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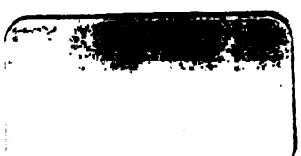

REPORTS

OF

CASES ARGUED AND DETERMINED

IN THE

Circuit Court of the United States

FOR THE SECOND CIRCUIT.

BY SAMUEL BLATCHFORD,
CIRCUIT JUDGE OF THE SECOND JUDICIAL CIRCUIT.

VOLUME XVII.

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JUDGES

OF THE CIRCUIT COURTS OF THE UNITED STATES

WITHIN THE SECOND CIRCUIT,

DURING THE TIME OF THESE REPORTS.

WARD HUNT, Associate Justice of the Supreme Court of the United States.*

SAMUEL BLATCHFORD, Circuit Judge of the Second Judicial Circuit.

DISTRICT JUDGES.

WILLIAM G. CHOATE, Southern District of New York.

WILLIAM J. WALLACE, Northern District of New York.

CHARLES L. BENEDICT, Eastern District of New York.

HOYT H. WHEELER, Vermont.

NATHANIEL SHIPMAN, Connecticut.

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* At the request of Mr. Justice Hunt, the Honorable Morrison R. Waite, Chief Justice of the Supreme Court of the United States, and the Honorable William Strong, an Associate Justice of the Supreme Court of the United States, severally held the Circuit Court of the United States for the Southern District of New York, under the provisions of § 617 of the Revised Statutes of the United States, and severally decided the cases which are stated in this volume to have been decided by them severally.

16996

*** *The following corrections should be made in Volume XVI of these Reports:*

Page 565, line 16 from the bottom, for "respondents" read "libellants"

" 569, line 4 from the bottom, for "claimant" read "libellant"

*** *The following correction should be made in this Volume:*

Page 357, line 25, for "indictment" read "indictments"

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CASES

ARGUED AND DETERMINED

IN THE

Circuit Courts of the United States

WITHIN THE SECOND CIRCUIT.

ROBERT CODMAN AND HENRY A. JOHNSON

vs.

THE VERMONT AND CANADA RAILROAD COMPANY.

The decision in *Codman* v. *Vermont & Canada R. R. Co.*, (16 *Blatchf. C. C. R.*, 165,) adhered to.

This suit being against the endorser of the notes, and the endorsement having been filled up when it was made, and ordering the contents of the notes to be paid to the bearer, and this having been done before the notes were put into circulation, the contract of the endorser was with the bearer, and no disability of the bearer to sue, as an assignee, could arise under § 11 of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 79,) now § 629 of the Revised Statutes.

It was of no consequence that the notary protesting the notes did not have the notes, as well as the coupons, to present for payment, at the time of making demand of payment.

Evidence which counsel did not, on a trial, think would be material, and did not know of and so did not obtain, although it might easily have been discovered, will not, generally, be allowed to furnish ground for a new trial, although its materiality may arise from the views of the Court in deciding the cause.

(Before WHEELER, J., Vermont, August 5th, 1879.)

WHEELER, J. After the opinion heretofore filed in this cause was delivered, (16 *Blatchf. C. C. R.*, 165,) and before

judgment, the defendant moved for a new trial, for the purpose of introducing new evidence, to the effect that the notary making the protest conceded did not have the notes themselves, as well as the coupons, to present for payment, at the time of making demand of payment, and moved that the cause be dismissed for want of jurisdiction in this Court. The cause has been further heard upon these motions.

The objection to the jurisdiction rests upon the proviso to section 11 of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 79, now *Rev. Stat. U. S., sec.* 629,) which is: "That no Circuit Court shall have cognizance of any suit to recover the contents of any promissory note or other chose in action, in favor of an assignee, unless a suit might have been prosecuted in such Court to recover the said contents if no assignment had been made, except in cases of foreign bills of exchange." These are not foreign bills of exchange. The makers and payee were citizens of the same State, the notes themselves were made payable to order and not to the bearer, so that no suit could be brought against the makers, upon them, by any one but the payee, without an endorsement, which would be an assignment, and, as to suits against the makers, they come precisely within the terms of that proviso. (*Gibson* v. *Chew*, 16 *Pet.*, 315; *Dromgoole* v. *Farmers' Bank*, 2 *How.*, 241.) It was settled early, that notes payable to bearer were payable to any one, and not affected with the disabilities of the original holder, under this statute. (*Bank of Kentucky* v. *Wister*, 2 *Pet.*, 318; *Smith* v. *Clapp*, 15 *Pet.*, 125; *White* v. *Vt. & Mass. R. R. Co.*, 21 *How.*, 575.) This suit is against the endorser and not the payee. The endorsement was filled up when it was made, and ordered the contents of the notes paid to the bearer. The evidence showed that this was done before the notes were put into circulation at all. The contract of the endorser was with the bearer, who might be anybody, so that no assignment of that liability would be necessary, and no disability of the original payee to sue would follow the cause of action arising upon that liability. This is expressly stated by Mr. Justice Clif-

ford to be the law, in *Lexington* v. *Butler*, (14 *Wall.*, 282, 293.) The objection to the jurisdiction, although not out of time, even at this late stage of the case, cannot prevail.

The defendant professes to wish to introduce the new evidence to add to the facts conceded, and not to contradict the terms of the concession. The evidence itself is newly discovered in fact, but might easily have been discovered before trial, if it had been thought that such evidence would be material; but it was not so thought by those having charge of the defence. They claim that the views of the Court make it appear to be material, and that, therefore, they ought now to have an opportunity to avail themselves of it. It is quite clear that the defendant has no right, upon any legal grounds, to have the case opened now for that purpose. If parties could first put in enough of their case to get the opinion of the Court, and then have an opportunity to make a case to fit the opinion, the administration of justice would be much protracted and large opportunities opened for abuse, although it is but just to say, that, in this instance, no attempt to patch up the case in any improper way is seen. The only wholesome mode of trial is for the parties to put in, and be required to put in, their evidence upon all points upon which they are to put in evidence at all, before the judgment of the Court is passed upon it. There are, probably, few cases tried but that the losing parties in which, or their counsel, are able afterwards to see, or think they see, some place where they could improve their side, if they had another opportunity. Still, it is better, in view of the whole, generally, that they should not have the opportunity. Nevertheless, there may be cases where the parties cannot bring themselves strictly within the rules for granting new trials, that the Court might and, perhaps, ought, in the exercise of its discretion, while the matter is wholly under the control of the Court, as in this case, before judgment, it is, to grant an opportunity to put in further evidence. In view of these considerations, the probable effect of the new evidence brought forward has been looked into. The evidence was full and clear that the

plaintiffs owned and held both notes and coupons. The deposition of the notary tends to show that he had only the coupons. The action is upon the notes themselves, for not paying the interest, according to the contract in the notes, on presentation of the coupons. Ordinarily, the instrument endorsed should be presented when demand of payment is made, in order that, upon payment, it may be delivered up. (*Freeman* v. *Boynton*, 7 *Mass.*, 483; *Shaw* v. *Reed*, 12 *Pick.*, 132.) In this case, nothing but the coupons were to be delivered up. The notes would be retained properly and necessarily. Notice to the endorser could not be dispensed with, but that was properly given, as is expressly conceded. The contract was, that payment should be made when the coupons were presented. They were presented and payment was not made, so there was clearly a default of the maker, of which the endorser had due notice, as is also conceded. This would seem to be sufficient, whether the notary learned whom to notify from the endorsements themselves, as was before inferred by the Court, or otherwise. (*Gilbert* v. *Dennis*, 3 *Met.*, 495.)

Besides, on further consideration of the terms of this guaranty, it seems probable that the defendant might be liable upon that alone. The only question about that is, whether it would follow the note into the hands of the plaintiffs, as bearers merely, to whom the guaranty was not otherwise made. The guaranty and endorsement are placed together over one signature, and the defendant guaranteed the payment of the notes, and ordered the contents paid to the bearer, at the same time. Such contracts are construed according to the expressed intention of the parties, as it is to be collected from the words used. (*Good* v. *Martin*, 95 *U. S.*, 90.) In view of the form and connection of the guaranty, it may well be understood, as suggested by one of the defendant's counsel on this argument, that the intention was that the notes should take the guaranty into circulation with them, and that the guaranty should run to the bearer, the same as the endorsement.

In arguing these motions it was still insisted, that the

defendant became a mere accommodation guarantor or endorser, and that all its undertakings in that direction were *ultra vires*. But, for the reasons before stated, the consideration was adequate and moved directly to the benefit of the defendant, and the statute quoted, as well as the general principles of the common law without the statute, brought the giving such notes, or becoming parties to them in other forms to the same effect, clearly within the scope of the corporate powers of the defendant. So, the evidence, if in, would not be likely to produce any different result, and there is no just occasion for delaying the cause to receive it.

The plaintiffs, in person, and with them *William G. Shaw*.

Edward J. Phelps and *Francis A. Brooks*, for the defendant.

THE GOODYEAR DENTAL VULCANITE COMPANY

vs.

SAMUEL S. WHITE.

In an action for damages for publishing a libel, the answer omitted to deny statements in the complaint as to the manner in which the plaintiff was damaged and as to the amount of the damages sustained. The defendant was allowed to amend the answer, by denying such statements, on the ground that the omission to deny them ought to have been regarded by the plaintiff as inadvertent.

(Before WALLACE, J., Southern District of New York, August 7th, 1879.)

WALLACE, J. The defendant moves for leave to amend his answer so far as to deny certain allegations of the complaint, which, not being denied in the answer, stand as admitted. The action was commenced in May, 1875, and the complaint alleges that the defendant published certain libel-

lous matter concerning a patent of the plaintiff, "knowing that the plaintiff was then offering for sale, and was about offering for sale, licenses or office rights to use said invention under said letters patent, and maliciously contriving to cause it to be believed that the plaintiff was not the lawful owner of the exclusive rights secured by said letters patent, and could not lawfully sell licenses to use said invention, and could not lawfully compel the payment of royalties for the use of the invention, and to prevent the plaintiff from effecting sales of licenses, as aforesaid, to dentists." The complaint further alleges, "that, by reason of the said several false and defamatory publications, great numbers of the dentists, and particularly the persons mentioned in Schedule A, hereto annexed, were dissuaded from purchasing said licenses, and refused, and still refuse, to purchase the same, in consequence thereof," and that the plaintiff has sustained damages in the sum of $75,000. Schedule A sets forth the names and residences of over fourteen hundred dentists, residing in all parts of the United States. To this complaint the defendant interposed a pleading which combined demurrers to each count in the complaint, with pleas of the statute of limitations, and matter in defence which could only be urged in mitigation of damages. The demurrers were noticed for argument from time to time, but the hearing upon the demurrers was delayed, and the decision was not had until October, 1878, at which time the demurrers were overruled, and the pleading permitted to stand as an answer, upon the payment of the costs of the demurrers. The defendant then moved to amend the answer, and the motion was granted, but, upon the hearing of that motion, it was first discovered that the answer, as amended, did not contain a denial of the allegation in the complaint which states, that, by reason of the publications of the defendant, the dentists mentioned in Schedule A were dissuaded from purchasing licenses of the plaintiffs, or of the allegation that the plaintiff has sustained damages in the sum of $75,000; and, thereupon, leave was obtained to move for the further amendment now asked for.

It is palpable, that the defendant did not intend to admit the truth of these averments, and that, upon the issue as it now stands, the defendant will be precluded from disputing his liability for very heavy damages. It is urged, in opposition to the motion, that the plaintiff has relied upon the implied admission in the answer, and, resting upon this from 1875 until this motion was made, it has not issued commissions and taken testimony *de bene esse*, as it otherwise would have done, and, in consequence, by the death, or removal, or forgetfulness of many of the dentists mentioned in Schedule A, it will be unable to produce proof, as to a large number of these dentists, that they were influenced by the defendant's publications, and were thereby dissuaded from taking licenses from the plaintiff; and it is further stated, in the plaintiff's affidavit, that the additional expense of obtaining its testimony at the present time, owing to peculiar circumstances, will be very onerous.

It would be a great hardship upon the defendant to preclude him from controverting so important an issue in the case, in consequence of a slip of his counsel in framing the answer; and the Court will struggle against the result, and, in furtherance of justice, give him an opportunity to present the truth of the matter, unless constrained to the contrary because of the countervailing hardship which such action would impose upon the plaintiff.

Was the plaintiff justified in relying upon the implied admission in the answer? Had he a right to suppose that the issue which would eventually be tried was that which was tendered by the answer? Here was a pleading containing demurrers which went to the whole complaint, and also matter by way of defence. By the demurrers the defendant admitted all the facts in the complaint, while, by another part of the pleading, he sought to deny the plaintiff's right to recover. What was the legal effect of such a pleading? A defendant may demur to part of a complaint and answer as to the residue, when the complaint joins several causes of action, but he cannot demur and answer to the same cause of action.

He must either demur or answer. (*Old Code of Procedure*, §§ 143 to 148 and 151.) There can be no doubt that the plaintiff could have stricken out either the matter in defence or the demurrers, upon a motion for that purpose. Instead of adopting this course, he preferred to notice the demurrers for hearing. By doing this, he elected to treat the demurrers as the regular pleading on the part of the defendant. Upon the decision overruling the demurrers, unless leave had been given to the defendant to answer, there would have been no answer in the case. This motion, then, is to be considered as though there had never been an answer in the case until leave was given, upon the decision of the demurrers, by which the defendant's pleading was allowed to stand as an answer; and the position of the plaintiff is the same as though the defendant had then, for the first time, served the answer which he now moves to amend. It is true, the error in the pleading was the fault of the defendant, but the plaintiff has no just cause to complain that he has been prejudiced by relying upon an admission in an answer, when he should have known that, as matter of law, there was no answer in the case.

But, I prefer to place the decision of this motion upon broader grounds, and consider it as though the answer sought to be amended had been the only pleading served, when issue was originally joined in the action. I think the plaintiff's counsel were not justified in the belief that the defendant intended to admit such an important allegation of the complaint, and should have regarded it as inadvertent and a slip in pleading. Defendants who contest the plaintiff's right to recover in an action for a wrong, are not accustomed to accept the plaintiff's own statement of his damages; and, to concede, as was, apparently, done here, that the plaintiff sustained seventy-five thousand dollars damages by reason of a libel, would be such a startling departure from the line of action usually adopted by a defendant, as to suggest, almost necessarily, mistake or ignorance. If there had been an express admission in the answer to this effect, it would have excited surprise and incredulity.

Aside from the extraordinary character of the admission, the rest of the answer indicated that the defendant intended to contest the amount of the plaintiff's damages, because, the last defence pleaded in the answer, while inartificially pleaded, was, in substance, a defence by way of mitigation of damages. Under the circumstances, the plaintiff's counsel should have anticipated that a motion to amend the answer would be made at the trial, if not before, and should, also, have assumed that the motion would appeal so strongly to the equitable consideration of the Court, that it could hardly be refused.

The motion to amend is granted.

William A. Beach and *William Tracy*, for the motion.

Benjamin F. Lee, opposed.

James A. Whalen *vs.* Philip H. Sheridan.

An officer of the army of the United States, assigned to the command of a military district created by the Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 428,) had no authority, as military commander, to issue an order to the sheriff of a county, requiring him to place a person in possession of a plantation and personal property which were, at the time, in possession of another person.

But, where he issued such an order, on the application of H., who claimed to be the true owner of the property, and was sued by W., who was dispossessed by the execution of the order, for damages for such dispossession, it was held that he could justify under such order if H. was the true owner and was entitled to the possession.

A motion for a new trial, because of alleged newly discovered evidence, denied, on the ground that such evidence was merely cumulative.

Under the system of pleading adopted in New York, judgment at the trial, in a suit at law, is to be rendered in accordance with the facts pleaded and proved, without regard to the form of the pleadings or the theory on which they were prepared.

(Before Wallace, J., Southern District of New York, August 7th, 1879.)

WALLACE, J. The jury having found a verdict for the defendant, the plaintiff now moves for a new trial, upon the ground of newly discovered evidence, and because of errors alleged to have been committed on the trial. The action was for trespass to personal property situate on the Killona plantation, in the State of Louisiana, of which the plaintiff was dispossessed, on the 8th day of August, 1867, under color of an order issued by the defendant, as military commander, directed to the sheriff of the county, requiring the sheriff to place one Mark Hoyt in peaceable possession of the plantation and personal property. The defence was a general denial of the plaintiff's cause of action, and a justification of the act of the defendant, under the authority of a law of Congress passed March 2d, 1867, (14 *U. S. Stat. at Large*, 428,) entitled, "An Act to provide for the more efficient government of the rebel States." By that Act those States were divided into five military districts, one of which was composed of the States of Louisiana and Texas, and the President of the United States was directed to assign an officer of the army to the command of each district, and to detail a sufficient military force to enable such officer to perform his duties and enforce his authority. The Act declared it to be the duty of each officer so assigned, to protect all persons in their rights of person and property, to suppress insurrection, disorder and violence, and to punish all criminals and disturbers of the public peace, and, to this end, to allow the local civil tribunals to take jurisdiction of, and try, offenders, or, when, in his judgment, it might be necessary, to organize military tribunals for that purpose. The defendant was assigned to the command of the district composed of the States of Louisiana and Texas. He alleged, by way of justification, that Mark Hoyt was the real owner of the personal property, and was entitled to the possession of the Killona plantation, and, having been dispossessed therefrom by the plaintiff and other lawless persons, he applied to the defendant for protection, and, thereupon, the defendant, as such military commander, issued the order to the sheriff to place Hoyt in possession, and that the

dispossession of the plaintiff under the order was the supposed grievance of which the plaintiff complained. The evidence on the part of the plaintiff was to the effect, that the plaintiff was in the exclusive and peaceable possession of the Killona plantation and the personal property thereon, until the 8th day of August, when he was required by the sheriff of the county to obey the military order of the defendant, and remove from the plantation, and relinquish the personal property to Mark Hoyt. On the part of the defendant, there was evidence to the effect that Hoyt was the owner of the personal property, and entitled to the possession of the property and plantation, and that, for some time prior to the issuing of the order, and when the order was executed, one Slater was in possession of the plantation and personal property, and the plaintiff was merely an occupant of certain rooms in the plantation buildings. Upon any view of the facts justified by the evidence, it was clear, that, although the possession of the plantation and property was held adversely to Hoyt, such possession had been peaceably obtained and maintained, and was under color of right. Upon the evidence, the Court ruled that the defendant had no authority, as military commander, to issue the order in question, and, when he assumed to administer remedial justice between citizens, not essential for the preservation of the public peace, or the prevention of illegal violence to persons or property, he exceeded his lawful powers. The Court also ruled, that, while the defendant could not justify his act, as one done by virtue of his authority as military commander, nevertheless, as his order was issued upon the application of Mark Hoyt, for the purpose of assisting Hoyt to obtain possession of his property, if the jury should find that Hoyt was the owner, and entitled to the possession of the property, the defendant could justify under the authority of Hoyt. Exceptions were taken to this ruling. The principal questions of fact submitted to the jury were, whether the plaintiff was in possession of the property at the time the order was executed, and, if so, whether Hoyt was the true owner of the property.

So far as the present motion proceeds upon the ground of newly discovered evidence, it can be briefly disposed of, and must be decided adversely to the plaintiff. The plaintiff desires to obtain the benefit of newly discovered testimony, to the effect, that, prior to the time of the execution of the order, Slater had transferred all his right and interest in the property to the plaintiff, and did not claim to exercise any control over it, and was not on the plantation, and had not been for some time. This testimony is insufficient to authorize a new trial, because it is merely cumulative. The status of Slater as well as of the plaintiff, with reference to the possession of the plantation and personal property, was one of the main issues of fact to which the evidence upon the trial was directed, and the newly discovered evidence is but additional evidence upon the same point, and is of the same general character as that produced upon the trial, and, within all the authorities, is cumulative, and, as such, not sufficient as ground for a new trial.

The important and more difficult question presented by this motion is that which involves the correctness of the ruling upon the trial, that the defendant could justify his act as one authorized by Hoyt, and could depend upon Hoyt's title to the property.

As the cause of action arose in the State of Louisiana, the rights of the parties are to be ascertained according to the law of that State, but, as nothing appeared, from the evidence on the trial, to show that the law of Louisiana differs from that of New York, the case was submitted, and is now to be considered, as though it were governed by the rules of the common law.

Although the owner of personal property, who takes it by force from the possession of one who holds it without right, is liable criminally for a breach of the peace, or civilly in an action for assault and battery, he is not liable in trespass, because, in an action of trespass, when the plaintiff's case rests upon proof of possession, title in the defendant is always a perfect defence. (*Hyatt* v. *Wood*, 4 *Johns.*, 150; *Ives* v. *Ives*,

13 *Johns.*, 235; *Jackson* v. *Seelye*, 16 *Johns.*, 197; *Jackson* v. *Farmer*, 9 *Wend.*, 201; *Taunton* v. *Costar*, 7 *Term Rep.*, 431; *Harvey* v. *Brydges*, 14 *M. & W.*, 437; *Meriton* v. *Coombes*, 9 *C. B.*, 787.) If Hoyt was the owner, and entitled to the possession, of the property in question, at the time of the plaintiff's dispossession, the plaintiff could not recover against Hoyt. Could he, then, recover against the defendant? The defendant undertook to restore Hoyt to his own, at Hoyt's solicitation. He was held liable for all acts done pursuant to his order, to the same extent, and because he was to be regarded, as though he had personally accompanied Hoyt and the sheriff, and assisted in the removal of the plaintiff. It would seem strange if Hoyt, upon whose request the defendant intervened, should not be liable, and yet the defendant be held. Such a conclusion would present the anomaly of the right to recover for a wrong, against an agent or a servant, for acts in behalf of a principal, when there is no right of recovery against the principal. The argument is, that, inasmuch as the defendant assumed to act as a military commander, he cannot justify in any other character or capacity. This argument would apply with equal reason to Hoyt also, because he was instrumental in procuring the defendant to act in his capacity of military commander. The logical sequence would be, if Hoyt had retaken his own with a file of soldiers, under the flag of the United States, that he must show his right to the flag and the soldiers before he could be heard to assert his title; and this for the protection of a person who had no right to the property or to its possession. Suppose Hoyt had resorted to artifice, to obtain possession, or had induced the plaintiff to abandon the property by untrue representations, would he be precluded from showing his right, when sued, because he had obtained possession by artifice or deception? If so, an owner may take his own by the strong hand, under circumstances which render him amenable criminally, and yet be protected, while, if he resorts to stratagem, involving no criminal liability, he must pay damages to one who, as against him, has no right

to detain the property. No authority or principle can be found to sustain such a conclusion.

The theory of the plaintiff is, that the defendant is estopped from asserting that he was acting as military commander; and numerous cases are cited to the effect, that one who holds himself out as acting in some special character, cannot be heard to deny that he was so acting, afterwards. The doctrine of estoppel has no application in this case, nor are the authorities cited in point, because, the plaintiff cannot be prejudiced by allowing the defendant to show that he was, in fact and in law, acting in privity with Hoyt.

An estoppel *in pais* arises where one party has been induced by another to rely upon the existence of a state of facts, and thereby to do or omit some act which will enure to the prejudice of the former, if the latter is permitted to prove the non-existence of the facts. Under these circumstances, one who has assumed to exercise an official authority will be precluded from disputing his appointment or title to the office. How has the plaintiff been misled because the defendant assumed to act as a military commander in requiring the plaintiff to restore the property to Mark Hoyt? The plaintiff was bound to know the law, and is conclusively presumed to have known it, as well as the defendant. He knew, therefore, that the defendant did not possess the authority which he assumed, and that, as a military commander, the act of the defendant was beyond the scope of his lawful powers. What injury, in a legal sense, has the plaintiff sustained by acting upon the assumption that the defendant, as military commander, could compel the restoration of the property to Hoyt? Concede that the plaintiff would not have surrendered possession of the property had he not supposed the defendant had the right, as well as the physical power, to compel obedience to his orders, nevertheless, the plaintiff has only surrendered possession to the person who was entitled to it. He might have defended his possession by force, and, if the property had been taken from him by violence, might have had his action for assault and battery. He would have recovered, however,

only compensation for his personal injuries. He knew he had no right to the possession of the property as against Hoyt; he knew that the defendant was seeking to obtain possession only for Hoyt; and, under these circumstances, he did only that which he should have done without any order or any show of coercion. The books will be searched in vain for any precedent sustaining the doctrine that an estoppel arises under such circumstances.

Under the instructions of the Court, the defendant could not justify unless Hoyt was entitled to the property. If Hoyt was entitled to the property, inasmuch as the defendant intervened at Hoyt's solicitation and for his protection, he was entitled to stand upon any defence which Hoyt could maintain. The case is similar to *Gault* v. *Jenkins*, (12 *Wend.*, 488,) where the defendants dispossessed the plaintiff, under a warrant in summary proceedings which was void because of want of jurisdiction in the officer issuing it, and, being sued in trespass, it was held they could justify by proof that they acted by the direction of the owner entitled to the possession of the premises.

It is insisted, that the defendant's justification is pleaded, technically, as one by virtue of his office as military commander. As to this, it suffices to say, that the answer sets out all the necessary facts, and, if the legal conclusions are inconsistent with the facts alleged, it is the duty of the Court to apply the correct legal inference to the facts. Under the system of pleading adopted in this State, judgment should be rendered at the trial in accordance with the facts pleaded and proved, without regard to the form of the pleadings, or the theory upon which they were prepared. (*Wright* v. *Hooker*, 10 *N. Y.*, 51; *Marquat* v. *Marquat*, 12 *N. Y.*, 336.)

The motion for a new trial is denied.

Scott Lord, for the motion.

Stewart L. Woodford, (*District Attorney*,) opposed.

The Eroe.

Where a rebate of duties is made in regard to goods respecting which damage is awarded for a breach of a contract of affreightment by a vessel, the vessel cannot have credit, against the amount of damage, for the amount of the rebate.

(Before Blatchford, J., Southern District of New York, August 11th, 1879.)

Blatchford, J. The libel claims $300 for damage to 1,503 bags of almonds in the shell, the damage being alleged to have been caused by the improper stowage of the almonds, so that they were injured by oil and wine. The District Court found, from the proofs, that the contents of 192 of the bags were, on arrival, injured by contact with petroleum oil, and that the vessel was responsible for such damage. On a reference to ascertain the amount of such damage, the referee reported that no damages to the libellant were proved. On exceptions to the report by the libellant, the District Court sustained the exceptions, and made a decree awarding to the libellant, as damages, $100, with $15 75 interest and $112 57 costs, being $228 32, in all. The libellant is satisfied with this decree, and has not appealed. The claimant has appealed. The District Court held, that the diminution of the almonds in value was wholly caused by petroleum, and that the proper measure of damage was the difference between the market value of the almonds in the 192 bags, as they arrived, and their sound value. This the Court fixed at $100, and it allowed interest thereon from the date of the arrival of the vessel.

The claimant insisted, before the District Court, that the libellant ought to give credit for a rebate of duties which he had received from the United States Government, on the damaged almonds in the 192 bags, on account of petroleum damage; and that the amount of such rebate exceeded $100. The District Judge rejected this view, and said, in his decision: "The market price of a merchantable commodity must

furnish the test of value. To take into consideration the amount of duty paid upon an article, in determining its value, is, according to my view, to resort to cost as a test of value. The rate of duty, doubtless, is an element which goes to fix market value, but the amount paid for duties upon any particular article is not taken into consideration, in determining the value of that article. The article sells for the same, whether the owner paid or escaped paying the duty. So, in this instance, the damaged almonds were worth the same in the market, whether the libellant paid the whole, or a part, or none, of the duty; and the difference between that value and the market value of sound almonds shows the amount of injury caused by the failure of the ship-owner to perform his contract. Any advantage which the freighter has gained in adjusting the duties, was an advantage to him in his contract with the Government, not a benefit to the goods arising from the act of the ship-owner. The ship owner is no party to the dealings of the freighter with the Government, and the result of that dealing cannot enure to his benefit; otherwise, the ship-owner might claim to take upon himself the adjustment of the duty, and, if not permitted, he might ask to show, in diminution of his liability, that, if permitted, he would have obtained a large rebate. Upon these grounds, I must reject the claim of the respondent, that the rebate of duties obtained by the libellant from the Government be credited to him, in calculating the damage arising from his negligence." This decision was made in July, 1877. In January, 1877, in the District Court for the Southern District of New York, the case of *The Bark Carlotta*, (9 *Benedict*,) came before me, in which, in directing an interlocutory decree for the libellant, and a reference, in a suit for the breach of a contract of affreightment by a vessel, I said, that, if any sum of money had been received by the libellant, or by any purchaser of the damaged goods from him, from the Government, as a rebate of duties, for loss or damage in respect of any goods as to which an allowance should be found due for loss or damage, he must be charged with such sum. The view thus expressed

was brought to the notice of the District Judge who decided the present case. He announced his dissent from it, and proceeded to give his own views, as above set forth. In the case of *The Carlotta*, no allowance was, in fact, made for a rebate of duties, because, no allowance was made for damage in regard to any goods respecting which a rebate of duties was made. The case of *The Carlotta* came recently, on appeal, before Chief Justice Waite, sitting in the Circuit Court for the Southern District of New York, (July 31st, 1879,) but the question raised was not decided, because he concurred with me in not allowing any damage in regard to any goods respecting which a rebate of duties was made. It remains, therefore, to decide, in this case, whether, where a rebate of duties is made in regard to goods respecting which damage is awarded for breach of a contract of affreightment by a vessel, the vessel can have credit, against the amount of damage, for the amount of the rebate. I think the considerations set forth by the District Judge, in this case, present the proper view of the law, and that the libellant is entitled to a decree for $100, with interest from the date of the arrival of the vessel, with $112 57, his costs in the Court below, and with his costs in this Court.

Beebe, Wilcox & Hobbs, for the libellant.

Butler, Stillman & Hubbard, for the claimant.

Orlando Perrine *vs.* The Town of Thompson.

After the Court decided *Cooper* v. *The Town of Thompson*, (13 *Blatchf. C. C. R.*, 434,) the Court of Appeals of New York decided, in *Horton* v. *Town of Thompson*, (71 *N. Y.*, 513,) that the Act of the Legislature of New York, passed April 28th, 1871, (*Laws of New York*, 1871, *chap.* 809, *p.* 1838,) validating the irregularities of the commissioners in issuing the bonds of the town, was unconsti-

tutional, and, after that decision, this Court, in an action between the parties to this suit, adhered to the former decision of this Court. In the present case this Court adhered to its former decisions, there being no difficulties in the way of a review of the case by the Supreme Court.

The case of *The County of Warren* v. *Marcy*, (97 *U. S.*, 96,) followed, as conclusive against a defence predicated on *The People ex rel. Kilbourne* v. *Benedict*.

Where a plaintiff has the legal title to coupons, he can sue upon them, although he bought them merely with the object of bringing suit upon them in this Court, and intending, if he collected them, to pay over a portion of the recovery to some other person.

Coupons payable to bearer are promissory notes, within § 1 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470,) and the holder of them is not an assignee, but acquires his title by delivery.

(Before WALLACE, J., Southern District of New York, August 11th, 1879.)

WALLACE, J. Since the decision of this Court in *Cooper* v. *The Town of Thompson*, (13 *Blatchf. C. C. R.*, 434,) the highest Court of the State has decided (*Horton* v. *Town of Thompson*, 71 *N. Y.*, 513,) that the Act of the Legislature, passed April 28th, 1871, validating the irregularities of the commissioners in issuing the bonds, (*Laws of New York*, 1871, *chap.* 809, *p.* 1838,) was unconstitutional; and, since that decision by the State Court, Judge Shipman, in this Court, in an action between the present parties, adhered to the former decision of this Court. The Supreme Court of the United States has sustained the validity of legislative Acts of the same general character as the one in question, (*Thomson* v. *Lee County*, 3 *Wall.*, 327; *The City* v. *Lamson*, 9 *Wall.*, 477; *Ritchie* v. *Franklin County*, 22 *Wall.*, 67,) but in no case of which I am aware, where the highest Court of the State in which the action was tried had pronounced the legislation unconstitutional. But, in *Town of Venice* v. *Murdock*, (92 *U. S.*, 494,) the Supreme Court refused to consider itself required to yield its own convictions as to the right of a holder of municipal bonds to recover, although the highest Court of the State had decided, that, under the construction to be given to the statute under which the bonds had been issued, there could be no recovery upon the bonds.

Under these circumstances, I think the more seemly disposition of the case requires me to adhere to the former decisions of this Court, until the case is reviewed by the Supreme Court. If there were any difficulties in the way of such a review, I should certainly suspend the determination of the case until the cases now in the Supreme Court, involving the same question, should be adjudged.

The case of *County of Warren* v. *Marcy*, (97 *U. S.*, 96,) is a conclusive authority against the defence predicated upon the action and judgment in *The People ex rel. Kilbourne* v. *Benedict.*

The evidence would not have authorized the jury to find that the plaintiff's purchase of the coupons in suit was colorable and fictitious merely. Quite likely he bought them mainly with the object of bringing suit upon them in this Court, and intending, if he collected, to pay over a portion of the recovery to some other person; and, perhaps, the jury would have been justified in finding that the coupons were sold by the owner, as well as bought by the plaintiff, with this understanding. Nevertheless, the plaintiff acquired the legal title, and, this being so, the motive of the transaction is not material. (*McDonald* v. *Smalley*, 1 *Peters*, 620; *Smith* v. *Kernochen*, 7 *How.*, 198, 216.)

The plaintiff is not an assignee, but acquired his title by delivery, and the coupons are promissory notes within § 1 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470.) (*Cooper* v. *Town of Thompson*, *supra*, and cases there cited.)

The motion for a new trial is denied.

James K. Hill, for the plaintiff.

Timothy F. Bush, for the defendant.

IRVIN A. WILLIAMS

vs.

THE BOSTON AND ALBANY RAILROAD COMPANY. IN EQUITY.

The decision of this Court in *Williams* v. *The Rome, Watertown & Ogdensburgh R. R. Co.*, (15 *Blatchf. C. C. R.*, 200,) in regard to the reissued letters patent granted to Irvin A. Williams, December 19th, 1865, for an "improvement in locomotive lamps," cited and applied.

Although the subordinate combinations covered by the several claims of the patent will not produce a useful result without the addition of other parts necessary to make a locomotive lamp, they are, nevertheless, sufficient to sustain the patent, because, by their coöperation, they contribute to a new result, and may be used in conjunction with such other parts as are ordinarily employed in locomotive head-lights.

All the claims of said patent are valid, except the fifth.

The fifth claim is void for want of novelty.

The defendant having employed all the parts in combination covered by the claims of the patent, cannot escape liability for infringement, because of the employment of others in addition.

A defence in a suit in equity, that the patentee has, since he obtained his patent, abandoned or dedicated it to the public use, must be set up in the answer.

Mere delay in enforcing equitable rights is not a defence to a suit, except in cases where the statutes of limitation apply, or where the party has slept upon his rights, and acquiesced for such a length of time that his claim has become stale.

(Before WALLACE, J., Northern District of New York, August 11th, 1879.)

WALLACE, J. The case of *Williams* v. *The Rome, Watertown & Ogdensburgh. Railroad Company* (15 *Blatchf. C. C. R.*, 200,) is a controlling authority upon many of the questions now presented. In that case, the validity of the issue of complainant's patent was necessarily determined, as was also the novelty of the several combinations claimed, so far as this was assailed by the patents then introduced as anticipations. Not only did Judge Blatchford sustain as patentable the entire combination which complainant's organized

locomotive lamps embraced, but also the sub-combinations covered by the several claims in the patent. In the present case, therefore, it must be held, that, although the subordinate combinations will not produce a useful result without the addition of other parts necessary to make a locomotive lamp, they are, nevertheless, sufficient to sustain the patent, because, by their coöperation, they contribute to a new result, and may be used in conjunction with such other parts as are ordinarily employed in locomotive head-lights. It then becomes necessary to ascertain whether the novelty of any of these combinations is disproved by the patents and devices now relied on as anticipations, which were not introduced in the former case.

To this end, the inquiry is, whether the alleged anticipations contain parts constructed and arranged substantially like those of the complainant, and have the same mode of operation. To illustrate: The first claim is for a combination of the circular, hollow wick-tube, perforated air-screen for the exterior current of air, and cap-deflector, substantially as set forth. This claim does not cover the use of these three devices in combination, irrespective of the manner of construction and arrangement. The correct rule of construction is one which will give the patentee what he has really invented, so far as is consistent with the language of his description and claim, both of which are to be read together; and where, as in this case, all the parts are conceded in the description to be old, and their efficiency is referred to their peculiarity of construction and arrangement, it is this peculiarity which is the essence of the invention.

Applying this rule, it is not contended that the defendant can rely upon any of the alleged anticipations except the English patent of Quincy and Johnson and the lamp of Dyott, because the others plainly fail to present the complainant's combination.

Every claim of the patent except the fifth covers a combination of which the hollow wick-tube and cap-deflector are parts. The fifth claim is for the combination of the hollow

wick-tube, lateral oil-reservoir and perforated air-screen for the interior current of air, substantially as set forth. The Quincy and Johnson patent discloses a device called a "blower," interposed between the cap-deflector and hollow wick-tube, which, it would seem, is a necessary feature in their arrangement, as respects each other, and materially affects their mode of operation, and which suffices to distinguish the construction and arrangement of these parts from the complainant's. This patent is, however, in my judgment, an anticipation of the fifth claim of the complainant. The orifices which admit the air for the interior current, together with the interior screen, are equivalents for the complainant's devices, and break up the current of air sufficiently to prevent material flickering of the flame from the pressure of air in the head-light. The differences between the wick-tube and the lateral oil-reservoir of Quincy and Johnson and those of the complainant are not substantial.

The Dyott lamp, assuming it to have been perfected like the model, does not contain the cap-deflector nor the circular hollow wick-tube of the complainant, nor equivalents therefor, and, therefore, does not anticipate any claim in the patent.

The defendant employs all the parts in combination covered by the claims of the complainant's patent, and cannot escape liability for infringement because it employs others in addition.

The defendant insists that the proofs show, that, since the complainant acquired his patent, he has abandoned or dedicated the same to the public use. This defence is not set up in the answer, and there is nothing in the record to apprise the complainant that such an issue was to be raised in the case. This alone is sufficient to deprive the defendant of the right to rely upon this defence. It is proper to say, however, that, while the evidence shows such laches on the part of the complainant in enforcing his rights, that, upon a motion for a preliminary injunction, it is very doubtful if he would not be defeated, it is not sufficient to establish the defence of abandonment or dedication. Mere delay in enforcing equitable rights is not a defence to an action, except

in cases where the statutes of limitation apply, or where the party has slept upon his rights and acquiesced for such a length of time that his claim has become stale. There may be an acquiescence by an owner in the use of his property, under circumstances which amount to an equitable estoppel against the assertion of his right. The case made here is not one for the application of this doctrine. According to the statement of the complainant, he has never permitted it to be doubted that eventually he should enforce his rights under his patent, neither does mere delay or acquiescence establish an abandonment or dedication of the patent. There must be an acquiescence in the appropriation of the right, of such character as reasonably to induce the belief that the owner intended to relinquish it to the public use.

Inasmuch as the complainant's patent has expired since the bill was filed, the decree will be for an accounting only.

Wetmore & Jenner, for the plaintiff.

A. McCallum, for the defendant.

THE STEAM STONE CUTTER COMPANY

vs.

THE WINDSOR MANUFACTURING COMPANY AND ELBRIDGE G. LAMSON. IN EQUITY.

A Court has power to set aside a report of a master for any manifest error, either in law or fact, and to recommit it for further proceedings, or to correct it, if the means of correction are furnished.

The principle stated, upon which gains and profits are recovered from an infringer, in a suit in equity.

Where infringing machines have been made and sold for profit by the infringer, the plaintiff is entitled to whatever of that profit arose from appropriating

the patented inventions by making and selling those machines, although other infringing machines were disposed of by the infringer without profit, or are still on hand and cannot be disposed of, involving loss to the infringer.

The value of the use of real and personal estate belonging to the infringer, such as shops, fixtures and machinery, including repairs, employed in making the machines made and sold for profit, is to be allowed as part of their cost.

The amount paid for insurance on such property, the insurance being for the safety of the property, generally, and not for the benefit of the manufacture of those machines, is not to be allowed as part of their cost; nor is the amount paid for local taxes on such property.

The infringer being a corporation, salaries paid to stockholders in it employed in making those machines, such salaries having been paid in good faith, for services actually rendered, and not as a mode of dividing profits, or for the purpose of concealing profits, are to be allowed as part of the cost of those machines.

Where a portion of the prices at which those machines were sold was due to an arrangement of the boiler in the machine, different from the plaintiff's, but the defendant had no monopoly of such arrangement, such portion of the price being allowed to the plaintiff, the cost of the workmanship is to be allowed to the infringer.

Where $750 of the price at which each of those machines was sold was due to a patented improvement of the infringer, called a bow-spring, attached to and sold with the machine, no part of the $750 is to be allowed to the plaintiff, and no part of the cost of making the bow-spring is to be allowed to the infringer.

The infringer had incurred liabilities on guaranties and warranty of title, as to those machines, but nothing is to be deducted on that account from the avails of their sales, because those liabilities will be extinguished by satisfying the plaintiff's recovery as to those machines.

Interest on the profits decreed was charged against the infringer from the time of the entry of the interlocutory decree.

(Before WHEELER, J., Vermont, August 11th, 1879.)

WHEELER, J. This cause has been heard upon the report of the master and exceptions by each party thereto. The exceptions of each raise some questions of fact as well as of law, and, in argument, it has been urged, on behalf of the orator, that these findings of fact should be revised by the Court, and corrected in favor of the orator, and, on the part of the defendants, that they should not be revised, but, if revised, that there are errors which should be corrected in favor of them. There is no doubt but that the Court has power to set aside the report of a master for any manifest error, either in law or fact, and to recommit it for further proceedings, or to cor-

rect it, if the means of correction are furnished. But, upon all that has been suggested or observed, in respect to this report, there is nothing that appears to warrant any interference with the findings of the master as to anything material to the rights of the parties, so far as his findings have extended.

There are various questions submitted by the master, and there is one point upon which he has reported no finding, that now seems to be material, which are to be considered. This bill was brought before the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 206, § 55,) authorizing Courts of equity to take an account of damages as well as of profits, in suits for the infringement of patents, and has proceeded, in this respect, for the recovery of profits only. The validity of the orator's patents and the infringement by the defendants have been established, so that the questions remaining here are solely as to the amount to which the orator is entitled. The defendant Lamson appears to have received nothing, otherwise than as a stockholder of the other defendant, on account of the infringement, and no decree for the payment of any money can be made against him.

The rights of the parties may be better understood, and a correct solution of several of the questions presented be more readily reached, by first considering the grounds upon which such recovery as may be had here rests. There was nothing in the statutes relating to patents, before the Act of 1870, providing expressly for the recovery of the gains and profits of an infringement of a patent by suit in equity. The right must have been derived from the application of the general principles of justice, as administered in Courts of equity, to the relations between the owners of patents and infringers, created by the patent laws. The patentee owns the monopoly of the patented invention. When an infringer converts any part of the monopoly into money, or into anything else, the owner has the right to follow his property in its new form. The person in whose hands it is becomes his trustee; not because he was ever a trustee of the invention or monop-

oly, or had any right whatever to dispose of it for the owner, but because he had the money or other thing in his hands, which the owner of the invention had the right to claim because the invention brought it. It is what is received for the invention that belongs to the owner of the patent, and, when that is not mixed with what is received for anything else, there can be no difficulty about how much the owner of the patent is entitled to; when it is, the difficulty lies wholly in making separation. (*Littlefield* v. *Perry*, 21 *Wall.*, 205.) Here, the defendant, the Windsor Manufacturing Co., made sales of eleven infringing machines, for profit; and, whatever of that profit arose from the appropriation of these patented inventions by the making and selling those machines, the orator is entitled to here, and no more. Other machines were made by the defendant, embodying the invention, which have been disposed of without profit, or are still on hand and cannot be disposed of, and which, as they are left, involve serious loss to the defendant; but, these facts do not vary the amount received for those sold, on which profit was made. The defendant did not make nor sell any of them for the orator. The whole was done on its own account, as a part of its own business, exclusively. Each infringement was separate, and no claim accrued in favor of the defendant against the orator, on account of any of them. The losses of unfortunate attempts were the defendant's own losses, and there is nothing to set-off against the orator's right to the avails of the successful attempts. If the defendant had been acting for the orator, and the whole enterprise, in connection with making this kind of machines, had been the enterprise of the orator, the net result would have been what the orator would have to stand to; but, the enterprise was an enterprise of the defendant; none of the machines were made by the defendant for the orator; neither has the orator adopted the making or selling any machine, as having been done for itself. It had nothing to do with any of the machines, except as they included the patented invention, nor with the sale of any of the machines, except as the sale included so much of the invention, and, as to that, it

only claims what the invention brought, which is the same as if anything else belonging to the orator had been put into and sold with the machines, and the orator claimed what that brought. The orator waives the tort, and proceeds for the money arising from the tort. The money arising here is what would be left, after deducting the cost of the machines which the defendant furnished, from the avails of the sales of the machines, including the invention that belonged to the orator.

The machines sold for $58,500; some of them with an express guaranty, in writing, of the right to use, and the rest with such warranty as would be implied by law from the fact of sale. The master has found and allowed elements of cost of manufacture of these machines, about which there is no question of law, to the amount of $35,451 93. He has also allowed for local taxes $116, which the orator claims should be disallowed, and has reported that the use of real and personal estate, belonging to the defendant, including repairs, employed in making these machines, was worth $2,632 46; that there was paid for insurance on such property, $455 52; that there was paid for salaries to stockholders of the defendant, employed in the making, $1,490; that $8,250 of the prices at which the machines were sold was due to a patented improvement of the defendant, called a bow-spring, attached to and sold with the machines, and $1,100 to an arrangement of the boiler in the machine, different from the orator's, which the defendant insists should be added to the cost of manufacture; and that the defendants' liabilities upon their guaranties and warranty of title is $22,000, if they are responsible for a failure of the right to use, which the defendant claims should be deducted from the avails of the sales.

The machines cost the defendant the use of this real and personal estate, the shops, fixtures, and machinery. They could not have been made without such use, any more than they could be without iron. The *whole* cost of the machines belongs to the defendant, and no sound reason is apparent why this part should be left out. The personal efforts of a

mere wrong-doer are not a proper subject for compensation to be allowed by a Court, but this stands on different footing. The orator had no right to the use of shops and machinery, and has no right to the money brought by that use.

The insurance was no part of the cost of manufacture. It was not put upon the property because it was engaged in this business. Had it been consumed by the element insured against, no part of the insurance would belong to the orator. (*Harding* v. *Townshend*, 43 *Vt.*, 536.) That money would have come from the defendant's property, not from the plaintiff's invention. The insurance was not for the benefit of this manufacture, but for the safety of the defendant in respect to its own property, generally.

It is so, in some respects, as to the local taxes. In that locality such taxes are assessed upon property according to its value, and not on account of its employment. No property is taxed because it is engaged in any particular manufacture, or because engaged in any manufacture, although, sometimes, it is exempt for a while because it is so engaged. These taxes, if justly assessed, as is to be presumed, would have been precisely the same if the property had been engaged in other business, or had been otherwise invested, or had been lying idle and wholly unproductive. So, the payment of the taxes did not have, or, at most, is not shown to have had, any effect whatever upon the cost of the machines.

The salaries paid to stockholders appear to have been paid in good faith, for services actually rendered, and not at all as a mode of dividing profits, or for the purpose of concealing profits. They were the same to the defendant, in its corporate capacity, in which it is sued, as if they had been paid to others not stockholders. It does not appear that the part which these salaried officers took in the business was such as to make them personally liable as infringers. The corporation infringed, and is sought to be charged for it in its corporate identity, and it should be held only according to its complete identity.

The defendant has not, so far as at all appears, any monop-

oly, by patent or otherwise, of the arrangement of the boiler in the machines. Placing it there was a mere matter of workmanship, for which the defendant should be allowed as a part of the cost of manufacture. That is allowed otherwise, and nothing should be allowed again on that account.

The defendant had a patent on the bow-spring improvement, and made use of it in disposing of so much of the orator's patents as was embodied in the machines. This improvement brought, according to the finding, $750 of the price which each machine brought. That part was not any product of the sale of the orator's invention. It is said, in argument, that the use of the bow-spring was intended and expected to make the use of the orator's invention more extensive and effective, which is, perhaps, true, and that, therefore, the orator should have the whole price due to both inventions, as belonging to that enhanced use. If this was an accounting for damages, there would be force in this suggestion, for, the more effective the machines sold were the greater the inroad upon the monopoly their sale would be, and the greater the damage. But, here, the sole question is as to how much was received from the appropriation and sale of the orator's invention, and not what damage resulted; and, what was received for the sale of something else, belonging to the defendant and not to the orator, should not be allowed to the orator. If, however, the defendant has $750 of the price of each machine, on account of the enhancement which the bow-spring furnished, no part of the cost of making the bow-spring should be treated as a part of the cost of what embraced the orator's invention. That cost should all be deducted from the total cost of the machines, and the remainder only be deducted from the remainder of the price of the whole, after the price belonging to the bow-spring has been deducted. The master has not reported what the total expense of the bow-spring is, but only that it brought $750 above the actual cost of making it and its attachments, leaving the part of other expenses allowed, belonging to it, unascertained. If, however, the proportion between what this

part of the invention brought and its part of this cost of the machines was the same as that between what the orator's invention brought and its part of this and the other parts of the cost of the machines, which is probable, the part of this cost of manufacture belonging to the bow-spring can readily be ascertained. It will bear the same proportion to the whole amount of these outside expenses as $8,250, the price of the bow-spring, bears to $58,500, the whole price. This part of the account is to be adjusted upon this basis, unless one party or the other moves for and obtains a further hearing in this respect.

As before stated, the only reason why the orator is entitled to any of the avails of the sales is, that, by the sales the defendant has converted the orator's property into money, which the orator is entitled to have in place of the property. The sale, to be an infringement, so as to entitle the orator to anything more than a mere nominal sum, must be a sale for use. (*Curtis on Patents*, § 294.) Here, that part of the avails of the sale belonging to the patented invention is large and substantial, and not merely nominal. If the avails of the sales are claimed and taken, the right to the thing sold must be parted with; *solutio pretii emptionis loco habetur.* (2 *Kent's Comm.*, 387.) It will be like taking judgment and satisfaction for the conversion of property, which always operate "so that the defendant hath now the same property therein as the original plaintiff had, and this against all the world." (*Adams* v. *Broughton*, *Andr.*, 19, *Strange*, 1078) And this relates back to the time of conversion. (*Addison on Torts*, *Wood's ed.*, 544; 6 *Hen. VII*, *fols.* 8, 9, *pl.* 4; *Shep. Touch.*, 227; *Barnett* v. *Brandão*, 6 *Man. & Gr.*, 640, *note.*) The sales must be adopted by the orator upon the very terms upon which the defendant made them, and as much right to the inventions must follow as if the sales had been made by the orator instead of by the defendant. It may be that this right will not follow until satisfaction is made; but, whether it will or not is not now material. The question now is, how much the orator is entitled to recover by way of satisfaction; and

this is to be arrived at on the ground that satisfaction will be made. If not made, the defendant will not suffer unjustly by having it reckoned as if it would be. It follows, necessarily, that the defendant will be under no liability over to the purchasers after satisfaction, and that nothing should be deducted here on that account.

There are profits on repairs sold, to the amount of $1,732, and on cutting done by the defendant, to the amount of $810 03, about which there is now no question.

Upon these conclusions, there is to be added to.		$35,451 93
for use of real and personal estate and repairs..		2,632 46
and for salaries of stockholders.....		1,490 00
making total cost of machines sold.....		39,574 39
the share of cost of bow-spring is.....		1,544 39
leaving for cost to be deducted.....		$38,030 00
From the amount of sales.....	$58,500 00	
is to be deducted for bow-spring...	8,250 00	
leaving.....	50,250 00	
from which is to be deducted.....	38,030 00	
which leaves.....	12,220 00	
to which is to be added.....	1,732 00	
and.....	810 03	
making.....	$14,762 03	

received by the defendant for the plaintiff's invention.

The defendant sold one machine with special guaranty of the right to use, and received $1,000 in money and $3,000 in notes, on time, therefor. Upon demand of a machine by the purchaser, that might lawfully be used, which the defendant could not comply with, the contract was rescinded by agreement, leaving the money in the defendant's hands, against which the defendant has a claim of about the same amount, and the notes there, but not enforceable. The orator claims that the defendant should be charged with the

profits of this machine, as upon a sale at $4,000. There is, however, no money, or the equivalent of money, arising from this transaction, belonging to the orator. The money received would not cover the actual cost of the machine. The notes were always subject to the defence of want of title, or, at least, to be extinguished by recoupment of damages, from failure of title to the invention and breach of the guaranty, while they were held as subsisting securities, and, since then, they have been wholly inoperative. There is nothing here to be reckoned, to vary the above statement.

The plaintiff claims interest upon the amount in the defendant's hands, and the defendant denies any liability to account or be charged for interest. In *Silsby* v. *Foote*, (20 *How.*, 378,) *Mowry* v. *Whitney*, (14 *Wall.*, 620,) and *Littlefield* v. *Perry*, (21 *Wall.*, 205,) interest upon profits of an infringement decreed to be paid was disallowed; in the first of the cases, without remark; in the second, with the remark that the profits were really damages unliquidated, upon which interest is not generally allowable, but that the Court would not say that in no possible case could interest be allowed; and, in the latter, with the remark, that profits actually realized were usually, in cases like that, the measure of unliquidated damages, that circumstances might arise which would justify the addition of interest, in order to give complete indemnity for losses sustained by wilful infringement, and that it would be for the Court to determine, upon the coming in of the new report in that case, accompanied by other evidence, whether the conduct of the defendants had been such as to subject them to liability in that particular. The tendency, in cases prior to the Act of 1870, seems to have been toward confining the liability to account for gains and profits more strictly to those actually received, and, at the same time, towards recognition of a liability for interest on the profits received. Still, no rule is laid down as to when it should or should not be allowed.

In this case, the defendant is made to account only for money or its equivalent actually received and held by the de-

fendant, but belonging to the plaintiff. The master has found that the defendant began and continued the business in good faith, believing it was not infringing the orator's rights, but having knowledge, while making and selling the machines, of the orator's claims. It is argued, for the orator, that the duty of the master was merely to take and state the account, and that no question of good faith was before him. But, if the question of good faith was pertinent to any part of the accounting, it was as much before him as those things pertaining to any other part. There was no contract about any part of this liability, and none to pay interest more than to pay anything else; so, the defendant cannot be charged with interest, except for the wrongful detention of the plaintiff's money. If the defendant wilfully, without right, and knowing it was without right, took the plaintiff's patented invention and converted it into money, with the intention of keeping it, while it was kept the detention of it would be manifestly wrongful. Upon the finding, this taking was intentional and without right, but with belief of right. Knowledge of the orator's claims involved knowledge of the orator's patents, and the belief of right must have been founded in the expectation of defeating the patents. The defendant had a patent for the bow-string, as an improvement, but none for the machine covered by the orator's patents. It invaded the patents, taking the risk of its turning out to be rightful or wrongful. It has turned out to be wrongful, and, since the entry of the decree in the cause, October 7th, 1870, the money has been detained with full knowledge of the character of the detention. And the defendant was not ignorant of the amount, for its books showed the amount approaching toward accuracy.

In *Ekins* v. *East India Co.*, (1 *P. Wms.*, 395,) on an accounting for a ship and cargo, bought by an agent of the defendant, of a person having no power to sell, the Court charged the defendant with interest, and said: "If a man has my money by way of loan, he ought to answer interest; but, if he detains my money from me wrongfully, he ought, *a*

fortiori, to answer interest. And it is still stronger where one by wrong takes from me either my money, or my goods which I am trading with, in order to turn them into money." This decree appears to have been affirmed, on appeal to the House of Lords. (2 *Bro. Parl. Ca.*, 382; 1 *P. Wms.*, 397, *note.*) It was said by Lord Mansfield and Mr. Justice Wilmot, in *Fisher* v. *Prince*, (3 *J. Burrow*, 1,363,) that interest might be allowed by a jury, in trover, for money numbered or in a bag. It was allowed on money obtained by fraud and imposition, in *Wood* v. *Robbins*, (11 *Mass.*, 504,) and on money detained by an officer, in *People* v. *Gasherie*, (9 *Johns.*, 71.) This seems to be well settled in Massachusetts. (*Hubbard* v. *Charlestown R. R.*, 11 *Met.*, 124.) And, if the law of the State of Vermont, where the money was detained, should govern, as perhaps it ought to, the law is the same there. (*Crane* v. *Thayer*, 18 *Vt.*, 162; *Vt. & Canada R. R. Co.* v. *Vt. Central R. R. Co.*, 34 *Vt.*, 2.) It is quite usual to charge a party with interest from the commencement of a suit, on account of the effect of it, as a demand, upon the mind of a party. (*Hunt* v. *Nevers*, 15 *Pick.*, 500; *Brewer* v. *Tyringham*, 12 *Pick.*, 547; *Haven* v. *Foster*, 9 *Pick.*, 112.) And it seems not to be improper here, to charge the party with interest from the entry of the decree, because ever after that the detention was known to be wrongful. This seems the more just, because all of the money was not received until about that time, October 1st, 1870, according to the master's report, although some of it was received considerably before. This interest amounts to $7,836 17, which, added to the principal sum, $14,762 03, makes $22,598 20, to be paid by the defendant, the Windsor Manufacturing Company, to the plaintiff, as of the 6th day of August, 1879.

The exceptions to the master's report are overruled accordingly, and the report is accepted and confirmed. Let a decree be thereupon entered, that the defendant, The Windsor Manufacturing Company, pay that sum, with costs, to the clerk, for the benefit of the plaintiff, and, in case the sum of $7,598 20, with the costs and interest thereon from said 6th

day of August, is not paid within thirty days from that day, that special execution issue, for the whole sum to be paid, at the expiration of said thirty days; and, in case that sum is so paid, and the balance of $15,000 is not paid within sixty days from said 6th day of August, with interest from that day, that special execution issue for the amount so remaining unpaid, at the expiration of said 60 days.

Aldace F. Walker and *Chauncey Smith*, for the plaintiff.

Wheelock G. Veazey and *Edward J. Phelps*, for the defendant.

HENRY J. SLEEPER AND OTHERS

vs.

EMILIO PUIG AND SANTIAGO PUIG.

A charter-party for the voyage of a vessel from New York to Santa Cruz, (Canary Islands,) and thence to Havana, Cuba, provided that the respondents were to be allowed, for the loading and discharging of the vessel, "dispatch for loading at New York and discharging at Havana; thirty running days for discharging at Santa Cruz;" and that, if the vessel should be longer detained by the respondents, demurrage, at so much per day, should be paid, day by day, for every day so detained: *Held*, that the customs and rules of the port of Havana were not to control as to the time for discharging there, but that the respondents were bound to take the cargo, at Havana, as rapidly as the vessel could deliver it.

By the rules of the port the cargo could be delivered only at the mole. The vessel came to anchor and was ready to deliver her cargo. There was no room for her at the mole. She was delayed till room was found: *Held*, that, under the terms of the charter-party, the risk of delay in obtaining a place of discharge at the mole, was on the respondents, and not on the vessel.

(Before BLATCHFORD, J., Southern District of New York, August 12th, 1879.)

BLATCHFORD, J. By the charter-party the vessel was chartered to the respondents for a voyage from New York to Santa Cruz (Canary Islands) and thence to Havana, Cuba. The cargo from Santa Cruz to Havana was to be stone or other lawful merchandise. The charter money was to be $4,000 gold for the round voyage, and the vessel's port charges at the Canary Islands; one half of the charter to be "payable on the discharge of cargo at Santa Cruz, in cash, or in approved sixty days' bills of exchange on London, at $4 84 to the pound sterling, charterers' option; balance on delivery of cargo at Havana; free of all commissions." The respondents were to be allowed, for the loading and discharging of the vessel, "dispatch for loading at New York and discharging at Havana; thirty running days for discharging and loading at Santa Cruz;" and, in case the vessel should be longer detained by the respondents or their agents, demurrage was to be paid the vessel's agent at the rate of 35 silver dollars per day, day by day, for every day so detained. It was further provided, that the cargo or cargoes should be delivered alongside, within reach of the vessel's tackles; and that the vessel should "be consigned to charterers' friends at Santa Cruz and Havana, free of commission."

The libel alleges that the vessel took on cargo at Santa Cruz and arrived at Havana; that her master duly reported his readiness to discharge cargo on the 4th of April, 1874; that the agents of the respondents did not give the vessel dispatch in discharging, but neglected to discharge the cargo for 17 days over the necessary lay days, under the terms of the charter-party, so that there became due to the libellants, for demurrage, $672 35; that $212 24 is due to the libellants for balance of freight on the cargo discharged at Havana; and that the libellants paid for the respondents, at Havana, for extra expenses in discharging cargo, $49 26.

The answer sets up that the charter money was fully paid; that, when the vessel arrived at Havana, the consignees of the respondents, as soon as they were notified of her arrival, immediately proceeded to assist her master in procuring a

wharf and in unloading the vessel; that, when she arrived, there was no berth unoccupied at the wharf, nor was it possible to procure one; that, by the laws and usages prevailing in the harbor of Havana, the control of wharves and berths, as well as the number of hours per day allowed for the discharge and loading of cargo, is not with merchants or other private individuals, but with the Government officials, who dispose of said matters as they deem proper; that, as soon as it was possible, the said officials provided a proper and suitable berth for the vessel; that the master thereupon proceeded to discharge and was allowed the full and usual number of hours per day wherein to effect said discharge, but, owing to the insufficiency and inability of her crew, the discharge was unusually slow; that thereupon and at the request of the master, the consignees of the cargo supplied him with extra men to enable the crew to discharge more rapidly; that, if there was any delay in unloading the cargo, it did not proceed from any negligence or default of the respondents, or of their consignees or agents; and that the usual dispatch in the port of Havana was used for the unloading of the cargo.

The District Court awarded to the libellants $490 for 14 days' demurrage, at $35 per day, and also $120 28 for balance due on charter-party. The respondents have appealed. The only question raised, in this Court, is as to the demurrage. The District Court held that the word "dispatch," in the charter-party, means, "without delay;" that it does not mean "with diligence," nor does it refer to, nor is it controlled by, any usages, customs or rules of the port; that it is a term that does not need construction by reference to extrinsic circumstances; that a charterer who stipulates for dispatch in discharge takes all risks of being able to effect such discharge; that though, without his fault, as, by reason of stress of weather, ice, the impossibility of obtaining the necessary hands to receive the cargo, or other cause, he is obliged to detain the ship, he must pay the stipulated demurrage; and that the time allowed, by this phrase, for receiving the cargo,

is measured by the capacity to deliver it. It is contended for the respondents, that, if such is the correct view, there is no difference between the legal consequences attached to the word "dispatch" and those which follow where a fixed and determined period of time is stated; that the term "dispatch" is to be construed according to the surrounding circumstances; and that there is nothing showing, or tending to show, that the parties ever understood or intended that they should be bound on the one side, or entitled on the other, to any more than diligent efforts on the part of the charterer to discharge as rapidly as circumstances would allow. Attention is called to the fact that the charter-party allows 30 running days for loading and discharging at Santa Cruz, while the expression "dispatch" is used in reference to loading at New York and discharging at Havana, and from this it is argued, that the respondents did not intend to bind themselves to the same rigid rule which the Courts have applied where a determined number of days is stated.

If it had been intended that the customs and rules of the port of Havana should control as to the time for discharging there, it was very easy to have so provided. In the absence of such a provision, and by the use of the word "dispatch," it must be held that the respondents were bound to take the cargo as rapidly as the vessel could deliver it. (*Keen* v. *Audenried*, 5 *Benedict*, 535; *Davis* v. *Wallace*, 3 *Clifford*, 123; *Thacher* v. *Boston Gas Light Co.*, 2 *Lowell*, 361.) The Court below decided that five working days was a proper and reasonable time for discharging the cargo; that it could have been delivered by the vessel in five working days; and that the vessel was entitled to insist on such dispatch. In these conclusions that Court was correct.

The vessel arrived at Havana on Thursday, April 2d. Friday, April 3d, was Good Friday. On Saturday, the 4th, the vessel came to her anchorage, and on the same day she was entered at the Custom House, and was reported by the master to the consignees of the respondents, as ready to discharge. The rules of the port required that her cargo should

be discharged at the mole. She was not brought up to the mole until the 14th. The mole was crowded with vessels and a place there could not be obtained for her before that day, the custom being to give berths to vessels there in the order of their arrivals, and the assignment of berths being in the control of the captain of the port. The vessel was at anchor in the usual place of anchorage near the mole, where vessels await their turn for discharging at the mole. The respondents' consignee, Morales, to whom also the vessel was consigned, in accordance with the charter-party, testifies, that the vessel was at anchor when he was informed by the master of her arrival, and that the wharf clerk of his house undertook thereupon to procure a berth for her at the wharf. It is contended for the respondents, that their liability for demurrage commenced only when the vessel arrived at the mole; that then, and then only, could delivery be made of the cargo; that the vessel could not be discharged until that time; that the risk in the interval was the master's; and that, until the master placed the respondents' consignees in a position to receive the goods, he could not hold the respondents for demurrage. It was held, by the Court below, that the respondents' consignees assumed the entire control of the matter of finding a place for the discharge of the cargo; that they thereby affirmed their duty, under the contract, as they understood it, to take charge of the vessel; that a delay in finding a place to discharge is as much within the mischief sought to be obviated by the requirement of "dispatch for discharging," in the charter-party, as a delay in receiving the cargo after the vessel reaches the wharf; and that the respondents are liable for all delay from the time of the reporting of the vessel at her anchorage near the mole in readiness to deliver her cargo. The obligation of the vessel, by the charter-party, was to deliver the cargo at Havana, and the second half of the charter money was payable on the delivery of the cargo at Havana. The respondents contracted for "dispatch" in discharging at Havana, and for the stipulated demurrage per day, day by day, for every day the vessel should be detained

by the respondents or their agents, longer than the time thus provided for. The vessel, from the 4th of April, was at her anchorage ready to deliver her cargo. She did not get aground, or in any manner become disabled or prevented from going to the mole or from delivering her cargo, except by the fact that there was no room for her at the mole. Under these circumstances, and in view of the terms of this charter-party, the risk was on the respondents and not on the vessel, of any delay in obtaining a place of discharge at the mole. (*Brown* v. *Johnson*, 10 *M. & W.*, 331.)

The defence that there was delay in discharging because of the insufficiency and inability of the crew of the vessel is not made out.

The discharging of the cargo was not completed until the 24th of April. Of the 20 days from April 4th to April 24th, the District Court excluded Sunday, April 5th, and allowed the five days next ensuing for discharging, and charged the respondents with 14 days' demurrage. This was correct. There is no satisfactory evidence that any one of such five days was a holiday or a day on which servile labor was not permitted. For every day from April 10th to April 24th, including the Sundays in that time, the vessel was entitled to demurrage, and the sum awarded, $490, was correct. There is no complaint as to the allowance to the libellants of the items amounting to $120 28.

The libellants are, therefore, entitled to a decree for $610 28, with interest at 6 per cent. per annum from May 2d, 1874, (the date fixed by the Court below) and for $75 49, their costs in the District Court, and for their costs in this Court, to be taxed.

Beebe, Wilcox & Hobbs, for the libellants.

Coudert, Brothers, for the respondents.

CHRISTOPHER C. CAMPBELL

vs.

THOMAS L. JAMES AND CHARLES EDDY. IN EQUITY.

The re-issued letters patent, division A, No. 4,143, granted to Helen M. Ingalls, October 4th, 1870, for an improvement in post-office postmarking and cancelling hand-stamps, (originally granted to Marcus P. Norton, April 14th, 1863, and re-issued to Jacob Shavor and Albert C. Corse, August 23d, 1864, and to said Norton, August 3d, 1869,) are valid.

The invention was made by Norton before May 4th, 1859.

A letter from Norton, introduced in evidence by the defendant, is evidence for the plaintiff on those points which are in his favor.

Evidence to defeat a patent, on the ground of prior invention, ought to be such as to remove all fair and reasonable doubt.

The assignment on which a re-issue was based was alleged to have been forged by the assignee, but, it appearing that the assignor, after the re-issue, recognized the assignment as valid, it was upheld.

The execution of an assignment by a corporation and by S., president, held to be a good execution by S. for his individual interest.

An assignment of a patent to an assignee in trust, gives him the legal title.

Although the defendant used the invention as an officer of the Government, in the performance of his duties, for the benefit of the Government, he is liable as an infringer.

(Before WHEELER, J., Southern District of New York, August 14th, 1879.)

WHEELER, J. This suit is brought for relief against alleged infringements of letters patent for an improvement in post-office postmarking and cancelling hand-stamps, originally granted to Marcus P. Norton, on the 14th day of April, 1863, and re-issued to Jacob Shavor and Albert C. Corse, on the 23d day of August, 1864, to Marcus P. Norton, on the 3d day of August, 1869, and to Helen M. Ingalls, on the 4th day of October, 1870, in division A, numbered 4,143. The principal defences set up and relied upon are, that Norton was not the first inventor; that there was no patentable invention involved; that it was in public use more than two years be-

fore the application, and with his consent and allowance; that the re-issue in suit was not for the same invention; that the plaintiff has no title; that the defendant is a public officer; and that he does not infringe in fact.

There is much controversy as to when, in fact, Norton first produced this invention. The application was made January 5th, 1863, but that is not early enough to anticipate knowledge and use of the invention by others; therefore, it rests upon the complainant to establish prior invention by Norton. It clearly and satisfactorily appears, from all the evidence, that he produced it before May 4th, 1859. By letter dated that day, Horatio King, First Assistant Postmaster-General, authorized the postmaster at Troy, New York, to use, for postmarking letters at that office, for the term of three months, one of Norton's improved stamps. Norton was an inventor of other improvements in such stamps, and there is a question as to whether the stamp referred to in that letter was this one, or some other. King's testimony and correspondence settles it that this is the one. After he went out of office, he was employed by Shavor and Corse to assist them about obtaining compensation for the use of this stamp, and was kept familiar with it all the while; and his testimony is that this is the one. General Dix was appointed postmaster at New York early in 1860. In August of that year, he wrote to King about a similar contrivance which he had got up, and, in a reply, directed by King, was warned that there was a prior invention which might subject that office to a heavy charge, if his contrivance was used. This enables King to testify with positiveness that entitles it to credit, that he had correspondence with Norton about this stamp before that time. One form of this instrument had a canceller made of cork. Norton permitted it to be used at the New York office, to test it. Its use commenced there soon after the correspondence of Dix with the Department in 1860, and was found there when Abraham Wakeman became postmaster there in 1861, or thereabouts, as is shown by his letter to the Third Assistant Postmaster-General, dated January 3d,

1863. This correspondence, which does not depend upon mere memory for dates and circumstances, identifies this stamp very clearly. The complainant claims that the invention was made in 1853 or 1854, and described in an additional description of a caveat filed about August 7th, 1854. This additional description, produced from the caveat files, does not appear to have ever been officially filed under the hand of any custodian of the records, and is admitted to be a copy made in 1868, said to have been put into the files by mistake, in place of the original, which is not produced. The defendant has put in evidence the record of proceedings by the Commissioner of Patents disbarring Norton, as solicitor of patents, and adjudging that copy to be no part of the files; and claims that this destroys the effect of it as evidence. No evidence on which the Commissioner acted, nor any showing the misconduct of Norton, is produced. Norton testifies that the original was duly filed, and afterwards copied, and the copy returned to the files, by mistake, as he supposes. The plaintiff claims that the action of the Commissioner legitimately shows nothing on this question, and that Norton's testimony is all the evidence there is properly bearing upon the subject. The defendant has introduced a letter from Norton to Wakeman, postmaster at New York, dated February 6th, 1864, when Norton was interested in this patent as part owner, stating, that "the *double cancelling stamp now* used by you in your post-office, *is my invention* as far back as the year A. D. 1856, as I can most fully and satisfactorily prove. It was patented to me in the early part of the year 1863, upon an application made by me a long time before then. I had several such stamps made in 1858, as I can prove by the person who made them," for the purpose of impeaching the testimony of Norton as to the caveat. The caveat, as such, long before the application for the patent, ceased to be operative, because not followed up. The only use the copy found can be is as a piece of evidence. The judgment of the Commissioner, as such, extended only to the exclusion of Norton as solicitor, and not to the effect of the paper as evidence *en pais*, (*Act of*

July 8th, 1870, *sec.* 17, 18 *U. S. Stat. at Large*, 200; *Rev. Stat. U. S.*, *sec.* 487;) although its effect upon the instrument as a caveat of record might be greater. (*Robertson* v. *Secombe Manufacturing Co.*, 10 *Blatchf. C. C. R.*, 489.) What the weight of the evidence produced, and legitimately bearing upon the question, as to whether there was in fact an original paper of which the one now in the files is a copy, is not now considered, because it does not appear to be material. This letter of Norton's and its connection is stated, however, because, in connection with the evidence before stated, as to when he actually produced the patented article, it does appear to be somewhat material. It was introduced by the defendant as evidence. The part relied upon was that inconsistent with what Norton and the plaintiff now claim. But, when so put in, it was legitimate evidence, according to what should appear to be its just weight, as well as to those parts in favor of, as to those against him. This is a well settled rule in respect to evidence of admissions. (*Stead* v. *Heaton*, 4 *T. R.*, 669; *Davies* v. *Humphreys*, 6 *Mees. & Welsb.*, 153; 1 *Greenl. Ev.*, § 201; *Wright* v. *Williams*, 47 *Vt.*, 222.) The letter tends to show that Norton actually had such stamps made in 1858. It was written before there was any controversy as to this fact, and is strongly corroborative of the correctness of the finding, that the invented and patented instrument was brought forward before May 4th, 1859.

The defendant has introduced evidence tending to show that what is claimed to be the same invention was made by various other persons, and put into use at several post-offices, prior to that date even. The most prominent are at the Philadelphia office, by William M. Ireland, in 1851; at the New York office, by James J. Riley, in 1852; at the Cleveland office, by Charles E. Wheeler, in 1853; and, of these, that at the Cleveland office seems to be most confidently relied upon. If the question in respect to use at this office was to be determined upon a fair balance of proof, and upon the parol evidence alone, the balance might turn in the defendant's favor. But, the evidence to defeat the patent, by showing an invention

prior to a clearly established one of the patentee, ought to be as clearly established, to the extent, at least, of removing all fair and reasonable doubts. There is, in the case, important written evidence upon this point, and the whole is to be weighed together. Wheeler himself, on the 28th day of November, 1863, wrote to A. N. Zevely, Assistant Postmaster-General, that he made the invention about the 1st of July, 1861, and that an order from the Department, then issued, led to it. On the 7th day of May, 1864, E. Cowles, postmaster at Cleveland, by whom Wheeler was employed, at his instance, wrote to the Postmaster-General, that the invention was made immediately upon the receipt of an order issued by Postmaster-General Holt. That order was issued at about the time of the invention stated by Wheeler in the letter, and could not have been issued long before. These deliberate statements, made by two persons separately, and at so near the time of the transaction in question, and giving circumstances accompanying it, which, in fact, existed as they stated, and made with a claim of first invention which would interest them to state that the invention was made as early as the facts would warrant, and made in writings now produced, far outweigh, in reliability, statements made wholly from memory, fifteen years later and further from the transaction. Taking the whole into account, the defendant has not shown, by the requisite measure of proof, that Wheeler invented what he did before Norton did what he did.

The direct testimony as to what Riley invented is contradictory and unsatisfactory. Riley testifies that the instrument which he invented was made by Mr. Hoole, who is understood to be the manufacturer of stamps for the New York office. Hoole was sued by Shavor and Corse for infringing this patent, pleaded to the action, and a trial, verdict, and judgment against him were had. He did not show this invention of Riley, which, according to Riley, he must have known of, in that defence. This goes strongly to show that Riley's statements are not correct.

Ireland was a boy fifteen years old, in the Philadelphia

office, in 1851. He was also there in the same employment in 1861. He doubtless did do in 1861 what he says he did in 1851. At this distance of time he may have carried back in his mind what he did, with the associations of 1861, to the same associations existing in 1851. When he made it in 1861 he remarked to others that it was his, without stating that he had made it previously. It is manifestly difficult to distinguish occasions in memory after so great a lapse of time.

Prior to 1860 there was nothing to call the attention of those employed in post-offices imperatively to the necessity of such an invention, while in the latter part of that year the strict requirements of the Department about cancelling postage stamps separately, and the increased use of the mails consequent upon the war in 1861, brought the subject sharply up. This brought out contrivances for the same purpose in post-offices in various parts of the country, and more probably gave rise to those particularly mentioned, as well as to others about which evidence was given, but which have not been particularly discussed here.

There is another consideration bearing upon this branch of the case, which is, that none of the things produced by these persons, if they produced what they say they did, were the same as this patented invention; nor were any of them the equivalent of it in all material respects. The discovery was, not that letters could be postmarked, and the postage stamps cancelled, at one blow; and, if it had been, that mere idea would not have been patentable; and, if that had been patentable to the first discoverer, it would have been anticipated by two prior patents, one of August 9th, 1859, and the other of December 16th, 1862, issued to Norton. But, the patent is for a machine or instrument that will do both of these things at one blow; and the question would be, whether the other machines were like it. In this, the two faces which make impressions are connected by a cross-bar fixed in the middle to a brad-awl handle, on which both are balanced, so that a blow with it will bring both faces to the surface to be stamped, although not aimed so as to strike precisely perpen-

dicularly. In those, a cancelling face was added to the side of a stamp made to be used alone, with the handle all upon that, and nothing to bring the other face down, unless the blow should be so aimed as to bring it to its place. This difference is shown by the evidence to be, as it is plain it would be, quite material. The stamp of the patent of August 9th, 1859, was, in form, open to that objection, as well as to the objection that its canceller was a cutter, which made it undesirable. In the patent of December 16th, 1862, the postmarking and cancelling faces were balanced upon the handle, like those of the patent in suit, but the canceller there was a cutter and the instrument could not be safely used. The invention in controversy combined the advantages of a safe and effective canceller, well balanced on the same handle with the postmarker, for the first time.

The nearest invention to this is Berri's English patent of April 24th, 1860, sealed September 27th, 1860. That seems to embody all the material parts of this one, but was subsequent to it. The patent of Ezra Miller, dated March 22d, 1859, had the acting faces of the stamps balanced in the same way as this, but the handle was like that of a hammer, and the instrument, as a whole, quite different from this.

Upon the whole case it appears that, in fact and in law, Norton was the original and first inventor of this patented invention. That its production did involve the exercise of inventive faculties and skill is apparent from the various steps, trials, and tests by which it was reached, from the fact that so many other patents have been granted upon attempts approaching the same object, without accomplishing it, and from the fact that the patent has sustained a suit for infringement of it against a party using the invention in fulfillment of a Government contract.

This patent was granted while the Act of 1836 and that of 1839, in respect to the defence of public use and sale of the invention, were in force. By the provisions of the Act of July 4th, 1836, sec. 15, (5 *U. S. Stat. at Large*, 123,) it was only public use, or being on sale, with the consent and allow-

ance of the patentee, before the application for a patent, that would defeat the patent. The 7th section of the Act of March 3d, 1839, (*Id.*, 354,) did not change the character of the public use or being on sale that would defeat a patent, but provided that no patent should be held invalid by reason of them, unless "such purchase, sale, or prior use, has been for more than two years prior to such application for a patent." (*Andrews* v. *Carman*, 13 *Blatchf. C. C. R.*, 307; *Elizabeth* v. *Pavement Co.*, 97 *U. S.*, 126.) No use shown, except that at the New York office, was with the knowledge, even, of the patentee. The application was filed January 5th, 1863, so that a sale or use, to defeat the patent, must have been prior to January 5th, 1861, while General Dix was postmaster there. It is not very clear, upon the evidence, that this invention actually got into use there before that time; and this defence, like others of the same class, ought to be made out by clear proof. But, whether it was so in use before that time or not, it is quite clear, from all the circumstances attending the use, whenever it was had, that it was not a public use, within the meaning of the statute, but a private use for testing the invention and informing the inventor as to its perfection and usefulness, with the design, on his part, all the while, to procure a patent for it, if it should prove to be ripe for that purpose. (*Elizabeth* v. *Pavement Co.*, 97 *U. S.*, 126.) The correspondence between the inventor and the postmasters, and between them and the Post-Office Department, abundantly shows this.

If the re-issues are for any other or substantially any different invention from that described in the original, they are unquestionably void. That the specifications or claims of the patent are different, the invention or discovery remaining the same, is of no consequence. The very object of the re-issue is to correct the patent, so as to make it conform to the invention. The principal objection to these re-issues is the specification of a metal canceller in the combination, as well as cancellers of wood or other elastic material. If a metal canceller had not been mentioned nor alluded to, it might well be said

that it did not enter into nor form any part of the conceptions of the inventor; but it was mentioned in the original. It was mentioned as not being so useful or desirable in the combination as an elastic one, but, nevertheless, it was mentioned, as forming a part of an arrangement not patented or desired. The inventor or owner, when the re-issues were applied for, desired it, the invention comprehended it, and the patent was made to cover it. The original patent also mentioned a canceller of any suitable material, as a part of the combination.

It is said, that the title to the re-issue fails because Norton did not own the patent when it was surrendered by and re-issued to him on the 3d day of August, 1869. This fact is sought to be made out by showing that the instrument of re-assignment from Shavor and Corse to him was forged by him, by placing it before and attaching it to the genuine execution by them of another and different instrument, unknown to them. Much testimony and argument have been bestowed upon that question. Whether the instrument was so constructed, or was genuine, it afterwards came to the knowledge of Shavor and Corse, and they settled all their claims to the patent with those persons claiming title to it by virtue of that instrument, upon the basis that the instrument should stand as if valid. This ratified and confirmed it as to them, as good from the beginning, upon just and well-settled principles. But this was not done until after the re-issue, and it is argued that the title at the time of the re-issue had not become Norton's, and that the Patent Office had no jurisdiction to re-issue it to him, and that the plaintiff cannot now be allowed to show title in that way, because he has alleged title by force of the instrument itself, and not by ratification of it. It is, doubtless, true, that a re-issue of a patent to a person not the owner would not affect the title of the owner. The re-issue and title should go together, to make a good title to the re-issue, or, at least, the re-issue should be consented to by the true owner. Here, the title followed the re-issue, and became the same as if it had preceded it, and was consented to by the

true owner, whether Shavor and Corse or Norton. This would seem to make the title to the re-issue good to Norton, in any event. (*Potter* v. *Holland*, 4 *Blatchf. C. C. R.*, 214.) This makes it unnecessary to determine that question of fact, which involves a charge of the commission of a high crime, that cannot be well tried in this collateral way, without danger of doing injustice.

As the instrument became as if good from the beginning, it was well set up and alleged as good, without stating what made it so.

Norton conveyed this and other patents to Helen M. Ingalls. She, for a nominal consideration, conveyed the legal title to them to William W. Secombe, in trust for herself, her sister and her sister's children, with power of management and sale, the net proceeds to be divided, two-fifths to himself and the remainder to be paid over to them, according to a declaration of trust referred to in the deed. Secombe was president of the Secombe Manufacturing Company, which, in some way, held title to some other of Norton's patents. The Secombe Manufacturing Company, and Secombe, president, subsequently made conveyance of patents to Ingalls. The plaintiff derives title from her, and no other conveyance from Secombe to her is shown. The defendant claims that Secombe's title would not pass by that deed, and that, if it would, the description of the patents conveyed does not include this one. The deed recites the issuing of the patents, her desire to purchase, and that she has purchased of the Secombe Manufacturing Company and of William W. Secombe, president, the patents, and declares, that, in consideration of one thousand dollars and other considerations, the said Secombe Manufacturing Company and William W. Secombe, president, do sell, assign and convey them to her; and it was executed by the signature of the Secombe Manufacturing Company, with seal, and by William W. Secombe, president, and another seal. It is obvious that there were intended to be, and were, two grantors in that deed. One was the company, and the other Secombe. The execution for the com-

pany, in the name of the company, was good for the conveyance of its interest. The execution by Secombe, although the addition to his name, of president, was made, was a good execution of the deed for himself, and good for that only, and not good to convey any interest for the company, even though that had been the intention. That execution made the instrument his deed, and it would carry whatever title he had in the subject of the conveyance. (*Combes' Case*, 9 *Co. Rep.*, 75; *Clark* v. *Courtney*, 5 *Pet.*, 319; *Isham* v. *Bennington Iron Co.*, 19 *Vt.*, 230; *Miller* v. *R. & W. R. R. Co.*, 36 *Vt.*, 452; *Brinley* v. *Mann*, 2 *Cush.*, 337.)

The description of the subjects of the conveyance is very general and broad, in some of its parts. It commences by reciting, that, "at various times and under several different dates," letters patent were issued, upon the application of Norton, for "improvements in hand printing and dating stamps, post-office postmarking stamps, internal revenue dating and cancelling stamps, and for other improvements not necessary here to name, among which were letters patent of the following date, to wit, January 14, 1862; December 16, 1862; August 4, 1865; and also during the years 1870 and 1871." It then refers to the deeds of assignment from Norton to Ingalls, among others, for a more full description of the patents conveyed, and ends by adding: "Meaning to convey, and we do hereby convey, unto her, the said Helen M. Ingalls, each and every claim, right, title and interest we now have, or can or would have, in any of said inventions, improvements and letters patent, by means or reason of any contract between us, or either of us, and said Marcus P. Norton and Helen M. Ingalls, or either of them, in, to or for the said inventions and said letters patent, or either of them," &c. The reference to the patents, by stating the inventions covered, includes this one; and it is quite obvious, from the sweeping character of the instrument, that this and all other patents upon those subjects were intended to be included.

It may be, that, as the conveyance was wholly in trust, upon the evidence carefully examined, such refusal to per-

form the trust would appear as to cause the title to revert, and it may be that the interposition of a Court of equity would be necessary for that purpose. But that subject has not been examined here, for the reason that the re-conveyance appears to be amply sufficient.

The defendant also objects, that the plaintiff acquired no such right, by the deed to him from Ingalls, as authorized him to maintain this suit. The conveyance was expressly in trust, upon condition that the plaintiff should have the sole management of the trust, until a fair, just and reasonable settlement should be had with the United States for the use of the invention in the postal service of the United States, by the Post-Office Department. It is argued, that the conveyance was for the purpose of such settlement, and no other. The operative words of the conveyance include the whole legal title to the patent, and all claims for the past use of the invention in the postal service of the United States. The limitation is one of time, upon the extent of the conveyance in that direction, and not upon its purposes. No settlement has been made with the United States, and the limitation in that respect has not expired. She has no legal title to the patent now. The plaintiff's right is the only one being infringed. He holds this right in trust, and may be liable to account for the proceeds of his management; but, whether he shall so account, or how, is not the question here. The question is merely, whether he has sufficient right to maintain the suit at all, and it appears that he has; certainly for the infringement since he has held the title, and the bill does not appear to be framed to cover anything else. Probably, Ingalls would be a proper party plaintiff with the orator, in the suit in equity, and, perhaps, a necessary party, if there had been objection on account of that non-joinder, but no such objection has been made, and, as she has been a witness, and testified that the suit is brought with her approval, there is no occasion for the Court to interfere to secure to her an opportunity to assert her rights, as is sometimes done, in the discretion of

Courts, to guard the rights of *cestuis que trust*, which it is the peculiar province of Courts of equity to protect.

One ground upon which the defendant claims he does not infringe is, that, in all he has done, he has acted as the officer of the Government, in the performance of his duties for the benefit of the Government, and that the monopoly granted, in granting the patent, did not extend to nor cover any use by the Government. But, the exclusive use of the invention granted to the patentee is property; and this property is now owned by the plaintiff. The grant saved nothing for the use of the Government; it was exclusive, absolutely, throughout the United States. It was granted by express law of Congress, pursuant to the Constitution, without which it could not exist. But, all property is upheld by law, either expressly or impliedly enacted or adopted, all of which is the law of the land, the same as the statutes upholding patents are. This property, like all other private property recognized by law, is exempt from being taken for public use without just compensation, by the supreme law of the land. (*Const. U. S., Am., Art. V.*) Nor can it be so taken by any officer, at will, in time of peace, leaving the owner to seek compensation. (*Mitchell* v. *Harmony*, 13 *How.*, 115.) The property in a patented invention stands the same as other property, in this respect. (*United States* v. *Burns*, 12 *Wall.*, 246; *Cammeyer* v. *Newton*, 94 *U. S.*, 225.)

The defendant also claims that he does not use the patented invention. The answer hardly denies that he does, but the plaintiff has so far treated it as being denied as to put in some evidence of infringement. The instruments shown by the evidence to have been used have the postmarking and cancelling faces connected by a cross-piece, and balanced upon a brad-awl handle, substantially like those of the patent. In one, the cross-bar is circular, and large enough to cover both stamps, and in the other the canceller is not tubed; but these things do not vary the principle of their action, nor affect their substantial identity with those patented.

This cause has been presented by counsel with great thor-

oughness of preparation, and faithfulness, and many points have been made that have not been specifically mentioned in what has been written, because none of them, in view of the facts upon which they rest, as found upon the evidence, or of the law as considered to be applicable, would be to a sufficient degree controlling of the conclusions reached upon the questions which have been mentioned, to warrant treatment of them in detail.

The complainant has expressly waived taking a decree for an injunction, and, therefore, a decree for that purpose is not to be entered.

Let a decree be entered that the patent is valid, that the defendant has infringed it, and for an account of profits and damages, with costs.

Marcus P. Norton and *George H. Williams*, for the plaintiff.

Stewart L. Woodford, (*District Attorney*,) and *Samuel B. Clarke*, (*Assistant District Attorney*,) for the defendant James.

THE UNITED STATES STAMPING COMPANY

vs.

HEZEKIAH KING AND OTHERS. IN EQUITY.

The letters patent granted to Eugene A. Heath, October 10th, 1871, for an "improvement in cuspadores," are valid.

The invention covered by the claim of the patent, defined.

Although, in a prior suit on the patent, it had been held invalid, in view of a prior patent, this Court held it to be valid, and granted a preliminary injunction on it, on a different state of facts.

The United States Stamping Company *v.* King.

The invention in the Heath patent held to be patentable.
Grounds stated for granting a preliminary injunction, although the patent had been held void, on final hearing, in another Circuit Court.

(Before BLATCHFORD, J., Southern District of New York, August 23d, 1879.)

BLATCHFORD, J. This is a motion for a preliminary injunction, founded on letters patent granted to Eugene A. Heath, October 10th, 1871, for an "improvement in cuspadores." The specification says: "Be it known, that I, Eugene A. Heath, of New York city, in the State of New York, have invented certain new and useful improvements in cuspadores, of which the following is a specification, setting forth what I consider the best means of carrying it into effect. The accompanying drawing forms a part of this specification. Figure 1 is a vertical section, showing the construction in its proper position; and fig. 2 a double view, the strong lines being a section in an upset or overturned position, and the dotted lines an elevation in its upright position. Similar letters indicate like parts in both the figures. I form separately three metallic parts and unite them, after suitable preparation, tightly and strongly, by soldering. The lowermost, A, is of cast iron, thick at the extreme bottom and thinner toward the top. Its upper edge is rabbeted and nicely finished to receive the lower edge of the sheet metal part B, and form a flush exterior surface therewith, as shown. B is a piece of sheet iron pressed in a Grimshaw press or otherwise formed in the proper dome shape, and of exactly the proper diameter, and with a vertical flange at its upper edge, as shown. C is a conical piece, which may be similarly formed into shape. Its lower edge has a flange which matches closely inside the flanged upper edge of B, and its upper edge is turned over by the ordinary tinsmith's tools or otherwise, and made to embrace a wire ring, D, to stiffen it, the construction of which is obvious. On soldering the several joints smoothly, and properly decorating the surfaces, there results a metallic cuspadore, not liable to fracture, and lighter than ordinary cuspadores on its upper side, and

much heavier than ordinary cuspadores on its lower side. One of the important ends attained by my invention is extraordinary stability. If the cuspadore is upset by any chance and caused to lie for a time in the position indicated by the strong lines in fig. 2, the excess of weight in its base, taken in connection with its form, causes it to return again, of itself, to its proper upright position, as soon as the disturbing cause is removed. I have shown the interior as formed with an offset, below which it is materially thicker than above, and prefer so to cast it. The upper portions may be formed, with some success, by spinning suitable thin brass. The junctions of the several parts may be further secured by causing one part to cling upon a bead, in addition to the soldering. In some cases rivets, or the like ordinary or suitable fastenings, may be employed. I claim a metallic cuspadore having a heavy base, A, and a light upper portion, B, C, formed and combined substantially as and for the purposes herein set forth." It is plain that the invention claimed is a metallic cuspadore, formed of three metallic parts, the lower part being heavier than in ordinary then existing cuspadores, and extending up to the largest diameter of the spheroid, the middle part and the upper part being lighter than in ordinary then existing cuspadores, the middle part being of a dome shape, and being joined below to the lower part and above to the upper part, and the upper part being an inverted cone in shape, flaring outwards, and forming a mouth, the whole structure not being liable to fracture, and having the capacity of returning to an upright position, of itself, from a position not upright, when left free, and being essentially of the form shown in the drawings of the patent. That form is a spheroidal body with a conical mouth, flaring outwards.

Mr. Henry B. Renwick, the plaintiff's expert, says, in his affidavit: "A cuspadore is a vessel of peculiar shape, which may be defined as spheroidal, with a conical mouth, and such vessels were first seen by deponent some twenty-five years since. These and all other cuspadores seen by deponent until the last few years were made of china or porcelain, and came

into use in houses of the better class, where the old-fashioned spittoons were considered vulgar and consequently inadmissible. These china cuspadores were costly and fragile, and, moreover, easily upset, as the base was small as compared with the whole diameter, and as the form of the vessel was flaring outwards and upwards from its base. In this latter respect, that is, want of stability, so far as real utility was concerned, the cuspadore was much inferior to the old-fashioned spittoon, which is so flat and wide-based that it is really unupsettible or non-upsettible by accident, the only way of upsetting it being by taking it by hand and turning it over, or by some other way deliberately contrived for the purpose of upsetting it. * * * Prior to the date of Heath's invention, vessels loaded at the bottom, so as to make them more stable, were well known. * * * It was easy, therefore, after the idea was once conceived, to load a cuspadore at bottom in a well-known way, so as to make it more stable, either by thickening the china at bottom, or cementing a weight into the bottom. But this would not have removed the whole difficulty. It was necessary to make them strong, not frangible like china or porcelain, and to make them cheap; and Heath conceived the idea of constructing them of metal, so that they should be strong, and of constructing them of at least three pieces of metal, so that they should be cheap. Owing to the peculiar form of the cuspadore, it is difficult, if not impossible, to form it of one piece of sheet metal, but Heath saw that, by dividing the body of the cuspadore at the equator, if it may be so termed, it could be formed of two pieces, each having all its flare in one direction, so that such hemispheroidal parts would be easily formed by casting, stamping or spinning. The funnel mouth-piece he then made in a separate piece, and as it, when separate from the body, flares all in one direction, it could be easily and cheaply formed. In forming these pieces, the lower part of the body was made much the thickest, and, when the three parts were put together and attached to each other, there resulted a strong, cheap, metallic self-righting cuspadore, as elegant in

form as those of china, and capable of being decorated, if desired. As far as deponent knows, Heath was the first to make a metallic cuspadore, or a self-righting cuspadore, but he does not claim broadly a metallic vessel in shape of a cuspadore, or a self-righting cuspadore, or a vessel made of three pieces, but the patent defines his invention as consisting in a metallic cuspadore made of three pieces of special form, viz.: one for the bottom of the body, one for the top thereof, and one for the conical mouth-piece, joined at the equator and at the small end of the mouth-piece, when the piece of metal forming the bottom or lower portion of the body is heavier than the other parts, so as to give stability and self-righting capacity. If the cuspadore was made of one piece of metal, it would not be Heath's. If made of several pieces, with the lines of junction in substantially different places from those represented in Heath's patent, it would not be Heath's. For instance, the lines of seam might be vertical and each include a part of the body and of the mouth-piece. Even if the cuspadore was made of Heath's three pieces, formed as he forms them and joined where he joins them, but with the bottom piece no heavier than the others, the cuspadore would not be the one referred to in Heath's claim." The considerations thus set forth commend themselves as founded in good sense and sound reason.

The cuspadore involved in this case as the defendants' cuspadore is made of three pieces of metal, one for the bottom, one for the upper part of the body, and one for the conical mouth-piece. These pieces are shaped as Heath's are, and are joined horizontally at the equator of the body, and at the ring where the conical mouth-piece meets the upper part of the body, as Heath's are. They all flare in one way, have no re-entering angles or curves, being in this respect like Heath's, and can be made easily and cheaply by stamping or spinning. The piece which forms the bottom is a compound piece, a partition being introduced a little above the bottom and parallel therewith, so as to form a chamber over the whole extent of the bottom, the partition forming

the bottom of the receiver. The chamber thus formed is filled with a heavy material, such as iron filings, to serve as a weight. This compound piece is thus, as a whole, thick and heavy, compared with the upper parts. It is, manifestly, the equivalent of Heath's single thick and heavy bottom piece. The structure, as a whole, falls within the definition, above given, of the invention claimed in the Heath patent.

The defendants attack the novelty of Heath's invention. They introduce a patent granted to William H. Topham, August 2d, 1870, for an "improved spittoon." The specification states the invention to be an "improvement in spittoons and other vessels." It says: "My invention is designed to be applied to spittoons, pails and other vessels made of paper, which, owing to the lightness of said material, are liable to be overturned or displaced; and the invention consists in incorporating with the bottom or lower part of the vessel a weight so arranged that, in case of force being applied, no matter from what side, to tilt or upset the vessel, said weight will have the effect of retaining it in its proper position, or of returning it thereto, and so that, when the vessel is thrown down to its place, the weight will cause it to readily adjust itself to a proper bearing on the surface on which it is intended to rest. Referring to the accompanying drawing, A represents a spittoon made of paper, the bottom, *a*, of which is provided with a weight, B, concentrically arranged in relation with said bottom, and preferably disposed between an upper and lower layer used in the construction of the bottom, whereby said weight is protected, and may be retained in place without any special fastenings, and the vessel possesses all the properties and advantages of a paper one, with the stability of one made of heavier material, and readily adjusts itself to a proper position in case of being carelessly thrown down, or of being pushed or tilted from any side. Said weight may be made of any material of suitable specific gravity, the black oxide of iron, among others, answering for such purpose." The claims of the patent are two: "1. A spittoon made of paper, weighted at its bottom or

lower part by a heavier material, to secure its stability, and to enable it to right itself in case of being tilted, substantially as specified. 2. The arrangement of a weight, B, between two thicknesses or layers, of which the bottom, *a*, or lower part of the paper vessel, is composed, essentially as and for the purpose herein set forth." A suit in equity was brought on the Heath patent, in the Circuit Court of the United States for the District of New Jersey, in June, 1875, by Lorin Ingersoll, the then owner of that patent, against Mary Turner and William Turner. They set up the Topham patent, as a prior patent, containing the Heath invention, and alleged that they were licensees under a re-issue of the Topham patent. Proofs were taken, and the case was brought to hearing before Judge Nixon. In his decision he says: "The word *cuspadore* is derived from the Portuguese word *cuspo*, to spit; *cuspidore*, a spitter." The English cuspadore is a spittoon of a peculiar form. Not much stress, therefore, can be laid upon the fact that Topham calls his patent "an improvement in spittoons," and Heath calls his "an improvement in cuspadores." The difference between a spittoon and a cuspadore is one of form, and the form of the cuspadore is not new. The characteristic and valuable feature of both articles is their self-righting quality, arising from the weighted bottoms. The functions of the weighted bottoms in each are the same, and Topham has the merit of being the older. It is in evidence that he made papier maché cuspadores, with weighted bottoms, as early as June or July, 1871, anterior to the date of the patent to Heath. What, then, has Heath done? He has improved a cuspadore by increasing the weight of the bottom, whereby it is rendered less liable to upset, using the same means that Topham applied to spittoons, and producing the same results. He has substituted sheet metal for other and, it may be, less appropriate materials for the manufacture, but there was no invention in the mere change of material; and his method of construction, to wit, the putting together the cuspadore in three pieces, is so obvious, that nothing was claimed for it in the patent; and nothing ought to have been. Any skilled

mechanic would naturally adopt it without the exercise of inventive talent. As the defendants justify under the Topham patent, there must be a decree in their favor, and it is ordered accordingly." This decision was made in June, 1877. There was very little testimony in the New Jersey suit. There was no expert testimony on either side. The date of the Heath patent, October 10th, 1871, was the earliest date assigned to Heath's invention, and it appeared that before that date Topham had made papier maché cuspadores, with weighted bottoms. Now it is shown, in this case, that the application for Heath's patent was filed before Topham made a papier maché cuspadore with a weighted bottom. This condition of the evidence destroys very much the force of the New Jersey decision, and makes it uncertain, at least, what the New Jersey decision would have been, if such evidence had been in that case, and if the expert testimony in this case had been in that case, in view of the facts that the shape and material and mode of construction of the Heath article are so entirely different from the shape and material and mode of construction of the article described in the Topham patent.

It is a striking fact, that, prior to the introduction into use of the Heath metallic loaded bottom cuspadore, there was not on sale, in the market, any metallic loaded bottom cuspadore. The Topham loaded bottom papier maché spittoon is not shown to have suggested to any one the making of a metallic loaded bottom cuspadore like that of Heath's. The metallic cuspadores of Musgrove were not loaded at the bottom, and were merely experimental, and whatever invention there was in them was incomplete and was abandoned. But the history of Musgrove's experiment, as given by himself, goes far to show that the making of Heath's cuspadore was not the obvious thing that it is now, after the event, claimed to have been. Musgrove failed to see what was needed, and, because he so failed, he stopped short of the Heath invention. The Dalby metallic spittoon did not embody the features of Heath's metallic cuspadore. It was not a cuspadore, and was not loaded at the bottom, and was not self-righting, and the

third piece, forming the top, was not joined to the upper part of the body, but rested on it. The Manning tea-pot and the tin pitcher are neither of them loaded at the base, nor are they self-righting, nor did they ever suggest the making of such a cuspadore as Heath's, with a loaded bottom. Many articles had, prior to Heath's invention, been made of three or more pieces of sheet metal joined together by horizontal seams, but the question as to whether it would be useful or practical to make a metallic cuspadore of three pieces of metal in the way suggested by Heath, and with a loaded bottom, still remained for the exercise of invention. The defendants sell cuspadores made by Jewett & Sons of Buffalo, who are licensees under the Topham patent. But Jewett & Sons do not make the structure of Topham. They make substantially that of Heath. The Topham structure is lacking in the essential features of the Heath structure. Topham's spittoon is not a cuspadore, and is not metallic, and is not made of three parts joined together. In Heath's cuspadore the rounded form and the load in the base coöperate to make the structure self-righting. In Topham's spittoon there is no such coöperation between the form and the weighted base, as the sides are nearly straight, and the bottom is not rounded. The porcelain cuspadore, easily upset, easily broken, sure to remain upset when upset, had been in existence for years. Its disadvantages, the desirability of remedying its faulty features, had been obvious for years. But the remedy was not obvious. Topham's structure furnished no remedy, because, although it had a loaded bottom, it was still a spittoon and not a cuspadore, and had not the points of advantage which the porcelain cuspadore had, in union with its disadvantages. Nor did any remedy come till Heath's cuspadore came. Topham, on the 29th of July, 1873, obtained a re-issue of his patent, with broader claims than those of his original patent, not confining his invention, as in the original, to vessels made of paper, but extending it to all spittoons or similar vessels weighted at the bottom. Whatever may be the force of the re-issued patent in suits brought on it, it can have

no effect as against the Heath patent, in this suit, because it is subsequent to that patent. A re-issued patent has the same effect and operation in law as though it had been originally filed in the corrected form, only on the trial of actions brought on it for causes thereafter arising, and has no such effect in any other case or for any other purpose. (*Act of July 8th*, 1870, § 53, 16 *U. S. Stat. at Large*, 205; *Rev. Stat. U. S.*, § 4,916.)

The Heath cuspadore was first introduced into the market in the summer of 1871. It was immediately appreciated by the public. In the first season 20,000 were made; in the second, 40,000; in the third, over 80,000. Since that they have been sold in large and increasing numbers, and have been constantly growing in favor with the public. This result, in connection with all the differences, before adverted to, between the Heath cuspadore and prior structures, leads to the conclusion that the invention claimed in the Heath patent is a patentable invention, and that the patent is valid. The case falls within the principles laid down in *Smith* v. *Goodyear Dental Vulcanite Co.*, (3 *Otto*, 496,) and in *Hicks* v. *Kelsey*, (18 *Wallace*, 670.)

It is urged, that, as the decision in the New Jersey case was one on final hearing, this Court ought, on a motion for a preliminary injunction, to follow it, from comity, until it is overruled by the Supreme Court. But, in addition to the suggestions before made, in regard to the New Jersey suit, it appears that a large number of suits have been brought on the Heath patent, and that in none of them but the New Jersey suit has there been a decision against the validity of the patent. In some of these suits the defendants have submitted to injunctions after investigating the subject. In two suits at law the plaintiff recovered against such defences as were set up. In several suits in equity there have been injunctions and decrees for the plaintiff. This court, in *Ingersoll* v. *Benham*, (14 *Blatchf. C. C. R.*, 541,) decided that the Topham patent did not show the combination covered by the Heath patent. The Manhattan Brass Company took a license

under the patent for a royalty. Several firms started to manufacture the cuspadores, but, on being notified that they would infringe the patent, they abandoned the manufacture. Some of these firms had licenses under Topham's re-issued patent. No one is now infringing the patent, by manufacturing the Heath cuspadore, except the Turners and Jewett & Sons. The Meriden Britannia Company was enjoined and then took out a license. All these considerations make a case in which it is proper to grant a preliminary injunction.

In a direct suit brought by the owner of the Heath patent, for an infringement, against Jewett & Sons, in the Northern District of New York, (*Ingersoll* v. *Jewett*, 16 *Blatchf. C. C. R.*, 378,) it has been decided by Judge Wallace, that the decision in the New Jersey case cannot avail Jewett & Sons as a plea of *res adjudicata* or estoppel. That decision must control, on that question, at this stage of this case.

The questions on which this motion turns, are questions of law as to the construction of the Heath specification and as to the patentability of the invention. There is no disputed question of fact to be elucidated by the taking of plenary proof for final hearing.

The technical point is made, that the only infringement shown is the sale by the defendants of two cuspadores, prior to the assignment of the patent to the plaintiff. This is so. But, the case has been argued on the part of the defendants on the assumption that such sale took place after the assignment to the plaintiff, which was March 4th, 1879, and the date of the jurat to the bill, which was March 5th, 1879, and on the assumption that the defendants have continued to sell the infringing cuspadores.

I have examined this case with care, and the more because of the views expressed by my brother Nixon, and have arrived at the undoubting conviction that the plaintiff is entitled to an injunction. It is, therefore, granted.

Frederic H. Betts, for the plaintiff.

Charles F. Blake, for the defendants.

JOHN J. SCHILLINGER

vs.

HERMANN A. GUNTHER. IN EQUITY.

A concrete pavement, made of cement, sand and gravel, made plastic by water and then laid in blocks, in a plastic state, at the place where it is to be used, and suffered to set or harden there, is not anticipated by a pavement made of blocks of cement made elsewhere, and then laid, like bricks or flags, at the place of use.

Under §§ 4,917 and 4,922 of the Revised Statutes, where a proper disclaimer is entered during the pendency of a suit on a patent, there may be a recovery for the plaintiff, in respect of what is not disclaimed, provided there has been no unreasonable neglect or delay to enter a disclaimer, but the recovery is to be without costs.

There may be a disclaimer of something which was introduced into a re-issued specification and did not exist in the original specification.

In connection with a disclaimer of a claim or part of a claim, it is not improper to eliminate or withdraw, by the same writing, the parts of the body of the specification on which the disclaimed claim or part of a claim is founded.

The disclaimer in this case upheld, against the objection that the matter disclaimed was not introduced by mistake, but with the intent to defraud or mislead the public.

(Before BLATCHFORD, J., Southern District of New York, August 26th, 1879.)

BLATCHFORD, J. The defendant contends, that the first claim of the plaintiff's re-issued patent is for a concrete pavement laid in detached blocks or sections, and that such claim is void, because blocks of cement had before been made, and carried to the place where they were to be used, and laid down side by side, thus forming a sectional cement pavement having all the advantages of the plaintiff's pavement. This view is not sound. The first claim of the re-issued patent claims "a concrete pavement, laid in detached blocks or sections, substantially in the manner shown and described." The concrete pavement referred to is shown by the specification to be a pavement made not of cement alone, but of cement,

sand and gravel, made plastic by water, and then laid, in blocks, in a plastic state, at the place where it is to be used, and suffered to set or harden there. This is a different thing from blocks of cement made elsewhere, and then laid, like bricks or flags, at the place of use.

Equally unsound is the view, urged by the defendant, that the disclaimer takes out of the patent the entire first claim of the re-issue. It takes out of that claim only so much thereof as claims a concrete pavement made of plastic material laid in detached blocks or sections, without interposing anything between their joints in the process of formation. The first claim originally included a concrete pavement made of plastic material laid in detached blocks or sections, without interposing anything between their joints in the process of formation. The first claim, as amended by the disclaimer, claims a concrete pavement made of plastic material laid in detached blocks or sections, when free joints are made between the blocks, by interposing tar paper or its equivalent.

The alleged prior inventions of Russ and Little have been disposed of by the rulings of Judge Shipman in this case, and so has the question of the infringement by the use of a trowel or a knife.

By § 4,917 of the Revised Statutes, which was in force when the disclaimer in this case was filed in the Patent Office, it is provided as follows: "Whenever, through inadvertence, accident or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be

considered as part of the original specification to the extent of the interest possessed by the claimant, and by those claiming under him, after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it." By section 4,922 it is provided as follows: "Whenever, through inadvertence, accident or mistake, and without any wilful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof which was *bona fide* his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But, in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered, unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer." The purport of these two sections, taken together, is, that, where a proper disclaimer is entered during the pendency of a suit on a patent, there may be a recovery for the plaintiff, in the suit, in respect of what is not disclaimed, provided there has been no unreasonable neglect or delay to enter a disclaimer, but the recovery is to be without costs. In the present case a proper disclaimer was entered after the suit was commenced. It disclaims certain words in the body of the specification, and it also disclaims a part of what was claimed in the first claim of the re-issued patent. What is disclaimed in the body is the foundation of so much of the first claim as is disclaimed. The plaintiff was neither the original nor the first inventor

of so much of the first claim as is disclaimed. What is thus disclaimed is a material and substantial part of what is covered by the first claim. The part of such claim which is not disclaimed is truly and *bona fide* the plaintiff's. What is not disclaimed is definitely distinguishable from what he claimed without right. He did not choose to claim or to hold by virtue of the re-issued patent wha the disclaimed. What he disclaimed was inserted by the re-issue. It did not exist in the original patent. But, for the purposes of a disclaimer, what is disclaimed stood, before it was disclaimed, as if there never had been but one patent, and that the re-issued patent. It was proper to correct, by a disclaimer, the unlawful claim introduced by the re-issue. It is true, that, strictly, § 4,917 contemplates only a disclaimer of some claim, or part of a claim, but, in connection with a disclaimer of a claim, or of a part of a claim, it is not improper to eliminate or withdraw, by the same writing, the parts of the body of the specification on which the disclaimed claim, or part of a claim, is founded. The disclaimer is none the less a disclaimer of a claim or of a part of a claim because, in addition, it disclaims such parts of the body of the specification. The disclaimer being a proper one, in form and substance, it is, by the statute, to be, after its filing, "considered as part of the original specification." The re-issued specification is to be thereafter read as if the disclaimer were incorporated in it.

But, no disclaimer can be allowed to be operative, unless the unlawful claim was made through inadvertence, accident or mistake, and without any fraudulent or deceptive intention, nor can a plaintiff recover on a patent which claims anything not *bona fide* the patentee's, unless the claim to the thing not *bona fide* his was made through inadvertence, accident or mistake, and without any wilful default or intent to defraud or mislead the public. It is set up in the amended answer, that the part of the thing patented which is disclaimed by the disclaimer, was not introduced into the re-issued patent "through inadvertence, accident or mistake, and without any wilful default or intent to defraud or mis-

lead the public," but, on the contrary, was introduced into it "deliberately and with the intent to defraud or mislead the public." I have arrived at the conclusion, on the evidence, that the disclaimed parts, both of the body of the re-issued specification, and of the first claim thereof, were introduced by reason of a mistaken idea on the part of the plaintiff, that the concrete, in setting, would shrink, so that the second block, when set, would not, though setting in contact with the first set block, adhere to such first set block, and that it was not necessary, in forming the blocks from the plastic material, to interpose anything between their joints, in the process of formation, in order to produce the detached blocks or sections described in the specification. I am also of opinion, on the evidence, that there was no wilful default, or fraudulent or deceptive intention, or intent to defraud or mislead the public, on the part of the plaintiff. The evidence shows, that the plaintiff believed, when he took the re-issue, that a sectional pavement could be made of plastic concrete, without interposing anything between the blocks. He may not have experimented as much as he ought to have done before arriving at that conclusion. He may have arrived at it on insufficient and inadequate grounds. Still, if he acted in good faith, it was a mistake. If he made experiments and drew a conclusion from them, not wholly baseless, it was not a wilful default, although other persons may, from other information, have been of a different opinion, and although other persons would have been slow to draw the same conclusion the plaintiff did from the premises before him. So, too, although the experiments and the conclusion were made and arrived at after the original patent was taken out, in such wise as to destroy the validity of the re-issue so far as such conclusion was concerned, it was proper to make the disclaimer in question, in order to avoid the effect of inserting in the re-issue matter which amounted, if true, to an invention made after the granting of the original patent. The plaintiff states, in his affidavit made November 22d, 1878, that he has never known any cement pavement constructed in sections

formed on the ground for actual use in outdoor work, without the interposition of something while the material was in a plastic state, to form or complete the joints. There is nothing in this that is inconsistent with his statement in the same affidavit, that he believed, when he took his re-issue, that the concrete, in setting, would shrink, and that, after one section had been formed, another section might be formed of the plastic material directly against and in contact with the one already formed, and the blocks, when completed, would be detached; nor anything inconsistent with the fair result of the evidence. The experiments on which he rested his belief were not pavements in sections formed on the ground for actual use in outdoor work. As to the conversations with the plaintiff, testified to by witnesses, they are too vague and unreliable to be satisfactory. The fact that the plaintiff, in the fall of 1874, laid, in Washington, from 2,000 to 3,000 square feet of concrete pavement in sections, without anything being interposed between the blocks, with the intention that it should be a pavement of detached blocks, such as his specification describes, shows that he had not, at that time, abandoned the idea that a pavement of detached blocks could be made in that way. It was not till January, 1875, that it clearly appeared that such pavement was a pavement of adhering blocks and not a pavement of detached blocks.

The foregoing observations serve to show that there was no unreasonable neglect or delay in not filing until March 1st, 1875, the disclaimer in question.

The remaining defence set up in the amended answer is founded on the first subdivision of § 4,920 of the Revised Statutes, and is to the effect, that, for the purpose of deceiving the public, the description and specification filed by the patentee in the Patent Office, and which is contained in the re-issued patent, was made to contain less than the whole truth relative to his alleged invention or discovery, or more than is necessary to produce the desired effect, and that the patent is, therefore, void. This defence fails, because, as has been held, there was no purpose of deceiving the public; and,

also, because the disclaimer being now a part of the specification, the specification is not open to the alleged objection.

The defences set up are overruled as not sustained by the evidence, and a decree to that effect will be entered.

Edward Fitch and *John Van Santvoord*, for the plaintiff.

Arthur V. Briesen, for the defendant.

In the Matter of Harvey Morse, an alleged Bankrupt.

An amended petition in involuntary bankruptcy cannot set forth, as part of the indebtedness to the petitioning creditor, a promissory note, endorsed by the debtor, which did not fall due until after the original petition was filed.

The District Court overruled a demurrer to an amended petition in involuntary bankruptcy, without prejudice to an application for leave to answer, on showing satisfactory cause therefor. Such application was promptly made, with the proposed answer duly verified, alleging defences which the debtor was entitled to try and prove, but the application was refused: *Held*, that, in analogy to the practice laid down in Rule 34 in equity, it ought to have been granted.

(Before Blatchford, J., Northern District of New York, August 28th, 1879.)

Blatchford, J. This is a petition praying for the review and reversal of an order made by the District Court, March 11th, 1879, overruling a demurrer to an amended creditors' petition in bankruptcy, and ordering an adjudication in bankruptcy, and a reference of the case to a register. The original creditors' petition was filed by a single creditor, the Farmers' Bank of Fayetteville, August 9th, 1878. On the 5th of March, 1879, the District Court made an order dismissing said original petition, with costs, unless an amended petition should be filed, within ten days from that date, by the said

petitioning creditor and other creditors constituting the number and amount of creditors required by the bankruptcy Act to procure an adjudication in bankruptcy. On the 11th of March, 1879, the said petitioning creditor filed an amended petition, not joining any other creditor. The petition was verified March 10th, 1879. It sets forth, as the indebtedness to the petitioning creditor, three promissory notes endorsed by Morse, and alleges that Morse was duly charged as endorser on each of them. One of the notes, for $500, fell due June 14th, 1878; one, for $300, fell due July 14th, 1878; and the third, for $500, fell due August 14th, 1878, which was after the original petition in bankruptcy was filed. The amended petition sets forth the filing of the original petition, and the filing of an answer thereto by Morse, and alleges that it was held that the petitioner did not constitute the requisite amount to authorize an adjudication of bankruptcy, and that such amended petition is prepared as an amended petition. To said amended petition Morse interposed a demurrer, upon the grounds (1) that it appears that said petition is founded in part upon promissory notes endorsed by Morse, maturing and protested after the filing of the original petition in bankruptcy; (2) that said petition does not show or state an indebtedness upon which a petition in bankruptcy could be maintained at the time of filing the original petition in bankruptcy, or when the bankruptcy Act was repealed. On the hearing, the District Court made the said order of March 11th, 1879.

I have not been furnished with a copy of any decision giving the views of the District Court, and am compelled to the conclusion that the order in question was erroneous and must be reversed. The statute in regard to involuntary bankruptcy, (*Act of June 22d*, 1874, § 12, 18 *U. S. Stat. at Large*, 180,) provides, that any person "owing debts, as aforesaid," who shall do so and so, "shall be deemed to have committed an act of bankruptcy, and, subject to the conditions hereinafter prescribed, shall be adjudged a bankrupt on the petition of one or more of his creditors, who shall constitute

one-fourth thereof, at least, in number, and the aggregate of whose debts provable under this Act amounts to at least one-third of the debts so provable." The section goes on to provide for the filing, by the debtor, of a list of his creditors, with "the sums due them respectively." The expression, "owing debts, as aforesaid," refers to the words, in § 5,014 of the Revised Statutes, (*Act of March 2d*, 1867, § 11, 14 *U. S. Stat. at Large*, 521), "owing debts provable in bankruptcy," or "owing debts provable under this Act." The meaning of the statute is, not merely that the debts shall be of a provable character, or shall be at some time provable, but that they shall be debts provable at the time the petition is filed, and made provable at that time by the statute. The whole subject of provable debts is regulated and covered by §§ 5,067, 5,068, 5,069, 5,070 and 5,071 of the Revised Statutes. It was originally provided as follows, by § 19 of the Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 525 :) "All debts due and payable from the bankrupt *at the time of the adjudication of bankruptcy*, and all debts then existing, but not payable until a future day, a rebate of interest being made when no interest is payable by the terms of the contract, may be proved against the estate of the bankrupt." It was held by judicial decisions, that the words, "at the time of the adjudication of bankruptcy," meant "at the time of the commencement of proceedings in bankruptcy;" and that time was the time of the filing of the petition. (*Act of March 2d*, 1867, § 38, 14 *U. S. Stat. at Large*, 535; *Rev. Stat. U. S.*, § 4,991.) Accordingly, in § 5,067 of the Revised Statutes, the above provision of § 19 of the Act of 1867 was re-enacted in these words: "All debts due and payable from the bankrupt *at the time of the commencement of proceedings in bankruptcy*, and all debts then existing, but not payable until a future day, a rebate of interest being made when no interest is payable by the terms of the contract, may be proved against the estate of the bankrupt." The same § 19 of the Act of 1867 went on to provide as follows: "If the bankrupt shall be bound as drawer, indorser, surety, bail or guarantor, upon any bill,

bond, note, or any other specialty or contract, or for any debt of another person, and his liability shall not have become absolute *until after the adjudication of bankruptcy*, the creditor may prove the same after such liability shall have become fixed, and before the final dividend shall have been declared." This provision was re-enacted as follows, in § 5,069 of the Revised Statutes: "When the bankrupt is bound as drawer, indorser, surety, bail or guarantor, upon any bill, bond, note, or any other specialty or contract, or for any debt of another person, but his liability does not become absolute *until after the adjudication of bankruptcy*, the creditor may prove the same after such liability becomes fixed, and before the final dividend is declared." It is declared, by § 5,072, that "no debts other than those specified in the five preceding sections shall be proved or allowed against the estate." The present case does not fall within § 5,070 or § 5,071. It does not fall within § 5,068, for, although an endorsement of a note by a bankrupt is a contingent liability contracted by him, it is "herein otherwise provided for," that is, in § 5,069. In § 19 of the Act of 1867, what is now found in § 5,069 of the Revised Statutes preceded what is now found in § 5,068 of the Revised Statutes. The endorsement of a note falls distinctly within § 5,069. It does not become a *debt*, within the meaning of § 5,067, until the liability of the endorser by reason of it becomes absolute or fixed. Until then it is not a debt "due and payable from the bankrupt." If the liability of the endorser does not become absolute or fixed until after the commencement of proceedings in bankruptcy, the endorsement cannot be a debt "due and payable from the bankrupt at the time of the commencement of the proceedings in bankruptcy," nor can it be a debt "then existing but not payable until a future day," within the meaning of § 5,067. The words, "the adjudication of bankruptcy," in § 5,069, must be held to mean "the commencement of proceedings in bankruptcy," as was the case with the like words in the clause of § 19 of the Act of 1867 which is now found in § 5,067 of the Revised Statutes. The endorsement which matured in this case

on the 14th of August, 1878, became a provable debt then, under § 5,069, if the endorser was then properly charged, but it was not a provable debt when the proceedings in bankruptcy were commenced. They were commenced when the original petition was filed. The amended petition is the original petition amended. It has relation to the time of the filing of the original. A new bankruptcy proceeding was not commenced by the filing of the amended petition. The proceeding commenced by the filing of the original petition was continued and proceeded with by the amendments made to it by the amended petition.

It is entirely clear, therefore, that the demurrer to the amended petition ought to have been sustained, on the ground alleged in the demurrer, that such amended petition was founded in part upon a promissory note endorsed by the alleged bankrupt, maturing after the original petition in bankruptcy was filed. The averments in the amended petition are to the effect that the debts set forth, of which such note is one, are provable under the statute against Morse, and that it requires all the debts so set forth to make up one-third of the debts provable under the statute.

An order must be entered reversing said order of March 11th, 1879, with costs to Morse in this Court; and directing the District Court to enter an order allowing, with costs to Morse in that Court, the demurrer to the amended petition, and vacating the adjudication in bankruptcy and the reference to the register, and all subsequent proceedings founded thereon; and also directing the District Court to take such further proceedings in the matter as shall be proper.

There is, also, a petition for the review and reversal of an order made by the District Court, April 1st, 1879, denying a motion by Morse for leave to withdraw said demurrer and to answer said amended petition. The order overruling the demurrer stated that it was made without prejudice to an application for leave to answer, upon showing satisfactory cause therefor. The application was promptly made. I think that it should have been granted, in analogy to the practice laid

down in Rule 34 in equity. The proposed
ified, was presented in connection with the
in the record. It alleges defences which M
to try and prove. An order must be ente
order of April 1st, 1879, with costs to Morse in this Court.

Kennedy & Tracy, for Morse.

James B. Brooks, opposed.

The W. E. Gladwish, The F. B. Thurber and The Francis King.

A person who ships cargo by a barge which he knows must be towed to her place of destination, is bound by the terms of towage which the barge agrees on with the tug which the barge procures to tow her.

If the barge is sunk and the cargo is lost, by contact with ice, while the barge is being towed by the tug, the owner of the cargo must show negligence on the part of the tug, in order to recover against it for such loss.

It was held not to be negligence in the tug to keep on, after reaching ice, instead of lying by, or making a harbor; that the towing hawser was not too long; that the speed was not too great; that nothing could have been done by the tug to avoid the danger, when the obstruction which actually caused the loss was seen; and that the barge and the vessels in the tow with her were not improperly arranged.

To make the tug liable for keeping on, it must appear that the error was one which a careful and prudent navigator, surrounded by like circumstances, would not have made.

The judgment of witnesses as to speed, formed long after the event, and not based upon anything which specially attracted attention at the time, is rarely to be depended upon.

(Before Waite, Ch. J., Southern District of New York, August 28th, 1879.)

This was an appeal by the libellant from a decree of the District Court, in a suit *in rem*, in Admiralty, dismissing the

libel. This Court found the following facts: "The Eastern Transportation Line, having its office in the city of New York, was engaged in the business of towing boats and vessels for hire, between New York and ports on Long Island Sound, and elsewhere. It was the owner of various tug boats, employed in its business, and, among others, the W. E. Gladwish, the F. B. Thurber and the Francis King. The A. W. Humphreys was a barge, or canal boat, owned by her master, James McKeag, and engaged in the business of transporting goods by water, for hire. She had no motive power of her own, but was towed from place to place by tugs employed for that purpose, as occasion required, by her owner, who was an experienced boatman. He had often been towed by this line. At some time before March 8th, 1875, the barge had been towed by one of the tugs of the line from New York to New Haven, under a contract to take her to New Haven loaded, and back light, for fifty dollars. She had the privilege of bringing back a load, if she chose, and, in that case, was to pay fifteen cents additional per ton for her load. No particular time was specified for her return, but she could come back at any time she was ready and the Line had a tug at New Haven that could take her. She staid at New Haven about four weeks, and, while there, took on board 360 pairs of car wheels, weighing 160 tons, belonging to the libellant, which she agreed to carry to Elizabethport, New Jersey, and there deliver to the Central Railroad Company of New Jersey, "dangers of the seas excepted," the consignors paying freight. A bill of lading in the usual form, bearing date February 27th, 1875, was signed by the master and owner. The tug Francis King arrived in New Haven, from New York, with a tow, on the morning of the 8th of March, 1875. She had been detained a long time on her voyage by the ice, which was found very thick west of Norwalk. The King started from New Haven, on her return voyage to New York, in the afternoon of the day she arrived, with a tow consisting of the Humphreys and ten canal boats. The Humphreys only had a load. All the other boats were light.

The capacity of the Humphreys was about three hundred tons, but she had on board only the car wheels. She was taken in the tow at the express request of her captain and owner, he selecting that time to go back, under his original contract. When he made his request, he well understood that there was ice in the Sound, and that the King had with much difficulty made her way through it from New York. He took the line from the tug, when the tow was made up, with a full knowledge that he might, and probably would, encounter difficulties from the same cause, on his way to New York. The libellant took no part in the contract for towage. It was known, however, that the barge must be towed when she did go. The time of starting was left entirely to the barge, though the agent of the libellant was desirous that she should deliver her cargo at its destination as soon as possible, and so informed her captain. The tow was made up, on the start, in two lines, side by side, and towed with hawsers astern. As the Humphreys was loaded, she was placed in the front tier and on the port side. It would have been unsafe, under the circumstances, to have towed her astern of the light boats. No objection was made by the captain of the Humphreys, or any one else, either to the length of the hawsers put out from the King, or to the arrangement of the tow. No ice was encountered, after leaving New Haven, that caused any detention, until some time during the night. The tow was then in the Sound, about opposite Norwalk. After a time, the tow was arranged in single file, the Humphreys still being the forward boat. The King kept on the best way she could, at no time attempting to return or make a harbor. During the 9th of March she sometimes loosened herself from her tow, went ahead and broke a channel, and then came back and took the boats forward in detachments of three or four at a time. At one time the ice was found so heavy and compact that she was compelled to lie by and wait for a change of tide to loosen it. On the change of tide she started again, and worked her way slowly along until about four o'clock in the afternoon, when she was

a few miles to the eastward of Execution Light. During all this time the weather was fine, without wind, and of a character to soften the ice. On the morning of the 9th of March, the president and superintendent of the Line started out from New York, with the tugs Gladwish and Thurber, for the relief and assistance of the tows in the ice. Some of these tows were on their way east from New York, and the King was known to have started from New Haven. These tugs met the King, to the eastward of Execution Light, about four o'clock, P. M. They there arranged themselves so that all three should take hold of the tow together. The Gladwish took the lead, the Thurber followed, and then the King. Another hawser was then put out from the King to the Humphreys, and from that time the tugs made the tow with a double hawser. The length of the hawser was not unusual. It was seen and not objected to by the captain of the Humphreys, who was all the time on his boat, steering and watching the navigation. His boat was still ahead, and the tow was still arranged in single file. After the tow was thus made up, the tugs proceeded through channels in the ice, which had been made or formed by steamers on their trips in and out of New York. These channels were generally crooked and of varying widths, from forty feet upwards, filled with broken ice. Sometimes, large cakes of floating ice were found, but, in this particular, it did not differ materially from what had been encountered before. Shortly after passing Execution Light, a small space of open water was found. The ice channel formed by the steamers led into this open space from the eastward, and again out of it toward the west. On reaching this open space, the engine of the King was stopped, and that of the Thurber slowed, the Gladwish only keeping up her full speed. She was the most powerful boat of the three, and still ahead. Not long after the tugs passed out of this open space, and while, perhaps, some of the boats of the tow were still in it, the propeller A. C. Barstow came up from New York, on her way to Providence. Noticing the tugs approaching with their tow, she took the south

side of the ice channel. The tugs at the same time went to the north. The propeller, finding a place in the solid ice which had been broken, further to the southward than the general line of the channel, forced herself into that. Between her and the tugs with their tow were large quantities of broken ice, packed together. After she got into this widened space, she put herself against the solid ice on the south and waited for the tow to pass, as it was not safe to attempt to go by in the narrower parts of the channel. While she lay there, the propeller City of New Bedford came along, bound from New York to New Bedford. She passed north of the Barstow and south of the tow, at a speed of six or seven miles an hour, cutting through the packed ice to reach the narrow channel astern of the tow and ahead of the Barstow. While the tow was passing these propellers, the Humphreys was struck in the port bow, a little distance from the stem, by a large cake of floating ice that had in some way been set in motion. A large hole was made in her side by the collision, and she soon filled and sank with her cargo. The tugs were then making their way, with the tow, through the channel, filled as it was with broken ice, at the rate of two or three miles an hour. The engine of the King was not moving and the Thurber was at half speed only. The piece of ice which struck the Humphreys was seen in motion from the King, but the tugs were not stopped, and nothing could then have been done to stop, or change the course of, the ice, so as to avoid the collision. The captain of the Humphreys had been at the wheel, doing what he could to steer her, as she followed the tugs, until just at that time, when he left the wheel-house to go to his supper. As soon as the collision occurred and its effect was known, the tugs were stopped on a signal from the King, and the King, letting go the hawser ahead, backed down to the Humphreys, to render what assistance she could. She had barely time to take off the captain and his family before the Humphreys went down. The other boats in the tow were taken in safety to New York. The

tugs were all properly equipped, and navigated by competent and faithful officers and men."

Welcome R. Beebe and *John McDonald*, for the libellant.

Robert D. Benedict, for the claimant.

WAITE, Ch. J. The contract for the transportation of the car wheels was between the libellant and the barge only. The tugs are in no way responsible to the libellant for the performance of that contract. Their liability is under their contract of towage only, as to which the libellant is bound by the terms agreed on by the barge. As it was known, when the cargo was shipped, that the barge would be towed to her place of destination, the shipper, in the absence of anything to the contrary, is presumed to have left the time and the manner of the towage to the discretion of those in charge of her navigation.

There can be no recovery in this action except for negligent or unskilful towing. The tugs did not, by their contract, insure the safe delivery of the cargo at the end of their route. Their agreement was to tow the barge, and, in so doing, to use such care and skill as a prudent man would exercise, under like circumstances, in the management of his own business. The law implies that their care and attention were to be in proportion to the dangers encountered and the consequences of neglect. This is but common prudence. The greater the risk, the greater should be the effort to avoid it. The burden of showing negligence is on the libellant. The mere fact of sinking the cargo is not enough. Actual fault, contributing to the loss, must be proven.

The specific allegations against the tugs are, in effect, (1.) that they kept on, after reaching the ice, without lying-by, or making a harbor; (2.) that the hawsers between the King and the Humphreys were too long for safety; (3.) that the speed was too great when the collision occurred; (4.) that, when the obstruction which actually caused the loss was

seen, the tugs were not stopped and no efforts made to avoid the danger; and (5.) that, after the Gladwish and the Thurber arrived, the tow was not divided and a part given to each tug to take on by itself. These will be considered in their order.

(1.) As to not making a harbor. The master of the barge, by electing to go back with the King, when he knew that ice would probably be encountered on the way, in legal effect assumed, for the barge and her cargo, all the risks of towage in the ice, not caused by the neglect or unskilful navigation of the tugs. The contract was for such a degree of caution and skill as was required for towage under such circumstances. There was no obligation to return to New Haven, or seek some other harbor of refuge, simply because ice was found in the way. All parties anticipated, when they started, that ice would be found, and that, for some part of the distance, the dangers incident to towage under such circumstances would be encountered. The object was to get through such ice as they might meet, not to wait for it to melt. The tugs undertook to bring to this work such prudence and such nautical skill as was ordinarily required in such navigation. More was not contracted for, and more was not expected.

When the ice was reached, it became necessary to decide whether to lie by or go on. This involved the exercise of judgment as to what ought to be done under the circumstances. A mere mistake is not enough to charge the tugs with any loss which followed. To make them liable, the error must be one which a careful and prudent navigator, surrounded by like circumstances, would not have made.

The facts are, that the weather was fine, the sun warm, and the ice apparently yielding. There was no wind, and nothing seemed to be in the way of going on but the melting ice, much broken, and with many openings through which the tow might, to all appearances, be taken in safety. The King, which was then alone, had come through the same or like obstructions the day and night before, with a tow of loaded boats, and there was nothing whatever to indicate that

a return voyage, with the tow taken on at New Haven, might not be made with equal safety. Propellers and steamboats had been for some time passing and repassing without serious damage, and every day the navigation seemed to be improving. In view of these facts, I cannot believe that ordinary prudence required an abandonment of the voyage for the time being, by lying up, or seeking a harbor. The tug was commanded by a competent master, and the captain of the barge was an experienced boatman. No objection was made by any one to going on, and it is evident that no person connected with the tow considered it necessary to stop. The progress made was slow and difficult, but all seemed to think there was no way but to keep on and do the best that could be done.

(2.) As to the length of the hawsers. It is not easy to tell, from the evidence, precisely what the length was, but that it was not at the time believed to be unsafe or unnecessarily long is shown by the fact that no one complained of it before the accident. And, in this connection, the conduct of the master and owner of the Humphreys must not be overlooked. He had long experience and had been often towed through the Sound. His barge had been the head boat from the start. He had been watching the progress of the tow from the time it came into the ice. He was in a position to see if there was anything wrong either in the arrangement of the boats, or the management of the tug, and, it is impossible to believe, that, if he had considered the hawsers too long, he would not, in some form, have made known his dissatisfaction. I am satisfied, from the evidence, that the length was not materially increased after the Gladwish and the Thurber took hold; and, down to that time, the hawser had certainly done its work well. All the boats had been brought in safety a long distance, through crooked channels and difficult passages. Under these circumstances, it seems to me clear, that there could have been no such error in judgment, in this particular, as to make the tugs liable.

(3.) As to the speed. It is impossible to say at what pre-

cise rate the tow was moving, but it is certain that the engine of the King was stopped, and that of the Thurber slowed down to half speed; that the Gladwish found it difficult to use her full power, on account of the choking of some part of her machinery by the ice; that the channel, most of the way, was narrow and filled with broken and floating ice; and that the tide was against the tow. With all these difficulties, it seems to me impossible that the general speed at the time was such as to be unsafe. The judgment of witnesses in such matters, formed long after the event, and not based upon anything which specially attracted attention at the time, is rarely to be depended upon. It is always safer to look at the facts as they are known to have occurred, and judge from them.

(4.) As to avoiding the ice that inflicted the injury. After a careful consideration of all the evidence, I am satisfied the collision which caused the loss was not with fixed ice, but with a large cake of ice which was itself in motion. The accident happened while the tow was in the vicinity of the propellers Barstow and City of New Bedford. Precisely how far they were away, is left somewhat in doubt, but, notwithstanding some conflict in the evidence, it seems to me clear that the intervening ice was not solid or stationary, but broken and floating. There undoubtedly were large pieces mixed with the mass, but none of it was what could be denominated fixed ice. The Barstow, until she came to a full stop, was working her way along and up against the solid ice. This would not have been necessary, if, as is contended, there had been a large field of solid ice, two or three hundred feet in width, between her and where the tow was to pass. The City of New Bedford passed the Barstow and the tow, by working her way through the intervening ice to the channel the tow had left. This indicates, beyond all doubt, that, while the pieces may have been packed closely together, the mass was not solid. Such being the case, it is easy to see, that a propeller, in passing along, would set the pieces, to some extent, in motion. Either the propellers or the tow had to move, in

order to get by. When the Barstow first came up, some portion of the tow was in the narrow part of the channel, where it was unsafe to undertake to pass. The wide part of the channel, where she was lying by, was not very long. In the language of some of the witnesses, it appeared as though an opening had been made there for boats to pass. To get out of the way, she worked herself up against the solid ice. In the meantime, the tow was passing, and, when the City of New Bedford came along, it had got so far out of the narrow channel beyond, that she deemed it safe to keep on without stopping. The Barstow was willing to let her get by, as she was a larger and stronger vessel, and better fitted for opening the way, and the Barstow could follow in her wake. It is not possible to tell, from the evidence, precisely when, or where, or how the piece of ice which inflicted the injury was set in motion; but it is clear to my mind, that it was connected in some way with the movements of one or the other of these propellers. The testimony is so conflicting as to make it impossible to locate the propellers with reference to the tow at the time the collision took place, or to determine precisely what the Barstow was doing; but it is certain, that the City of New Bedford was moving somewhere in the vicinity, at a speed of six or seven miles an hour, and that, at some time not long before, the Barstow had been working her engine so as to get away from the tow as it was approaching. There was no other known cause for the displacement of the ice at the time, and the conclusion is, therefore, irresistible, that it must, in some way, have been done by the propellers. At this time, the tugs were moving cautiously, and there was nothing to indicate danger from the quarter it came. So far, I can see no fault in the management of the tugs.

The moving cake of ice which inflicted the injury was seen from the King before the collision took place, and it only remains to consider whether the tugs were in fault for not avoiding it after this discovery was made. There was not time enough, after the discovery, to stop the Humphreys altogether, and it does not seem to me that the additional

headway produced by the tugs not stopping, was sufficient to cause the loss. If the tugs had been stopped, it is likely the result would have been the same. The only thing to be done was, if possible, to turn the ice away from the barge, or the barge from the ice. It will scarcely be contended that there was time enough to do this, from the tug. The ice did not come within reach from her, and, even if she had been loose from the other tugs, she could not have backed down soon enough to do any good. If the captain of the barge had been at his wheel, he might possibly have been able to steer away from the approaching danger; but, unfortunately, he had just at that moment been called to his supper, and was not in a place where he could attempt any such movement. For this, certainly, the tugs are not responsible, and, on the whole, I have been led to the conclusion that the tugs are free from blame under this allegation of fault.

(5.) As to not dividing, and, in this connection may be considered the further complaint, presented on the argument, that, when the three tugs were brought together, no one man was placed in command of the whole.

Neither of these complaints is set forth specifically in the libel, and I cannot find that they are at all supported by the evidence. Certainly, some one person should be put in command, and the presumption is that this was done. Not a particle of evidence is found to the contrary. In the absence of such evidence, the law implies that what ought to be done was done.

So far as dividing the tow is concerned no witness has been examined on the subject, and the complaint seems to be based on theory rather than proof. It is certain the tow was not divided; but, in the absence of any testimony showing that it ought to have been done, I cannot hold that the judgment of the experienced men who acted on the facts as they actually appeared at the time, was so clearly wrong as to make it a fault. Towing in sections would not be likely to reduce the speed. True, each tug might in that way more easily control its own movements; but it is far from certain that

this, under the circumstances, would have been an equivalent for what must necessarily be lost by the change. The difficulty was in overcoming the obstruction of the ice. By keeping together, the power of all the tugs could be combined, and a longer continuous channel kept open. But, however this may be, there is nothing before me to show that keeping together was a fault.

On the whole, I am of the opinion that a case has not been made out against the tugs, and that the decree below, dismissing the libel, was right.

The Eleanora.

A steamer must, in a fog, run at only such a speed as is consistent with the utmost caution; and she must, if possible, be kept under such control that she can be stopped after another vessel with which she is in danger of collision may be seen or otherwise discovered.

A schooner sailing in the night, in a fog, in a common thoroughfare of approaching steam vessels, and heading on a course crossing their regular tracks, and hearing fog signals from them from various directions, was held in fault for not exhibiting a lighted torch, a collision having occurred between her and one of such steamers.

Nothing short of an absolute certainty that the torch could do no good, to be established by proof, will justify an omission to obey the rule.

The schooner was held in fault because, while on her port tack, she sounded one blast only at a time of her fog horn, instead of two blasts at a time.

The rule of the supervising inspectors of steam vessels on that subject, though it does not have the force of law as regards a sailing vessel, had become binding on the schooner, as a usage of the sea.

The schooner was held in fault for sailing short handed in a fog, having only two men on deck, one attending to going about, and acting as a look-out, and the other steering and blowing the fog horn.

A schooner and her cargo were lost by a collision with a steamer. The steamer being sued separately for the two losses, both vessels were held in fault. The damages for the loss of the schooner were apportioned between the two vessels. A decree was given to the owners of the cargo for the full amount of their loss; and a credit was allowed to the steamer, on the decree in favor

of the schooner against her, for a sum equal to one-half of the decree in favor of the owners of the cargo.

As, in the suit by the schooner, both parties had appealed to this Court, the costs in this Court in that suit were equally divided between them.

(Before WAITE, Ch. J., Southern District of New York, August 28th, 1879.)

THESE were two libels *in rem*, filed in the District Court, in Admiralty, against the steamship Eleanora, one by the owners of the schooner Transit, and the other by the owners of her cargo, to recover for the loss of the schooner and her cargo by a collision between the schooner and the steamship. The District Court held that both vessels were in fault, and apportioned equally between the schooner and the steamship the damages for the loss of the schooner. It gave to the owners of the cargo a decree against the steamer for the full amount of the damages sustained by the loss of the cargo. In the suit by the owners of the schooner, both parties appealed to this Court. In the suit by the owners of the cargo the claimants appealed to this Court. The decision of the District Court, (BLATCHFORD, J.,) was as follows: "These libels are filed, the first of them by the owners of the schooner Transit, and the second of them by the owners of her cargo, to recover for the damages caused by the loss of the schooner and her cargo of coal, which took place on the night of the 30th of August, 1875, shortly before midnight, in consequence of a collision between the schooner and the steamship Eleanora, in Long Island Sound, off Faulkner's Island, during a dense fog, the schooner and her cargo being sunk and totally lost, and the master of the schooner being drowned. The steamer was bound from New York to Portland, Maine. The schooner was bound to the eastward. The wind was east, and very light, and the tide was running flood or to the westward. The schooner was on her port tack, beating, and heading about south southeast, or six points off the wind. The course of the steamer had been a little north of east. The stem of the steamer struck the starboard side of the schooner a few feet forward of the stern of the schooner, and substantially cut

off the part of the schooner that was aft of the line of the blow. The libels allege that those on the steamer were either negligent in not discovering the schooner in time to avoid the collision, or, seeing the schooner and her lights, or, hearing her signals on her fog horn, were negligent in continuing to run the steamer at the rate of ten or twelve knots an hour, and in not causing the steamer to be stopped before colliding, or causing her course to be changed. The answers allege, that a fog came on at 20 minutes past eleven o'clock; that the steamer was running at a moderate rate of speed, and had competent lookouts, properly stationed and keeping a vigilant lookout, and her whistle was sounded at regular and proper intervals; that, while thus proceeding cautiously, the lookout reported, and there was, at the same time, heard, one blast of a fog horn, about one half a point over the port bow of the steamer; that thereupon, immediately, her wheel was put hard-a-port, and thereafter kept so, and she was stopped and backed; that, immediately thereafter, the sails of the schooner came into view, crossing the bow of the steamer from port to starboard; that the schooner exhibited no flash nor other lights at any time, nor was any signal given from her except the one blast of her fog horn, just immediately before the collision; that she had no competent officers, nor crew, nor lookout, nor wheelsman, at or previous to the collision; that, notwithstanding every effort, from the moment of receiving any signal from the schooner, to avoid her, was made by those in charge of the steamer, the vessels came into collision; that the collision occurred about 20 minutes to 12 o'clock, midnight, and was inevitable as to the steamer; that the collision was solely owing to negligence and want of skill and care on the part of the schooner, in that she had no competent crew, and had no proper lights set and burning, and exhibited no flash light, and had no competent or proper lookout, and gave no sufficient or timely or proper signals by lights or fog horns, and did not indicate her port tack by two blasts of her fog horn, so that vessels approaching her might be warned in time and thus avoid her, and had no competent helmsman,

and, for some time before, and at the time of the collision, had no one at all at her helm; that the only signal, to wit, the one blast of the fog horn, which the steamer received, was acted upon promptly; and that, had such signal been timely and proper, and had those navigating the schooner not been guilty of the other negligent acts above-mentioned, the collision could have been avoided. The fog was very dense. The steamer, when the fog came on, reduced her speed to the rate of between 5 and 6 miles an hour, her ordinary rate being 10, and blew her fog whistle at proper intervals. There were in her pilot-house her master, and first mate, and one seaman, and there was a seaman on watch just outside of the pilot-house, and one on the lookout forward, on the forecastle deck, close to the stem. All were listening attentively for sounds of fog horns and looking attentively for lights. The schooner, as I find, on the evidence, had her colored lights set and burning, but they were not seen at any time from the steamer, nor could they, or the lights of the steamer, have been seen in such a fog at any useful distance. The schooner had on her deck a seaman, who was at the wheel, and her mate. Her master came on deck very shortly before the collision. The persons on the deck of the schooner were listening and looking. They had a fog horn on deck, and it was being blown by them at proper intervals. Yet, it is plain, from the evidence, that neither vessel became conscious of the presence of the other, until just before the collision. I cannot resist the conclusion, that the collision was due, in part, at least, to the improper speed of the steamer. The violence of the blow, and the fact that, notwithstanding the steamer stopped and reversed at full speed, as soon as she became aware of the proximity of the schooner, by hearing her fog horn, the impetus carried her, despite the obstacle, a considerable distance ahead and beyond the place of collision, before she came to a stand-still, indicates that her speed was too great. The schooner gave blasts on her fog horn at proper intervals, unconscious of the approach of the steamer. The schooner was bound to the eastward, with her booms off to starboard. The blasts of her fog horn were deliv-

ered, as was natural, towards the eastward, and the position of the sails of the schooner would tend to intercept the sound from being heard by a vessel approaching the starboard side of the schooner, nearly at right angles. The moment the whistle of the steamer was heard on board of the schooner, the fog horn of the schooner was blown over the starboard side of the schooner, and towards the direction from which the blast of the whistle came. The steamer was running at the rate, at 5½ miles an hour, of 484 feet in a minute. The wind was blowing the sound of the whistle directly away from the schooner. It will not do to say that the fact that the schooner did not hear the steamer's whistle sooner, or the fact that the steamer did not hear the schooner's fog horn sooner, it appearing that those on both vessels were watchful and attentive, proves that the steamer gave no blasts of her whistle before the first one that the schooner heard, or that the schooner gave no blast of her fog horn before the first one that the steamer heard, in the face of the clear evidence that both whistle and fog horn were blown, and blown at proper intervals, in view of the existing state of things before the blasts which were respectively heard. If the steamer had been going at less speed, or had gone ahead a short distance and then stopped still and listened, and thus made her speed, or her passage from point to point through the intervening space, and not merely her running rate while in forward motion, that "moderate speed" which the statute requires, it is quite apparent, that, blowing her whistle continually, at proper intervals, the blast would have been heard by the schooner, and answered by the fog horn over the starboard side of the schooner, in sufficient season for the steamer to have stopped and backed, and be brought to a stand-still, before reaching the schooner. Therefore, the steamer was in fault as to her speed. It is contended that the schooner was in fault in not showing a lighted torch. It is provided, by section 4,234 of the Revised Statutes, that every sail vessel shall, 'on the approach of any steam vessel during the night time, show a lighted torch upon that point or quarter to which such steam

vessel shall be approaching.' In order to make this provision operative, it is necessary that the sailing vessel should be aware of the approach of the steam vessel towards her, or, that, if ignorant of such approach, such ignorance should not arise from negligence or inattention on the part of the sailing vessel. In the present case, I do not find, on the evidence, that there was any negligence or want of attention on the part of the schooner, in watching for sounds from the steamer. The schooner was provided with a torch, but it was not on deck. I am not satisfied, on the evidence, that there was a sufficient interval of time between the hearing of the steamer's whistle by the schooner, and the hearing of the schooner's fog horn by the steamer, for the torch to have been lighted and exhibited in such manner as to have done any good, or to have indicated the presence or position of the schooner to the steamer sooner or better than the fog horn did, even if the torch had been on deck. Here, again, the difficulty goes back to the speed with which the steamer was approaching the course of the schooner. But, there is an obstacle to the entire exoneration of the schooner from fault. The board of supervising inspectors of steam vessels, in January, 1875, established certain regulations, which were approved by the Secretary of the Treasury. They are contained in a printed pamphlet of 45 pages, entitled: 'General Rules and Regulations prescribed by the Board of Supervising Inspectors of Steam Vessels, and approved by the Secretary of the Treasury, 1875.' Among these regulations, on page 41, are 'Rules prescribing certain fog signals to be observed by steamers, sailing vessels and other craft.' One of those regulations is as follows: 'Sailing vessels, and every craft propelled by sails, upon the ocean, lakes and rivers, shall, when on their starboard tack, sound one blast of their fog horn; when on their port tack, they shall sound two blasts of their fog horn; when with the wind free, or running large, they shall sound three blasts of their fog horn; when lying to or at anchor they shall sound a general alarm.' This regulation was in force at the time of this collision. The statute re-

specting fog signals (*Rule* 15 *of section* 4,233 *of the Revised Statutes*) does not cover the point of an indication of the starboard tack by one blast of a fog horn, and of the port tack by two blasts. The power of the board of supervising inspectors of steam vessels to establish the regulation in question is claimed to be derived from section 4,405 of the Revised Statutes, which provides, that 'the board shall establish all necessary regulations required to carry out in the most effective manner the provisions of this Title, and such regulations, when approved by the Secretary of the Treasury, shall have the force of law.' This provision was a re-enactment of a like provision found in section 23 of the Act of February 28th, 1871, (16 *U. S. Stat. at Large*, 449.) I find it impossible to hold that the regulation respecting the indication of the tack is a necessary, or even an appropriate, regulation to carry out any provision that is found in the Title in question, Title 52. It is urged that the clause referred to gives to the Board power to make any regulation which tends to prevent the loss of life on board steam vessels. The provisions of Title 52 are, indeed, many of them, provisions to prevent such loss of life. But they are specific provisions in regard to various matters. None of them relate to fog signals, or to the navigation of a steamer or a sailing vessel in a fog, or to the manœuvring of a steamer with reference to a sailing vessel. Therefore, I cannot hold that the regulation respecting the indication of the schooner's tack had the force of statutory law, as respected either the schooner or the steamer. But, the evidence is clear, that, as the language of the sea, the steamer had the right to understand one blast of a fog horn as indicating a sailing vessel on her starboard tack; and, in view of the evidence on the part of the steamer, and the absence of testimony on the part of the schooner, to the effect that one blast of a fog horn was not understood by those on the schooner to indicate the starboard tack, it must be held that the schooner knew that a single blast would indicate to the steamer that the blast came from a sailing vessel on her starboard tack. The schooner had, very shortly be-

fore, been on her starboard tack. On that tack, the one blast was proper. When she came on her port tack she continued her one blast. The steamer heard that one blast a little on her port bow, not over half a point. With the headway she had, she ported her helm. This threw her head to starboard, and, on the evidence, she changed, by compass, before the collision, a point and a quarter, or from east one-quarter north to east by south. Her view was, that the fog horn was on a sailing vessel which was on the starboard tack, and had already got on the port bow of the steamer, and was moving away from the course of the steamer. Therefore, porting would ensure the passage of the steamer under the stern of such vessel. But, the schooner was on the port tack, and was moving towards the line of the steamer's course. As it was, although the steamer, by porting, changed a point and a quarter, she struck the schooner at a point only 15 feet from the schooner's stern. If the schooner had, by two blasts of her fog horn, indicated that she was on the port tack, it is apparent that the steamer, hearing the sound only half a point on her port bow, would not have ported, and that, if she had kept her course, or, much more, if she had starboarded to the same extent to which she ported, she would have passed under the stern of the schooner without striking her, or the blow would have been a sliding and glancing one, inflicting less injury on the schooner and her cargo. I must, therefore, hold the schooner in fault. I do not find that any of the other faults alleged against the schooner are established. It follows, that, as regards the suit brought by the owners of the schooner, the damages for the loss of the schooner must be apportioned between the schooner and the steamer. The decision in *The Atlas*, (3 *Otto*, 316,) requires, that, in the suit by the owners of the cargo, there should be a decree against the steamer for the full amount of the damages sustained by the loss of the cargo. In each case there must be a reference to ascertain the damages."

This Court found the following facts: "A little before midnight of the 30th of August, 1875, the schooner Transit,

owned by the libellants in the first suit, laden with two hundred and thirty-two tons of coal, owned by the libellants in the second suit, was sunk by a collision with the steamship Eleanora, in Long Island Sound, between one and two miles to the eastward, and six and seven miles to the southward, of Faulkner's Island. The schooner and cargo were a total loss, and the captain of the schooner was drowned. The wind was light from the eastward, and the tide flood, running to the westward about two miles an hour. The schooner was eighty feet keel, and twenty-eight feet beam. Her registered tonnage was one hundred and fifty tons or thereabouts, and her carrying capacity about two hundred and thirty. She was beating eastward, on a voyage from Newburgh, N. Y., to New Bedford, Mass., and making very little headway. Her crew consisted of her captain, mate, one able seaman, one ordinary seaman and a cook. At the time of the collision she was on her port tack, having come about from the starboard tack only a little while before. The steamship was one hundred and eighty-six feet long, and thirty feet beam. Her registered tonnage was a little less than one thousand tons. She was propelled by a screw, and her usual speed was not far from ten miles an hour. She was on one of her regular trips between New York and Portland, Maine, bound east, having left her dock in New York a little after four o'clock in the afternoon of the same day. About eleven o'clock at night, a very thick fog came on, which lay low upon the water, and it was impossible to see a vessel at any considerable distance. Ordinary signal lights were of but little use. The mate's watch, consisting of the able seaman and himself only, commenced on the schooner at eight o'clock. The mate was at the wheel and the seaman on the lookout until the fog came on, or a little after. The mate then called the seaman to the wheel and went himself into the cabin, for the fog horn. On coming out he went forward near the foremast and blew the fog horn at short intervals, acting at the same time as lookout. He then came aft and gave the horn to the man at the wheel, with directions to blow it.

Then he went below again and called the captain. Coming on deck soon after, he went forward and let go the jib sheets and superintended the navigation of the vessel, as she came about on her port tack. The man at the wheel steered the vessel, gave the necessary attention to the sails aft, as she came about, and did all that was done toward blowing the fog horn after he was assigned that duty by the mate. Soon after the vessel got on her port tack, the captain came on deck and looked under the sails to the starboard. Down to that time, after the vessel had come about, the blasts of the fog horn had all been given on the port side, and the sound to the starboard was obstructed by the sails. The captain at once directed that the horn be blown on the starboard side. This order was obeyed, a single blast only being given. Almost immediately afterwards the steamer appeared through the fog and struck the schooner on her starboard quarter, about fifteen feet from the stern. The steamer passed by without stopping, and, in so doing, broke off the entire stern of the schooner. Soon afterwards the schooner filled and sank. After the schooner got about on her port tack, the mate went aft to the mainmast on the port side, and remained there until the collision. The lights of the steamer were not seen until just before the steamer herself came in view, and that was only a few moments before the vessels came together. The course of the schooner was directly across the track of the steamers bound east from New York, and leaving their docks that afternoon from four to six o'clock. Their courses and position at the different hours in the night were well understood by those accustomed to navigate the Sound, and they were regularly due in that place about the time the fog came on. Fog whistles were heard on the schooner a considerable time before the collision, and they indicated the close proximity of several of the steamers. The mate heard whistles when the schooner was going about, and afterwards. Some of the steamers he had seen before the fog came on. After he got on the port tack he heard whistles near by, but gave no special attention to the sounding of the horn.

No torch light was exhibited from the schooner. The torch was in the cabin, but was not brought on deck. Both the Eleanora and the Transit had the ordinary regulation lights set and burning. In June, 1871, the board of supervising inspectors, appointed under the Act of February 28th, 1871, (16 *U. S. Stat. at Large*, 449,) recommended certain fog signals to be observed by steamers, sailing vessels and other craft. Among other recommendations was the following: 'Sailing vessels, and every craft propelled by sails, upon the ocean, lakes, and rivers, shall, when on their starboard tack, sound one blast of their fog horn; when on their port tack, they shall sound two blasts of their fog horn; when with the wind free or running large, they shall sound three blasts of their fog horn; when lying to or at anchor, they shall sound a general alarm. In each instance, the above signals shall be sounded at intervals of not more than two minutes.' This Rule was approved by the Secretary of the Treasury and promulgated from the Department, July 18th, 1871. Printed copies were sent to the custom houses generally, for distribution on board of vessels. In October, 1873, the collectors of customs were instructed by the Department to issue to each sailing vessel, with its other regular papers, two copies of a circular intended to bring the Rules to the attention of navigators, and to enjoin their observance. A supply of these circulars was furnished to collectors generally, but none appears to have been sent to Port Jefferson, a small port on Long Island, where the Transit was registered, until after the collision occurred. No direct evidence has been produced to show that actual notice of the Rule had been given to the captain or the mate of the Transit, but it is abundantly established that the circulars were distributed generally to the custom houses of the country, and had been furnished to vessels in accordance with the instructions. The evidence also establishes the fact that this Rule was generally understood and acted upon by all careful and prudent navigators in Long Island Sound, and by those sailing into and out of the harbor of New York. In August, 1875, it had been generally

adopted, by common consent, as a rule of navigation. This Rule was not observed by the Transit. She sounded only one blast of her fog horn while on her port tack, instead of two, as the Rule required. The Eleanora was, in all respects, properly manned and equipped. She ran on her usual courses and at her usual speed, from the time she left her dock in New York, until she became enveloped in the fog. She had at all times, down to the moment of the collision, competent lookouts properly stationed on deck and performing their duties. When she reached the fog, no special orders were given to slacken her speed, but it was a rule of the boat to let the speed run down while the fog whistles were being sounded. Soon after the steamer got into the fog she commenced blowing her fog signals, and kept them up at proper intervals until the vessels came together. When the engineer heard the fog signals, he closed the throttle valve somewhat and opened the furnace doors, to let the steam run down, so that, when the collision occurred, the steamer was going at somewhat less than full speed, without any direct orders to that effect having been given. The Eleanora had been running for a considerable time in company with the eastern bound steamers leaving New York that afternoon. Some ran to the north and some to the south of her. Their fog signals were plainly heard from her. Fog horns were also occasionally heard. None, however, were recognized as near by until a single blast was heard but a moment or two before the collision. The captain was then on deck, and he promptly gave the orders to port the wheel and to stop and back. All these orders were obeyed, but, before much change was made in the course, or the speed could be stopped, the vessels came together. After the collision the steamer ran out of sight of the schooner in the fog, before she was finally stopped. She then came back and did all that could be done to save life and property. The fog signals of the other passing steamers were distinctly heard and recognized from the Eleanora until they had passed beyond hearing distance. The

report of the commissioner as to the amount of damages in both cases is sustained by the evidence."

Horace Barnard, for the libellants.

F. A. Wilcox, for the claimants.

WAITE, Ch. J. I have had no difficulty in reaching the conclusion that both vessels are responsible for this collision. A simple slackening of speed by a steamer in a fog is not always enough. She must run at a moderate speed, (*Rev. Stat., sec.* 4,233, *Rule* 21,) and is never justified in coming in collision with another vessel, if it be possible to avoid it. (*Sup. Ins. Rule IV.*) This implies such a speed only as is consistent with the utmost caution. Having complete control of herself, and being capable of so much damage if a collision does take place, the law has imposed on her the obligation of so directing her own movements, in the midst of the uncertainties of a fog at sea, as to be at all times under easy command. If she fails in this she must suffer the consequences. Her rate of speed must be graduated according to the circumstances. The more dense the fog the greater the necessity for moderation. The object is to keep her, if possible, under such control that she can be stopped after another vessel, with which she is in danger of collision, may be seen, or otherwise discovered. She has the right to assume that other vessels will perform their duties and act accordingly, but she has no right to disregard any obligation placed on herself.

Guided by these rules, which are well settled, it is easy to see that the Eleanora was in fault for going at too great a rate of speed. She was running in a dense fog, where the ordinary signal lights were of no use, and objects could not be seen much, if any, more than her own length away. Her officers and men appear to have been watchful on deck, and a vigilant lookout was maintained, but her engineer, at his place in the engine-room, was left to act only on his general

orders to slacken speed when the fog whistles were being blown. He did not know whether the fog was dense or not, and he contented himself with opening the furnace doors, to let the steam run down, and shutting off the throttle valve somewhat; how much does not distinctly appear. No orders were given to him from the deck. It is true, the witnesses, some of them, say she was going as slow as she could and have her wheels pass the centre; but in this they are evidently mistaken. The fog horn of the Transit was heard before the vessel herself came in sight. As soon as it was heard, the orders to stop and back were given and obeyed. Notwithstanding this the steamer kept on until the schooner came in sight, then ran over the schooner, and then ran again out of sight in the fog, before coming to a stop. In this way the steamer must have run three or four times her length, under a reversed engine, against a head tide of two miles an hour. It needs no argument to show that this could not have been done if, as claimed, when the order to stop and back was given, she was under no more than mere steerage way, or if she had been going, since she came into the fog, at least half an hour before, with her throttle valve to any considerable extent closed, and her steam running down. To my mind it is clear she was doing what is too often done under such circumstances, taking the risks of running too fast.

As to the Transit I have had no more difficulty than with the steamer. Confessedly, she did not exhibit a torch light. She was sailing in what she knew, or ought to have known, was a common thoroughfare of approaching steam vessels at the time. Their fog signals were heard from various directions, and she was heading on a course crossing their regular tracks. The statutory Rule is imperative, that every sailing vessel "shall, on the approach of any steam vessel during the night time, show a lighted torch upon that point or quarter to which such steam vessel shall be approaching." (*Rev. Stat.*, *sec.* 4,234.) No sailing vessel has a right to disregard this regulation because she thinks it unimportant. If she knows

of the approach of a steam vessel she must exhibit the light, or take the risks of loss occasioned by its absence.

In this case no attention was paid to the Rule. The light was not only not exhibited, but the torch was not brought on deck. If exhibited, possibly it might not have been seen far enough away to have done any good; but such a possibility furnishes no excuse to the vessel for its absence. Nothing short of an absolute certainty that it could do no good, to be established by proof on the trial, will justify an omission to obey the Rule. In a fog, all vessels must do all that is required of them by law or usage. While more is demanded of a steamer than a sailing vessel, it is as important that the sailing vessel should obey all the rules prescribed for her, as that the steamer should not neglect those which are to govern her. Actual safety is dependent upon a strict performance by each, of all their respective duties. While the Transit was sailing on her starboard tack, while she was coming about, and while she was on her port tack, fog signals from steamers in her immediate neighborhood were heard, and it is by no means certain that some of them did not come from the Eleanora. It was not proper to assume that the torch light would have done no good. It was her duty to exhibit such a signal, and, under the circumstances of this case, I cannot but consider it a fault that she omitted to do so.

But, even if this were otherwise, her failure to give two blasts of the fog horn while on the port tack was, certainly, a fault. The testimony taken since the appeal leaves no doubt on my mind that, when this collision occurred, in 1875, the recommendation of the supervising inspectors in respect to special signals to indicate the course and movements of sailing vessels during a fog, had been adopted by navigators in Long Island Sound and in and about the harbor of New York, as part of their "language of the sea," and that it had been so long in use as to make it a fault on the part of the schooner, if it was not known and understood by those responsible for her navigation. The supervising inspectors had no power to prescribe rules which would have the force of law, for the

government of sailing vessels, and they did not attempt to do so. Their absolute authority did not extend beyond steam vessels, but they certainly had the authority to suggest rules for the consideration of sailing vessels, by which their conduct towards steamers should be regulated, and these rules, if generally acted upon by navigators, might in time become binding, as usages of the sea. The suggestions of the supervising inspectors were eminently practical. They were approved and promulgated by the Secretary of the Treasury more than four years before this accident. They were immediately taken up and acted upon to some extent. Two years afterwards, extraordinary efforts were made by the Government to give them publicity and to secure their observance. It is possible that these efforts had not been put forth at the little port of Port Jefferson, where the Transit was registered, but it is quite certain that the suggestions were known and acted upon in almost every other port she entered from the time of their promulgation until the collision. Under these circumstances, if her officers had not learned of this new sound in fog language at sea, they must be considered as unfit for the positions they occupied, and the consequences of their ignorance must be visited on her. The Eleanora, when she heard the one blast of the fog horn almost ahead, acted as if the vessel from which the sound came was on the starboard tack, and put her wheel to port. This, if the signal had indicated the truth, would have been right, and quite likely would have avoided a collision. As the fact was, the movement was exactly wrong, since it brought the steamer on to the schooner. If the wheel had been put to starboard, and the steamer swung the other way, as would likely have been done if two blasts of the horn had been given instead of one only, a passage under the stern might have been made in safety.

The Transit too was, I think, short handed on deck at the time. While the number of her crew may have been sufficient, and two might have been enough for a watch on deck, under some circumstances, it is easy to see that a mate, who

was attending to the navigation of a vessel and letting go her sails while going about in a fog, was in no condition to act as lookout on the watch for the fog signals from steam vessels which might momentarily be expected; and that a man at the wheel, steering the vessel and looking after the sails aft, as they came about, would not be likely to give as much attention to the fog horn as the necessities of the case for the time being required. This is shown by the fact that, although the steamers were due, and approaching from the west, the horn was not sounded in that direction until after the captain came on deck, which was but just previous to the collision. Until then, the sound in the direction of the danger had been obstructed by the sails. A fog horn, at the best, can be heard only for a comparatively short distance, and is by no means reliable for signal purposes under all circumstances. Hence, it is important that those who are responsible for its use should be vigilant and attentive. As it is the way prescribed by law for giving information as to the position of a sailing vessel in a fog, when sight is of but little use, the duties of the man who has it in charge are as important as those of a lookout under other circumstances. Steamers are bound to keep out of the way of sailing vessels, but sailing vessels must, in the night and in a fog, by the use of the prescribed signals, furnish the steamer with the means of knowing how this may be done. This duty on the part of the sailing vessel is as obligatory as that of the steamer to keep away.

Both vessels being in fault, as between themselves, the damages must be apportioned. Castner and others, who sue the Eleanora alone, for the cargo, are entitled, under the rule in the case of *The Atlas*, (93 *U. S.*, 302,) to a decree for the full amount of their loss; and, as the Transit, if she had been joined, would have been liable for one-half this loss, a credit may be allowed the Eleanora, on the decree in favor of the owners of the Transit, for a sum equal to one-half of the damages to the cargo. Although separate libels were filed by the owners of the vessel and the owners of the cargo, they constitute, in effect, but a single suit. They have been

heard together and submitted on the same evidence. Having all parties before it, the Court may do what it would have done if there had been but one libel, that is to say, divide the damages of the collision throughout between the two colliding vessels. A formal claim, to that effect, on the part of the Eleanora, is not necessary. It is rare that, in any case, a defending vessel makes a demand for a division of damages. A complete defence is generally insisted upon in the pleadings, and the apportionment is made by the Court, on the facts as they are finally developed at the hearing. It is unnecessary to decide what the rule in this particular would be if the Eleanora had not been subjected in the suit for the cargo, because here she has been, and that, too, upon the very testimony submitted in the suit between the two vessels. The fund belonging to the Transit, growing out of the collision, is in Court, and no injustice is done by using it to reimburse the Eleanora for what she has paid for the Transit, on account of the mutual fault of the two vessels.

While the allowance made by the commissioner in his report for the value of the Transit seems large, I think it is sustained by the evidence. As to the other exceptions to the report in the case of Davis, it is sufficient to say they are overruled. The exceptions in the other case have not been seriously insisted upon here. A decree may be entered in favor of the libellants in the suit of Castner and others, for $1,114 17, and interest at six per cent. from October 25th, 1875, until the date of the decree. In the case of Davis and others, the damage to the vessel and freight amounted to $4,660 14; one-half of this is, $2,330 07; deduct one-half of the value of the cargo, $557 08, and the balance due to the Transit is $1,772 99; to which add interest at the rate of six per cent., from October 23d, 1875, to the date of the decree. In the case of Castner, a decree may be entered against the Eleanora for costs in both Courts. In the case of Davis, the libellants are entitled to costs in the District Court, but, as both parties appealed, the costs in this Court may be equally divided between them.

The Jesse Williamson, Jr.

The Blanche Page and The James A. Burden.

Under Rule 4 of the statutory navigation Rules, (*Rev. Stat.*, § 4,233,) requiring "steam vessels, when towing other vessels," to "carry two bright white mast-head lights vertically," and requiring that each of those mast-head lights shall be of the same character and construction as the mast-head lights prescribed by Rule 3, a steam tug, which has no mast, and cannot carry a light at her mast-head, must carry two bright white lights vertically, of a character to be visible five miles away, on a dark night, with a clear atmosphere, and so constructed as to show a uniform and unbroken light ahead, and from ten points on one side to ten points on the other, of the tug.

Whether, if two lights of a power equal to what is required for mast-head lights are suspended vertically on the flag-staff at the stern of a tug, in such a manner as to show a uniform and unbroken light ahead over an arc of twenty points of the compass, they would be the legal equivalent of two mast-head lights, *quere.*

If circumstances are such as to make it proper for a steam tug to keep a tow 400 or 500 feet behind her, she should be specially careful not only to notify approaching vessels that a tow is following, but, as near as may be, where it is.

Whether Rule IX of the board of supervising inspectors appointed under the authority of the Act of February 28th, 1871, (16 *U. S. Stat. at Large*, 440, *Rev. Stat.* §§ 4,405 *and* 4,412,) has the force of law in respect to the lights to be carried on canal boats and barges, while being towed by steam vessels, *quere.*

(Before Waite, Ch. J., Southern District of New York, August 28th, 1879.)

These were cross libels filed in the District Court, in Admiralty, for a collision. John H. Starin, as owner of the barge James A. Burden, sued the schooner Jesse Williamson, Jr., for damages to the barge while being towed by the steam tug Blanche Page, through a collision between the barge and the schooner. William H. Sise and others, as owners of the schooner, sued the tug and the barge, for damages to the schooner by the same collision. The District Court dismissed the libel against the schooner, and gave a decree for the libellants in the suit against the tug and the barge. Starin, the owner of the tug as well as of the barge,

appealed to this Court, in both suits. The decision of the District Court, (BLATCHFORD, J.,) was as follows: "On the evening of the 2d of November, 1875, after dark, the schooner Jesse Williamson, Jr., collided with the barge James A. Burden, which was in tow, on a hawser, of the steam tug Blanche Page. The bowsprit of the schooner entered the port side of the cabin in the after part of the deck of the barge, and upset a stove which had fire in it, and the barge took fire and burned up, with her cargo. The schooner, also, was injured. John H. Starin, the owner of the barge and of the tug, sues the schooner to recover for the loss of the barge, and of her cargo, which the barge was carrying on freight. The owners of the schooner sue the tug and the barge to recover for the damage done to the schooner. The collision took place a short distance to the westward of Throgg's Point, the schooner being bound to the eastward, and the tug and barge to the westward. The libel in the suit against the schooner sets forth, that the hawser by which the barge was towed was about 80 fathoms long; that, after the tug had passed around Throgg's Point, the schooner was discovered by those in charge of the barge, to the leeward of the tug, and showing only her red light; that, at that time, the barge was following after the tug almost in a straight line, but heading a little to the windward of her, the wind being from the northwest or thereabouts; that the schooner passed the tug, on the port hand of the tug, at such a distance that she could easily have cleared the barge also, if a proper lookout had been kept, so as to see the barge, or if proper care had been taken in reference to the navigation of the schooner; that, as soon as the schooner was seen by the master of the barge to be approaching the barge in such a way as to render a collision probable, the helm of the barge was put hard-a-port, and the schooner was loudly hailed to keep away from the barge, which it was even then possible for her to do by porting her helm, but, without making any such change, she kept on, and ran into the barge; that the tug and the barge had all the regulation lights properly set and burning brightly; and that the collision was caused by

the negligence and carelessness of those in charge of the schooner, in that, among other things, she had no lookout properly performing his duty, and she did not continue her course to pass the barge on the port hand, as there was ample room for her to do, there being nothing whatever in her way, and she did not take proper measures to avoid the barge by changing the course she was on when she was hailed. The answer of the schooner alleges, that, when the schooner was about two miles to the westward of Throgg's Neck, and sailing on an easterly course, in about the middle of the channel, she discovered the green light and the white light of a vessel about one point over her port bow, and apparently distant about 2½ or 3 miles, which lights approached the schooner, and shortly changed, showing both green and red lights; that, when still nearer to the schooner, said vessel closed her green light, and showed the red and white only; that, at that time, said vessel and the schooner (which was moving at the rate of about six knots an hour) had approached so that said red light bore over the schooner's port bow, and distant about half the distance between the schooner and the New York shore, and had gone so far by the course of the schooner, as to be entirely out of her track; that, within a short time afterwards, the lookout on the schooner discovered a barge, which proved to be in tow of said vessel, (which was a tug,) on a very long hawser, (of about 100 fathoms in length,) which barge was far to the southward of the course of the tug, and heading nearly across the channel, into which position the wind and tide had carried her, in consequence of the neglect and mismanagement of those in charge, and the length of the hawser by which she was towed, and the change of course of the tug in rounding Throgg's Point; that there were no lights visible on the barge and no lookout; that, immediately on discovering her, the schooner was ported; that the schooner had all the regulation lights properly set and burning brightly, and a careful lookout properly stationed and attentive to his duties; and that the collision was caused solely by the carelessness and negligence and improper sea-

manship of those in charge of the tug and barge, in, among other things, towing the barge on a hawser of undue and unsafe length, and not having any light on, or lookout or proper person in charge of, the barge. The libel of the owners of the schooner contains the same averments as their answer to the libel of the owner of the barge. The answer of the owner of the tug and the barge, which was filed after the other three pleadings had been filed, avers, that the tug and the barge had come around Throgg's Point on the starboard side of the channel and as near to the starboard edge of the channel as was prudent; that, after the tug and the barge had just passed around Throgg's Point, the schooner was discovered, by those in charge of the tug and those in charge of the barge, to the leeward of, and ahead of, the tug, bound eastward and showing only her red light; that the barge in tow of the tug was following after the tug, almost directly behind her, but heading a little to the starboard of her; that it was not possible for the tug and the barge to have passed on the other side of the schooner; that, at the time, the tug had all the regulation lights properly set and burning brightly, and indicating that she had a vessel in tow, and the barge had the regulation light also properly set and burning brightly; and that there was negligence in the schooner, causing the collision, in that she did not take proper measures to avoid the barge by porting her wheel, and changing the course she was on, in time to avoid the barge, and in that, although she was approaching the tug and the barge on their port hand, in such a way as to head for the barge, and in such a way that the tug could not possibly draw the barge out of the way, and that the barge could do nothing to avoid her, except to port her wheel, which she did, the schooner kept on her course toward the barge until she struck. In other respects, the answer of the owner of the tug and the barge contains the same averments that his libel does. The libel of the owner of the barge, in averring that the tug and the barge had all the regulation lights properly set and burning brightly, does not state what lights either vessel had. This averment

is contained in the third article of such libel. The answer to that libel denies all the allegations contained in such third article, except as specifically admitted. There is no admission of the allegation as to the lights on the tug and the barge, except what is found in the statements in the answer, above recited, respecting the green light, the red light and the white light, of the tug. The answer states, that there were no lights visible on the barge, and, while it alleges fault in the tug and the barge, in that the barge had no light, it does not allege, as a fault in the tug, that the tug did not have all her proper lights, or did not have the proper lights to indicate that she had a vessel in tow. So, too, the libel of the owners of the schooner mentions the red, the green and the white lights of the schooner, and avers that there were no lights visible on the barge, and alleges that the collision was the fault of the tug and the barge, in that the barge had no light, but it does not allege any want of proper lights on the tug. The answer to such libel alleges that the tug had all the regulation lights properly set and burning brightly, and indicating that she had a vessel in tow, and that the barge had the regulation light (in the singular) also properly set and burning brightly, but it fails to state what lights the tug had or where they were placed, or what the lights were which indicated that she had a vessel in tow, or where they were placed. The tug had two common globe lanterns, with white lights, one above the other, about 2 feet apart, about 4 feet from the top of her flag-staff aft, and she had a white head-light, and red and green lights. Those flag-staff lights aft on the tug were not noticed by any one on the schooner. The barge had two globe lanterns, with white lights, similarly arranged on her flag-staff aft. They were not noticed by any one on the schooner. The pleadings on the part of the schooner are very unsatisfactory. If the schooner failed to see any towing lights on the tug, and so failed because the tug did not have proper towing lights, and thus was brought suddenly, and without receiving proper warning, into the presence of the barge, and that was believed by the schooner to have been a

cause contributing to the collision, it was to be expected that averments to that effect would be found in such pleadings. But there are none of such averments. The failure to see the lights aft on the flag-staff of the tug, and the failure to aver in the pleadings that they were not seen because they were not proper towing lights, would show that there could be no issue regarded as raised as to whether such lights were proper towing lights, if only the averment had been made in the libel suit of the owner of the barge, (which was the first pleading filed,) that the tug had such lights as proper towing lights. But, the averment of that libel is only that the tug had all the regulation lights, and that averment is denied by the answer of the schooner. On the whole, I think the question must be examined as to whether the lights which the tug had as towing lights were the proper regulation towing lights. Rule 4 of the 'Rules for preventing collisions on the water' contained in § 4,233 of the Revised Statutes, provides as follows: 'Steam vessels, when towing other vessels, shall carry two bright white mast-head lights vertically, in addition to their side lights, so as to distinguish them from other steam vessels. Each of these mast-head lights shall be of the same character and construction as the mast-head lights prescribed by Rule 3.' Rule 3 shows that, by a 'mast-head light,' as spoken of in Rules 3 and 4, is meant a light at the foremast-head, in a steam vessel which has a foremast; that each of the two towing lights in such a steam vessel is to be a bright white light, of such a character as to be visible on a dark night, with a clear atmosphere, at a distance of at least five miles, and so constructed as to show a uniform and unbroken light over an arc of the horizon of twenty points of the compass, and so fixed as to throw the light ten points on each side of the vessel, namely, from right ahead to two points abaft the beam on either side; and that the two lights are to be arranged vertically, and are to be in addition to the green and red side lights. Rule 4 states the object of this arrangement of white lights to be to distinguish towing steam

vessels from other steam vessels. This tug did not carry sail and had no foremast. She was, however, such a steam vessel as is spoken of in Rule 7, and was required to carry the red and green side lights, and, in addition thereto, a central range of two white lights, the after light being carried at an elevation of at least 15 feet above the light at the head of the vessel, the head light being so contructed as to show a good light through 20 points of the compass, namely, from right ahead to two points abaft the beam on either side of the vessel, and the after light so as to show all around the horizon. Such central range of two lights the tug was bound to carry, as a steam vessel, when not towing, and she was bound, when not towing, to carry two lights at her head, arranged vertically. 'The light at the head of the vessel' prescribed in Rule 7, is the equivalent of the light 'at the foremast-head' prescribed in Rule 3, and, where a towing steam vessel of the class mentioned in Rule 3 is required, by Rule 4, to carry two bright white mast-head lights arranged vertically, to distinguish her from other steam vessels of her class, a towing steam vessel of the class mentioned in Rule 7 is required, by Rule 4, to carry two head lights arranged vertically, to distinguish her from other steam vessels of her class. I considered this question in the case of *The U. S. Grant*, (7 *Benedict*, 195,) very fully, and arrived at the conclusion, that, under provisions of law such as are now found in § 4,233 of the Revised Statutes, a steam tug, when not towing, is bound to carry a light at the head of the vessel, and an after light in a central range, and is bound, when towing, to carry two lights at her head, and to carry them vertically, that is, one above the other, and to dispense with the after light, but still to carry the green and red lights. The steam tug, in the present case, did not have two head lights arranged vertically. She had only one head light. The idea of the statute is, that one white head light shall indicate a steam vessel not towing, and two white head lights shall indicate a steam vessel towing; for, it expressly forbids sail vessels, whether under way or being towed, from carrying any white head light. As there is to

be a white head light, in the front of the vessel, at her head, conspicuous, first to be seen, when she is not towing, so there are to be two of them, arranged vertically, one above the other, in the front of the vessel, at her head, conspicuous, first to be seen, when she is towing. The object is, that a tow shall be indicated to other vessels by the lights on the tug, at the earliest possible moment, so that they may give both tug and tow a sufficiently wide berth. For that purpose, the towing lights are to be head lights, and each is to be of the brilliancy and size and in the position of the usual head light. In the present case the tug ought not to have had any light on her flag-staff aft. The two globe lanterns she had aft were not proper towing lights. They were not head lights, and were not calculated to attract attention, and it is not shown that they were of a brilliancy equal to that of the head light. If the tug had had proper towing lights at her head, in the same position with the head light which she did have, it is quite clear that they would have been seen by the schooner as soon as the head light of the tug was seen. That was seen by the schooner a long distance off, and so were the red and green lights of the tug. The fact that the two after lights on the tug were not seen from the schooner indicates that they must have been very feeble lights. The schooner had no proper notice that the tug had a vessel in tow, and the failure to give such notice was a fault in the tug, which contributed to the collision. The barge and the tug, as one vessel, and that a steam vessel, were bound, as between either of themselves and the schooner, to keep out of the way of the schooner, if the schooner, on the one hand, and the barge and the tug, on the other, were proceeding in such directions as to involve risk of collision, although the barge was being towed astern of the tug; and it was the duty of the schooner, as well as her privilege, to keep her course, unless there were special circumstances rendering a departure from these requirements necessary, in order to avoid immediate danger. (*The Cleadon*, 14 *Moore's P. C. C.*, 92, 97; *The Warrior*, *Law Rep.*, 3 *Adm. & Eccl.*, 553; *The Civilta*, 6 *Ben-*

edict, 309, 319; *The U. S. Grant*, 7 *Id.*, 195, 204, 205.) The evidence shows, I think, that the schooner did not change her course so as to embarrass the tug or the barge. She cleared the tug and she had no reason to suppose the barge was being towed behind the tug. The lights which the barge had were as feeble to indicate her presence as were the after lights on the tug to indicate there was a tow. The fact that the schooner saw the head light and side lights of the tug and did not see the two lights aft on the barge, indicates that those lights were defective, as a warning to the schooner, either in position, or size, or brilliancy. The obligation resting on the barge and the tug, to keep out of the way of the schooner, imposes on them, as the schooner did not change her course to their embarrassment, the necessity of showing affirmatively that the schooner committed a fault in not changing her course, or that there were special circumstances which required her to do something which she did not do, or to avoid doing something which she did. The libel of the barge sets forth, as a fault in the schooner, that she had no lookout properly performing his duty. The mate of the schooner, with two seamen, Blake and Saunders, were forward on the lookout, when the lights of the tug were first seen from the schooner. The master was aft by the wheel, and a seaman, Frisbie, had the wheel. The schooner was heading east. The mate reported to the master a green light on the port bow 'way ahead.' In a few minutes he reported it was a steamer showing a white bow light, and green and red lights, coming nearly for the schooner, and then he reported that she had hidden her green light and showed only her red light and her white light. The master then called the mate aft, and he came aft, and then the master went forward himself, telling Frisbie to keep the schooner east by south, which was done. The master then sent aft the two men who were forward, to get ready to haul aft the main sheet, preparatory to turning Throgg's Point. They started aft, but, before they got aft, the master saw the barge rise up before him. He ordered his wheel hard-a-port, and

the order was obeyed, but the barge and the schooner collided. The schooner, from the time she sighted the tug, made no change towards the tug and the barge. She changed one point away from them, from east to east by south, and afterwards, by hard-a-porting, she changed more away from them. From these circumstances, and from the way in which the vessels struck each other, it is manifest that the barge was not moving either west or west by north, but was moving crosswise of those courses, to the northward. I am not satisfied, from the evidence, that the master, or any one else on the schooner, ought to or could have seen the barge any sooner than she was seen, or that there was any deficiency in the lookout on the schooner, which contributed to the collision. The libel of the barge also alleges fault in the schooner, in that she did not continue her course to pass the barge on the port hand. If this means, that, after sighting the tug, the schooner changed towards the tug and barge, the evidence shows the contrary. Such libel also alleges that the schooner took or kept such a course that she collided with the barge. The evidence shows that she changed her course away from the barge, as soon as she sighted the barge, and that there was no fault in her in not seeing the barge sooner. The libel of the barge also alleges, that the schooner was in fault because she did not change her course by porting, when she was hailed from the barge. It appears that she heard no hail, and it does not appear that she ought to or could have heard any hail which the barge made, and it is shown that she did port as soon as she discovered the barge. The answer of the tug and the barge contains no averments as to fault in the schooner, which are not covered by the foregoing observations. In the suit against the tug and the barge, there must be a decree for the libellants against both vessels, with costs, with a reference to ascertain the damages. In the suit against the schooner, the libel is dismissed, with costs."

This Court found the following facts: "About half-past seven o'clock in the evening of November 2d, 1875, a collision occurred in the East river, near Throgg's Neck, be-

tween the schooner Jesse Williamson, Jr., owned by the libellants in the second suit, and the barge James A. Burden, in tow of the tug Blanche Page, both owned by the libellant in the first suit. The evening was clear, but dark, and the moon had just set. The wind was heavy from the northward and westward. The schooner was loaded with coal and on a voyage from Port Johnson, New Jersey, to Portsmouth, New Hampshire. Her crew consisted of a captain, mate, three seamen and a cook. Her regulation lights were properly set and burning. The tug was on her way from New Haven to New York, and towing the barge astern, by a hawser at least seventy or eighty fathoms long. The length of the barge was one hundred and twenty or one hundred and thirty feet. The lights of the tug were as follows—a white head light forward; a red light on the port side; a green light on the starboard side; and two white globe lanterns on the flag-staff aft, hung one above the other. The lights aft were not of a character to be visible on a dark night, with a clear atmosphere, at a distance of five miles, and were not otherwise constructed, or fixed, as mast-head lights. The barge had two white globe lanterns hanging one above the other from her flag-staff, burning dimly, but no other lights whatever. The speed of the tug, with her tow, was five or six miles an hour, and that of the schooner somewhat more. The usual course from the East, around Throgg's Neck, is southwest by south to the Point, and then around the buoy to west-northwest. In this case, the tug, when she rounded the buoy, hauled a point, or a point and a half, further north, on account of the wind. The schooner was steering so as to make Throgg's Point as close as she could with safety, because, when she rounded the Point, she would be compelled to come up more into the wind. She had on deck her captain, mate, and three seamen. The mate was on the lookout and the two seamen were forward with him. The captain was aft and the third seaman was at the wheel. The mate, on the lookout, saw and reported the green light of the tug off the port bow, then the white head light, then the red light, and finally the green

light shut out. No other lights were seen. After this the captain called the mate aft and went forward on the lookout himself. Soon after getting forward he sent the seamen to tend the main sheets, on rounding the Point. The schooner passed the tug port to port, at a safe distance, and steadily kept her course. The red light of the schooner was seen from the tug about the time of passing the buoy. This was when the tug's lights were first discovered from the schooner. The vessels could not then have been more than a mile apart, if as much as that. The red light of the schooner was alone seen from the tug. Immediately after the seamen were sent aft, the captain saw the hull of the barge loom up close by, out of the darkness, and angling across the schooner's bow. He saw no lights. This was the first time that the barge, or anything on her, had been seen from the schooner. The wheel was at once put to port, but not in time to avoid a collision. The schooner struck the barge on the port side, fifteen or twenty feet forward of the stern. The blow knocked down the stanchions and joiner work, which caught fire from a stove. The barge was partially burned and sunk, with her cargo on board. As soon as the man at the wheel of the barge saw, by the way the schooner was coming, that a collision was possible, he ported his wheel, and then, when the schooner lapped the barge, starboarded it, hoping to swing the stem off. The commissioner's report as to damages is supported by the evidence. Rule IX of the Rules and Regulations of the supervising inspectors appointed under the authority of the Act of February 28th, 1871, (16 *U. S. Stat. at Large*, 440; *Rev. Stat., secs.* 4,405 *and* 4,412,) is as follows: 'Steam vessels, when towing other vessels, shall carry two bright white mast-head lights vertically, in addition to their side lights, so as to distinguish them from other steam vessels. Each of these mast-head lights shall be of the same construction and character as the mast-head lights which other steam vessels are required to carry; and, in addition to the lights herein referred to, when engaged in towing canal-boats and barges, or both, as is customary on the Hudson and other

rivers, white lights shall also be carried on the extreme outside of the tow on either hand, and also on the extreme after part of the same.' This Rule was approved by the Secretary of the Treasury."

George A. Black, for the schooner.

Robert D. Benedict, for the tug and the barge.

WAITE, Ch. J. The only question which I think it necessary to consider in this case is, whether the tug carried "two bright white mast-head lights vertically," or their legal equivalent.

Rule 4 of the statutory navigation Rules, (*Rev. Stat.*, *sec.* 4,233,) provides, that "steam vessels, when towing other vessels, shall carry two bright white mast-head lights vertically, in addition to their side lights, so as to distinguish them from other steam vessels. Each of these mast-head lights shall be of the same character and construction as the mast-head lights prescribed by Rule 3;" that is to say, (*Rule* 3,) "a bright white light, of such a character as to be visible on a dark night, with a clear atmosphere, at a distance of at least five miles, and so constructed as to show a uniform and unbroken light over an arc of the horizon of twenty points of the compass, and so fixed as to throw the light ten points on each side of the vessel, namely, from right ahead to two points abaft the beam on either side." Such a light must be carried at the foremast-head of an ocean-going steamer, or a steamer carrying sail. Steam vessels not carrying sail and navigating bays, lakes, rivers, or other inland waters, are required, by Rule 7, to carry, in addition to their colored lights, "a central range of two white lights, the after light being carried at an elevation of at least fifteen feet above the light at the head of the vessel. The head light shall be so constructed as to show a good light through twenty points of the compass, namely, from right ahead to two points abaft the beam on either side of the

vessel, and the after light so as to show all around the horizon."

This tug could not carry a light at her mast-head, for she had no mast, but she could carry two bright white lights vertically, of a *character* to be visible five miles away on a dark night, with a clear atmosphere, and so *constructed* as to show a uniform and unbroken light ahead, and from ten points on one side to ten points on the other of the vessel. This would be a light of the character and construction which ocean steamers, and steamers carrying sail, are required to have at the foremast-head. I deem it unnecessary to decide, in this case, whether, if two lights of a power equal to what is required for mast-head lights, are suspended vertically on the flag-staff at the stern of a tug, in such a manner as to show a uniform and unbroken light ahead over an arc of twenty points of the compass, they would be the legal equivalent of two mast-head lights; for, I am clear, that, unless there are two lights of that power and efficiency, carried vertically somewhere on the vessel, Rule 4 is not complied with.

That such lights were not carried on this tug is very apparent from the evidence. It is conceded, that ordinary globe lanterns only were used. The mate, when acting as lookout on the schooner, must have been vigilant. He saw, first, the green light, then the white at the head, then the red, and then the green shut in, as the tug approached and rounded the buoy, and put herself on her course down the river. The head light was seen, while those from the flagstaff were not. The presumption is, that the light ahead was such as was required by Rule 7, and, therefore, of the same character and construction as that prescribed by Rule 3, for the mast-head. As that light was seen, the conclusion is irresistible, that the stern lights were not of the same power, or were not so placed as to present the view which the law required. This, under the circumstances, is not only a fault in law, but a fault in fact. The schooner, while, to my mind, in all particulars vigilant, was not actually informed that she was to meet a tow, until the hull of the barge loomed up out of the

darkness, immediately ahead, almost at the very moment of the collision. Clearly, if the circumstances are such as to make it proper for a tug to keep a tow four to five hundred feet away from her, she should be specially careful not only to notify approaching vessels that a tow is following, but, as near as may be, where it is. A sailing vessel must hold her course while a steamer is keeping out of her way in passing, but this obligation continues only so long as the steamer is passing. The sailing vessel should, therefore, be told where the steamer is, and as, for the purposes of this rule, the tug and her tow are to be considered as one vessel, and that the tug, it is necessary that the required information should extend to both tow and tug. In the day time, the tug may assume that both will be seen from the sail vessel, and act accordingly; but, at night, and in the dark, this is impossible, and, consequently, the law has supplied a system of arbitrary signals, intended to make up for the loss of vision by day. If these signals are omitted, and the sailing vessel comes into collision for want of them, the loss must fall on the tug, where the fault lies.

There can be no doubt that this collision was caused, in part, at least, by a want of proper towing lights. Had the schooner been told, in the appropriate way, of the approach and presence of a tug and tow, she would have watched as well for the tow as the tug, and, if she had found the tow driven out of its course, as this one undoubtedly was, by force of the wind, or otherwise, she would have taken some measures herself to prevent a collision. From the manner in which this schooner was navigated, I have no doubt whatever, if she had known that a tow was following the barge, the loss never would have happened. She was keeping up as close to Throgg's Point as she could, in order to take advantage of the wind and save herself from going off too much to leeward, when she got by. There was room enough for her to keep off; and there can be no reasonable doubt that she would have done so had she known it was necessary. Not knowing of the barge, she held her course, as she certainly had the

right to do, with the information she had. In this I recognize fully the rule, that, while a tug must keep herself, as well as her tow, out of the way, a sailing vessel is not permitted to run down a tow, if it gets beyond the control of a tug, and she can, with reasonable effort, avoid it.

Holding, as I do, that a tug, while towing in inland waters, must exhibit vertically two bright white lights, of equal power with the mast-head lights of sea-going steamers, so fixed as to present a uniform and unbroken light right ahead and ten points on either side, and that this tug was in fault in this particular, it is unnecessary to inquire whether Rule IX of the board of supervising inspectors has the force of law, as a rule of navigation. By section 4,412 of the Revised Statutes, the board has the right to "establish such regulations, to be observed by all steam vessels, in passing each other, as they shall, from time to time, deem necessary for safety," and, by section 4,405, these rules, when approved by the Secretary of the Treasury, "have the force of law." The statutory navigation Rules, (*sec.* 4,233, *Rule* 8,) prescribe lights for sailing vessels while being towed, but omit any provision for canal-boats, barges, &c., when towed, as is customary in rivers and other inland waters. This is an important omission, and, if there is really any doubt as to the power of the board to bind towing steamers by this rule, in passing sailing vessels, the necessary legislation to remedy the defect should at once be obtained. The absolute necessity there is for some such rule must certainly be acknowledged, if tugs are permitted to separate themselves long distances from their tows, and then make up the tow of any size or form they please.

I see no reason for disturbing the report of the commissioner as to the amount of damages.

A decree may be prepared, dismissing the libel of Starin, with costs in both Courts, and in favor of Sise and others, for $1,076 74, and interest on $627 86 from November 26th, 1875, and on $446 88 from November 20th, 1877, at six *per cent.*, that being the amount allowed by the commissioner.

The Nevada.

A large ocean steamer has no right to leave her moorings in a narrow slip crowded with other craft, by the use of her own propeller, without taking the utmost care to prevent accidents by the disturbance of the water which necessarily follows.

She must maintain complete control of herself, and, if she cannot get out by the use of her own propeller, without doing damage to other vessels that are lawfully moored near her, she must employ a tug.

In leaving the slip, she must keep a lookout astern, and over her side, into the slip, if necessary.

(Before Waite, Ch. J., Southern District of New York, August 28th, 1879.)

This was a libel *in rem*, in Admiralty, filed in the District Court. After a decree in favor of the libellants, the claimants appealed to this Court. The decision of the District Court, (Blatchford, J.,) was as follows: "The libel in this case is filed by Sergeant J. Quick, as master and owner of the canal boat Kate Green, for himself and for F. A. McKnight, against the steamship Nevada. The Kate Green and a cargo of corn on board of her were sunk in the slip between piers 46 and 47, North river, in the city of New York, on the 27th of September, 1871, by a collision between her and the Nevada. The cargo was insured by The Western Insurance Company of Buffalo, which paid the loss, and its interest is vested in McKnight. The Nevada, a screw steamer, was moored at the north side of pier 46, lengthwise of the pier, with her bow towards the river, and, about 3 P. M., in full daylight, she steamed from her berth and went out and down the river and out to sea. The Kate Green was in the slip, and was, by the suction caused by the revolution of the screw of the Nevada, drawn into contact with the blades of the screw, as it revolved, so that the blades made holes in the bottom of the Kate Green and let in water, which caused her to sink, with her cargo, in a very short time. No person on board of the Nevada knew of the occurrence until she reached Liver-

pool, which was her destination. The libel alleges, that the Kate Green was properly and securely moored and fastened. and that the collision occurred through the negligence of those in charge of the Nevada, and not through any neglect on the part of the Kate Green, her master and crew. The libel claims for a total loss of the canal boat and her cargo. The answer alleges, that the Kate Green was made fast, by her bow only, to a floating grain elevator which lay alongside and to the south of a steamer which was lying at the south side of pier 47; that the stern of the Kate Green was not fastened to anything; that between the Kate Green and said steamer there were two canal boats and another elevator; that the Kate Green remained thus made fast until the hour arrived for the Nevada to sail; that her master was notified of the approaching departure of the Nevada, and was warned that the boat was not properly moored, and was exposed to danger from the departure of the Nevada; that, notwithstanding said warning, he neglected to take the steps necessary to secure the boat; that the Nevada, at the hour appointed, left her berth, and, moving slowly and carefully, proceeded out into the river; that, previous to and while so leaving her berth, the steam whistle was blown, the bells on deck were rung, and all usual and proper precautions were taken to announce said departure and to avoid collision with the several lighters and canal boats lying in the slip; that, as the natural and ordinary result of the movement of the Nevada through the water, and of the action of her screw, the water was sucked or drawn towards the Nevada, and the stern of the canal boat, so allowed to remain unfastened, was thereby drawn over to the side of the Nevada, and struck against the Nevada with a violent blow; also, that the collision was occasioned solely by the negligence of the master and crew of the Kate Green, and by reason of her said improper and insufficient mooring. The fair reading of the answer is, that the situation and insufficient mooring of the Kate Green were seen and known by those on board of the Nevada, that the Kate Green was warned in respect thereto, that she neglected to moor herself

more securely; that, after such warning was given, those on the Nevada saw that the Kate Green did not moor herself more securely, and saw that she continued to be insufficiently moored; and that, nevertheless, the Nevada, with full knowledge that the natural and ordinary result of the action of her screw, as she would move ahead, would be to suck or draw the water, and with it the unfastened portion of the Kate Green, over to the Nevada, put her screw in motion, and kept it in motion, until the collision occurred, in consequence of such drawing over of the Kate Green until she struck the Nevada. A clearer case of negligence on the part of the Nevada could not well be set forth. Much evidence is given as to the mooring of the Kate Green; as to whether she was fastened at all by lines to anything; and as to how she was fastened, if she was fastened. I deem it unprofitable to discuss or determine those questions, and many other questions as to which evidence was given. The case is easy of solution on plain propositions. If the Kate Green was loose in the slip, and not fastened at all, her condition ought to have been seen by and known to those on the Nevada, and it was negligence in them to set the screw of the Nevada in motion, under such circumstances that the Kate Green could be drawn over against the Nevada by the suction of the screw of the Nevada. And this is true whether the Kate Green was warned or not, and whether, when warned, she was loose or was only insufficiently fastened. And it is true whether the warning came from the Nevada or from elsewhere. Indeed, an unheeded warning from the Nevada, given before the Nevada set her screw in motion, so far from relieving the Nevada from fault, only serves to make her fault in starting her screw more clear, as showing that she had her attention called to the perilous condition of the Kate Green, and yet set her screw in motion. If the Kate Green was fastened, she was so fastened that she was at such a distance from the Nevada, that, after she began to be drawn over by the suction of the moving screw of the Nevada, there was abundant time for the Nevada to have stopped her screw and avoided the col-

lision, if there had been a proper lookout kept in the proper place on board of the Nevada. The fact, that no one on board of the Nevada knew or heard of the accident till she had crossed the ocean, tells the whole story. It is abundantly proved, that, as the Kate Green was being drawn over by the suction of the moving screw of the Nevada, the Nevada was hailed from the Kate Green to stop her screw, but no heed was paid to the hail, by the Nevada, because there was no person in a position on the Nevada to hear the hail. Whatever observation was made by those on the Nevada, of the position of the vessels in the slip, preparatory to the sailing of the Nevada, and whatever warning she gave by any hails to any boat in the slip, were made and given, on the evidence, at a time before the Kate Green had come into the slip. Indeed, the answer does not aver that any oral notice or hail or warning was given to the Kate Green by any one on board of the Nevada. As there was fault on the part of the Nevada, causing damage to the cargo of the Kate Green, and as the Nevada alone is sued in this suit for such damage, and as no fault, if any, of the Kate Green, can be imputed to the cargo, there would have to be a decree against the Nevada in respect to the cargo, even if the Kate Green also were found to be in fault for the collision. As to the boat herself, I do not find that she was in fault. If she was loose, not fastened, she was not in fault for remaining so, whether warned or not, because it was the duty of the Nevada to see her condition and not to put her screw in motion. If the Kate Green was fastened, she was fastened at a distance from the Nevada which allowed abundant time, if her fastenings parted, for the Nevada, with a proper lookout, to stop her screw, after the Kate Green began to be drawn over. In either view, the Kate Green, in fact, hailed the Nevada, after the suction began to take effect, in season for the Nevada to have stopped her screw and saved the collision, if an officer of the Nevada had been stationed in a proper place, to observe the condition of the Kate Green and to hear the hail. There

must be a decree for the libellant, as to both boat and cargo, with a reference to ascertain the damages."

This Court found the following facts: "About three o'clock in the afternoon of September 27th, 1871, the steamship Nevada left her berth in the slip between piers 46 and 47, North River, New York, on a voyage to Liverpool. She was one of a line of ocean steamers plying regularly between New York and Liverpool, owned by an English corporation of which Williams & Guion were agents in New York, and, previous to her departure, lay on the north side of pier 46, with her bow toward the river, and her stern toward the bulkhead. The slip was two hundred and five feet wide, pier 46 six hundred and thirty feet long, and pier 47 six hundred and twenty-four. On the opposite of the slip, and on the south side of pier 47, lay the steamship Queen, also with her bow toward the river, and her stern toward the bulkhead. The bow of the Nevada was about thirteen feet back from the end of her pier, and that of the Queen fifty-two feet six inches from the end of hers. Two floating grain elevators lay alongside of, and moored to, the Queen; one named the Scotia, at one of the forward hatches, and the other, named the Metropolitan, at one of the after hatches. The canal boat Sarah and Madonna, lay alongside of the Metropolitan, with her stern toward the bulkhead, and was being unloaded into the Queen. At her stern lay the canal boat C. H. Hart, with her bow toward the bulkhead, and extending some distance beyond the Metropolitan. Her stern was made fast by a line to the Metropolitan, and her bow by another leading to the deck of the Queen. She was waiting her turn to be unloaded. One or more boats lay alongside the Scotia, and moored to her, and there were two lighters at the bulkhead, astern of the Nevada. The length of the Nevada was three hundred and fifty-five feet, and her beam forty-three feet, four inches. The length of the Queen was three hundred and eighty-one feet, and her beam forty-two feet four inches. The Metropolitan was about eighty-seven feet long, and her width twenty-four feet. The C. H. Hart was ninety-six feet long,

and her width seventeen feet, four inches. Just as the Nevada was starting, the canal boat Kate Green, owned and commanded by the libellant Quick, came into the slip, in tow, on the port side, of the tug Jacob Sinex, and was placed alongside the C. H. Hart. Her master, Quick, made a line from her bow to the bow of the Hart, and her steersman another from her stern to the stern of the Hart. While this was being done, the tug let go and commenced backing out of the the slip, but she had only time to get under the stern of the Kate Green, or a little beyond, when the Nevada started. Previous to the time the Kate Green came into the slip, full public notice had been given by those in charge of the Nevada, that she was about to depart, and particular notice was also given to all the boats then alongside the Queen, including the C. H. Hart. When the Hart came in she was sent up the slip, in order that she might keep out of the way. The Nevada had been advertised to sail at that hour. Her bells had been rung, and her whistles blown, several times. Signals, indicating that she was about to depart, were flying at her mast-head. She took out, on that voyage, a considerable number of cabin and steerage passengers, and there was about her decks and on her pier, all the bustle and noise which usually accompanys the sailing of a large ocean steamer. The Kate Green was not seen from the Nevada when she came in, and no special notice was given to her that the Nevada was about to leave. She had no time, after her arrival, to give particular attention to what was being done on board of the Nevada, or on the pier. All the bells were rung and whistles blown before she arrived, or while the attention of those on board was given to making her fast and getting away from the tug. Neither was there time for her master to examine particularly the fastenings of the Hart. The Nevada started almost simultaneously with her getting alongside the Hart, and the first actual notice she had that the Nevada was about to leave was when the propeller commenced moving. If she was, in fact, made fast at the time, it had only just been done. She lay about sixty feet from the Nevada.

The tide was flood, and running up by the ends of the pier, pretty strong. When the Nevada started, the revolution of her propeller and her own motion caused a displacement of the water in the slip, and a suction, which drew the Hart and the Green away from where they were lying, and broke the bow fastenings of the Hart. As soon as this was done, the Green swung rapidly towards the Nevada. Her master, who was on deck, called loudly to the Nevada to stop the propeller, but he was not heard, or, if heard, not heeded. The Nevada kept on without stopping, and the revolving blades of her screw struck the Green under the water line, and a little aft of the port bow, inflicting such an injury as caused her, the Green, to sink soon after, with her cargo on board, and some articles of furniture, &c., belonging to her owner. No one on board of the Nevada knew of the parting of the Hart's lines, or of the swinging of the Green, or of the accident, until after she arrived in Liverpool, If a man had looked from her deck over her side into the slip, he could not have failed to see what was going on all the time from the first movement of the propeller, and before, until she got out. There was an abundance of time, after the breaking of the fastenings of the Hart, and after the Green began to swing, and after the hail of her master, to have stopped the propeller, before the collision. The report of the commissioner as to the damages, is warranted by the evidence, and the libellant, McKnight, was the owner of the claim for damages when the libel was filed."

E. H. Lewis, for the libellants.

Stephen P. Nash and *George C. Holt*, for the claimant.

WAITE, Ch. J. There are many palpable errors in the testimony in this case, but the material facts, as found, are satisfactorily proven, and are sufficient, as I think, to charge the Nevada with fault. A large ocean steamer has no right to leave her moorings in a narrow slip crowded with other

craft, by the use of her own propeller, without taking the utmost care to prevent accidents by the disturbance of the water which necessarily follows. The natural effect of the revolution of her propeller is to draw towards her stern all objects near by, movable in the water, and that, added to the displacement of the water, by the movement of the vessel herself, in such a slip, makes it the duty of the officers and men responsible for her navigation to be specially vigilant, and to keep the vessel completely under their control, until all danger is past. Other vessels have the right to come into the slip and moor themselves. She has an equal right to be there, and to start on her voyage when she is ready, but she cannot, with impunity, cause damage to other vessels lying near, by any neglect of her own navigation in going out. She must watch for, and, if necessary, give warning of danger.

Some witnesses have testified that the Kate Green was told, when she came in, that the Nevada was about to leave, and sent up into the slip to get out of the way, but, upon the whole evidence, it is manifest to my mind they were mistaken, and that they confounded the Green with the Hart, which arrived a short time before, and which, undoubtedly, was warned. I do not entertain a doubt, that the Green got into the slip without being noticed from the Nevada, or by any one charged in any manner with her navigation. The entire attention of those on board the Nevada, officers as well as men, so far as I can discover, was directed towards her and to getting her away from her pier, and into the stream, without injury to herself. No notice whatever was taken of the other vessels in the slip, and no one was set to look out for danger on the other side of the vessel, or at the stern, when it ought to have been known that much damage might be done to the neighboring vessels by the screw, if from any cause they got loose from their moorings. This I cannot but consider, under the circumstances, a gross fault. With the large number of competent officers and men which the prudent and successful navigation of such a vessel required on board, there was no difficulty in providing men for the per-

formance of that duty, and, if they had been at their posts, the Green would have been seen, as she approached the slip, and stopped outside, or sent up into the slip with her tug, away from danger, to wait until the Nevada had gone. The fastenings of the Hart might have been strengthened, to meet the additional strain caused by the presence of the Green alongside, or, when the boats broke away, and the Green swung over, the propeller might have been stopped until she could have been got away. I know that, since the appeal, testimony has been taken to show that it would have been unsafe to stop the propeller after the steamer had started, because of the effect of the tide upon her bow when it got outside the end of the pier. If this was really so, of which I am by no means certain, it was a fault in the steamer to start without making provision to counteract the effect of the tide, in case it became necessary to stop. The rule hardly admits of an exception, which requires a steamer moving by her own power, in a crowded and narrow slip, to maintain complete control of herself. She is not likely to be put in a situation, during her entire voyage, where other vessels will be exposed to so much danger from her movements as there, and, if she cannot get out by the use of her own propeller, without doing damage to other vessels that are lawfully moored near her, she must employ a tug.

An attempt has been made to prove that the steamer broke a hawser leading from her to her pier, as she went out, and that her stern swung away from the pier and out into the slip. The testimony on both these points is very conflicting, and it is not easy to say what the actual facts were; but, in the view I take of this case, they are unimportant. The real fault of the steamer was in not keeping a lookout astern, and over her side, into the slip. The office of a lookout is to watch for the approach of danger, and he should be stationed where he can best do what is required of him. At sea, danger is most to be looked for ahead, and the lookout takes his place at the bow; but, in a crowded slip, there is as much, and oftentimes more, use for him at the stern, or over

the side, than at the bow. Under such circumstances, it is as important to keep men stationed there, as at sea it would be forward. Thus much for the Nevada.

At first, I was inclined to think the Kate Green was also at fault, but, on further reflection, have reached a different conclusion. In *The City of Paris*, (14 *Blatchf. C. C. R.*, 531,) a case like this in many of its features, I held a canal boat responsible equally with the steamer, and divided the damages, because the canal boat was insufficiently moored; but, there, the steamer was known to be about to sail long before she started, and the captain of the canal boat ought to have known that the boat alongside of which he was moored was not securely fastened. Besides this, he lay within twenty-five feet of the steamer, and a very little change of position would bring the vessels together. Here, however, the Kate Green had no actual notice that the steamer was about to leave, and I am by no means satisfied that she was securely made fast to the Hart before the propeller was set in motion. If there had been time enough, she might have seen, by the indications on the steamer or the pier, that the steamer was about to start, but, in passing into and along the slip, she was cut off from any view of what was going on. If she had had time, also, she might have seen that the Hart was not sufficiently fastened to hold the two boats; and it is possible, that, but for this, the rule acted upon in *The City of Paris* might, with propriety, be applied here. But, upon the case as it stands, I think the whole fault must be charged on the steamer. Had she kept her proper lookout, and given the necessary warning, all defects in the mooring of the canal boat could have been avoided.

The delay in filing the libel is sufficiently explained, and no change has taken place in the ownership of the Nevada since the loss. The suit, therefore, is not barred by lapse of time. While there may have been some difficulty in obtaining testimony, caused by the length of time which elapsed between the occurrence and the trial, the facts on which the case turns, if not admitted, are not seriously contested.

There is no complaint as to the amount of damages allowed by the commissioner, except in relation to the value of the canal boat, and in that I think the preponderance of evidence is in favor of the report.

A decree may be prepared in favor of the libellant Quick, for three thousand one hundred dollars, and interest at six per cent. from September 27th, 1871, and in favor of the libellant McKnight, for five thousand eight hundred and and sixty $\frac{61}{100}$ dollars, with like interest from the same date, and for costs.

The Shady Side.

A steam tug moving in a slip, in a fog, and inside of the ends of the piers, is not required to sound her steam whistles, as a signal to a steamer moving up the river outside of the slip, and which runs into the slip and collides with her.

A steamer running up a river in a fog mistook her way and ran into a slip at a speed which made it impossible for her to stop, so as to avoid a collision with a tug inside of the slip, after the tug came in sight, and was held in fault for not running at a moderate speed in a fog.

The tug having been sunk by the collision, the libellant procured her to be raised. She was sold to the libellant for $18, in a suit against her by the person who raised her. The libellant afterwards paid the charge for raising her, $600. The expense of repairing her, added to the cost of raising her and a reasonable demurrage, exceeded what would have been her value when repaired. This Court allowed the libellant $3,500, as her value at the time of her loss, as a total loss. The value of what was saved was sufficient to pay the expense of saving it, but no more; and the value of the tug when raised was equal to the expense incurred in searching for and raising her, but no more.

This Court allowed to the libellant his costs in the District Court, and, as the claimant had been partially successful on the appeal, it divided the costs in this Court.

(Before Waite, Ch. J., Southern District of New York, August 28th, 1879.)

This was a libel *in rem*, filed in the District Court, for a collision. That Court decreed for the libellant, with costs,

and awarded to him $5,000, as the value of his tug at the time of her loss, as a total loss, with interest; $600, as the expense of raising her, with interest; $250 for the time and disbursements of the libellant, after the collision, in finding his tug and preserving her; and $300 for her furniture lost, not appurtenances, with interest; in all, $6,803 10, for which amount, with interest, and $720 37, costs, being, in all, $7,616 05, a decree was entered. The claimant appealed to this Court. This Court found the following facts: "At about eight o'clock in the morning of March 16th, 1875, the steam tug Mary, owned by the libellant, and which had been laid up the night before on the upper side of pier 52, East river, New York, near the bulkhead in the slips between piers 52 and 53, left her berth to back across the slip, and take on her fenders, either at pier 53, or at a brig lying alongside that pier. The brig lay at the lower side of the pier, with her bow toward the bulkhead of the slip, and her stern about seventy feet inside the outer end of the pier. The brig was about one hundred feet long. Pier 52 was about two hundred feet long, and pier 53 about two hundred and eighteen. The slip between them was about five hundred and fifty feet wide. The tide was strong ebb, and a thick fog was prevailing. The Shady Side was a side-wheel steamer, running on a ferry between pier 22, East river, and Morrisania. She left her pier at 7.45 that morning, bound up the East river, on a trip to connect at Morrisania with the Port Chester Railroad, at 8.25. When she was about opposite Catharine street, the fog growing thicker, she was slowed down, and her course, which, to that time, had been well out in the river, going up parallel with the ends of the piers, was changed so as to head, as was supposed, about for the end of pier 53. That pier could not be seen at the time, and the course was shaped by compass. At pier 38 the fog lighted up again, and she was run at full speed until she reached pier 45, when, the fog again becoming thicker, she was slowed once more, and her course changed, so as to bring her in nearer the piers. She passed pier 52 not a great distance away, and headed on her course, which would

take her somewhat inside the end of pier 53. That pier could not then be seen from her. When the Shady Side was passing pier 52, the Mary was in the slip, about halfway across from pier 52 to the brig. She lay a little angling across the slip, her stern being nearer the brig than her bow. Her stern was not then as far out toward the end of the pier as was the stern of the brig. Her engine was stopped, though she still had a little sternway on. The intention was to have her taken by an eddy in the slip over towards the brig. The wheelsman on the Shady Side first saw the Mary when he, in the pilot house, was about opposite, or a little past, pier 52. The attention of the captain was at once called to the Mary, and he rang the bell to stop and back, and hove the wheel hard over to starboard. The Shady Side was at the time headed for the Mary, and under strong headway. The Mary, seeing her coming, commenced backing, but, before the Shady Side could be stopped, or the Mary got out of the way, the vessels came together, the Shady Side striking the Mary on her port side, about twenty feet aft of the stem, cutting into her nearly as far as the keel. The force of the blow was such as to throw the captain of the Mary, who was standing on the outside of the pilot house, and another man on deck, overboard. The engineer of the Mary got on board the Shady Side, without shutting off his engine, which was backing. The engine kept up its backward motion until the vessels got separated, and then the Mary was carried about two-thirds the way across the river, and down as far as the bridge pier, where she sank. The Shady Side kept on under headway until she came within a few feet of the brig. When she stopped, she was headed so as to strike the brig about fifteen feet from the stern. The collision occurred a considerable distance inside the ends of the piers. The Mary did not sound her whistle when she left her berth, or at any time while moving in the slip. She at no time went outside the slip. The Mary was about sixty-eight feet long, and the Shady Side about one hundred and sixty-eight. Some time was spent in searching for the Mary, after she sank. She was found in

very deep water, and in a much frequented part of the harbor. Some difficulty was experienced in getting parties willing to contract for raising her. She was at last raised, however, and taken to the Hoboken flats. The price paid for this work was six hundred dollars. While she was lying on the flats, an effort was made to have the claimant agree that she should be considered a total loss, and the rights of the parties determined accordingly. The claimant not assenting to this, the contractors for raising her commenced a suit against her, in Admiralty, to recover the amount due them. This was done with the consent of the libellant, and, a decree having been obtained for her sale, she was bid in by the libellant for eighteen dollars. After this was done, the libellant paid the debt. He made no defence in the Admiralty suit. Soon after the purchase was made at this sale, she was taken by the libellan t to a dry dock in New York, where some repairs were made. But little was done, however, and she was taken down to pier 52. After lying there awhile, she was removed to a small creek on Long Island, and there beached. When she was raised she was not worth repairing. The cost of repairs, added to the expense of raising, and a proper allowance for demurrage, would amount to more than she would be worth when repaired. The value of the Mary, at the time of the collision, was thirty-five hundred dollars. Her value when raised was equal to the expense incurred in searching for and raising her, but no more."

F. A. Wilcox, for the libellant.

Dennis McMahon, for the claimant.

WAITE, CH. J. The only fault charged upon the Mary is her failure to sound her whistle. The evidence leaves no doubt on my mind, that the collision occurred inside the ends of the piers, and that the Mary was simply moving across the slip. The sailing rules require, that steam vessels, when under

way in a fog, shall sound their steam whistles, and, when not under way, their bell. This evidently applies to vessels moored, or moving in the way of commerce, and not to those lying at docks, or, ordinarily, to those moving about in slips. The object is not to notify vessels of their approach to the land, but of the proximity of other vessels in the waters they are navigating. The Shady Side was moving up the river. Her course was entirely outside the slip. A whistle sounded as a fog signal in the slip would tend to deceive rather than give information as to the actual facts. Such a signal would indicate the channel or fairway of the river, rather than a place inside the land, as a slip really is. What the Shady Side expected was information as to the waters she was to navigate, not the mooring places along the shore in the harbor. It was not a fault of the Mary, therefore, toward the Shady Side, to omit the sounding of her whistle.

The Shady Side was clearly in fault. While running in a fog, in a harbor liable to be crowded, she mistook her way and ran into a slip at a speed which made it impossible for her to stop, so as to avoid a collision, after an obstruction came in sight. Such speed was certainly not moderate, under the circumstances, and indicated a want of caution, which is entirely inexcusable while navigating a harbor like that of New York, in a dense fog.

The real controversy in the case is as to the amount of damages. The libellant claims as for a total loss, because the expenses of repairs, added to the cost of raising and a reasonable demurrage, would exceed the value of the vessel when repaired. In this, I think, he is sustained by the evidence; but, if the boat had been sound and in all respects in a good condition at the time of the collision, the case would have been different. Neither the engine nor the boiler were seriously injured by the blow. The hull alone was hit. Had that been reasonably strong, it is scarcely to be believed that a cut into the side only, even as far as the keel, would have put her past repair. The fact, that, after she was taken out on the dock, her owner abandoned her, is evidence that, to his

mind, her hull was not worth repairing. The mere mending of the break would not make an otherwise weak hull strong.

Whatever damage happened to the engine and boiler, save in some important particulars, was caused by the sinking. This seems to have developed the fact that the boiler was substantially worn out, and that the engine might possibly not be worth a new hull. The libellant, under these circumstances, is entitled to recover as for a total loss, less the value of what was saved.

The testimony as to value is conflicting and not altogether satisfactory. My conclusion, however, is, that the vessel was in a condition which made her liable to fail at any time. So long as she could be kept up, she would do reasonably good work, and make fair earnings, but, when she began to give out, she was likely to go altogether. She was nearly sixteen years old, and had been bought by the libellant, in Boston, for two thousand dollars, three years before. Somewhat extensive repairs were made on her after this purchase, and her market value in New York may have been greater than it was in Boston. She was still, however, an old vessel. She had never been rebuilt. Her boiler was as old as the hull, and, undoubtedly, would have soon given out. Under all the circumstances, I cannot believe the actual value of the vessel was more than thirty-five hundred dollars. If it was, I am clear she ought to have been repaired.

The value of what was saved is sufficient to pay the expense of saving it, but no more.

The libellant may take a decree for three thousand five hundred dollars, with interest at six per cent. from March 16th, 1875. He is also entitled to recover his costs in the District Court, but, as the claimant has been partially successful on his appeal, the costs in this Court will be divided.

THE UNITED STATES, PLAINTIFFS IN ERROR

vs.

THE YORK STREET FLAX SPINNING COMPANY, DEFENDANT IN ERROR.

Under § 1 of the Act of March 3d, 1863, (12 *U. S. Stat. at Large*, 737, 738, *Rev. Stat.*, § 2,864,) forfeiting imported goods, or their value, to the United States, for fraud in the entry of the goods at the custom house, if a suit is brought for such value, such value is not limited to the sum which the defendant received for the identical goods entered, on their sale by him.

(Before WAITE, Ch. J., Southern District of New York, August 28th, 1879.)

WAITE, Ch. J. This is a suit to recover the value of certain goods alleged to have been forfeited to the United States under section 1 of the Act of March 3d, 1863, (12 *U. S. Stat. at Large*, 737, 738, *Rev. Stat., section* 2,864.) This Act provides, that, if an "owner, consignee, or agent of any goods, wares, or merchandise shall knowingly make, or attempt to make, an entry thereof by means of any false invoice, * * * said goods, wares and merchandise, or their value, shall be forfeited," &c. After the close of the testimony on the part of the Government, the defendant asked the Court to instruct the jury to bring in a verdict for the defendant, on the ground that none of the acts charged in the declaration as causes of forfeiture had been proven. This was denied, and the defendant then asked for a verdict because no proof had been made of the value of the goods, such value being the statutory basis of recovery. The Court thereupon ruled, "that the value of the goods, which must be taken as the basis of recovery, was the sum which the defendant received for the identical goods covered by the entries and invoices in the suit, in this country, the goods having passed into consumption, which sum, in the hands of the defendant, repre-

sented the goods themselves," and then, on the evidence as it stood, directed a verdict for the defendant. Many requests to charge were presented on behalf of the Government, which were refused, but, as they were intended to break the force of this ruling, it will not be necessary to refer to them in detail.

The entire testimony is not embraced in the bill of exceptions, and, under the ruling of the Court upon the first motion for a verdict, I must assume, that, so far as the acts of forfeiture were concerned, there was evidence sufficient to make it obligatory on the Court to submit the case to the jury. If, then, there is error in the ruling of the Court on the second motion, I must reverse the judgment, notwithstanding any doubt I may have on the case as it is presented here, about the propriety of subjecting the defendant to another trial on the merits, since the Act of June 22d, 1874, (18 *U. S. Stat. at Large*, 186,) has made actual intent to defraud an essential element of recovery. I must also assume that the evidence established the fact that the goods had gone into consumption, as that seems to have been one of the ingredients on which the Court based its ruling.

The question, as it comes here for determination, is not whether the value of the goods at the time of importation, or when they were sold or entered into consumption, or when the suit was commenced, is the proper basis of recovery, but whether the Government is bound to accept, under its election to take the value, what the fraudulent importer himself got for them when they passed out of his hands. I know it is settled, that, when provision is made by statute for "a forfeiture of goods or their value," the title to the goods remains in the original owner until the Government elects whether to demand the goods or their value, and that, if, before the election is made, the goods are sold to a *bona fide* purchaser, the title passes by the sale, and the right of the Government to proceed against the goods is gone. (*United States* v. *Grundy*, 3 *Cranch*, 338; *Caldwell* v. *United States*, 8 *How.*, 366.) This, however, falls far short of deciding, that, when the goods

are sold, or have entered into consumption, the Government must accept, as their value, what the importer has seen fit to part with them for; and it seems to me that the learned Judge below, in so holding, confined the basis of recovery within too narrow limits. The right to recover the value does not depend on any principle of subrogation, but on the statute, which, in effect, says, that, for this particular offence, the offending goods, or their value, shall be forfeited by the owner. The Government is given the right to choose whether it will take the goods or the value, and this right of choice is kept open so long as the goods remain the property of the offender. As soon, however, as they pass from his hands into those of a *bona fide* holder, the right of election is gone, and the Government is driven to its suit against the wrong-doer, not for what he has in the place of the goods, but for their value. The basis of recovery, in a suit for value, is not changed by the sale. That remains precisely as it was before. If this is not so, the Government has never any real right of election. Before the sale, it must proceed for the goods, and after, for the proceeds. Such, I think, cannot be the rule. Until the sale the Government may seize the goods, and realize their value by a sale, or it may pass by the goods and look directly to the wrong-doer for their value. The effect of a sale is to take away all right of proceeding against the goods, and leave the Government to its original right of action against the fraudulent importer, for the value only.

It was contended, however, upon the argument, that there was no evidence which the jury could properly consider, tending to prove the value of the goods in this country, and that, if the ruling below as to the basis of recovery was wrong, it could do no harm, since, on the whole evidence, the Court did right in taking the case from the jury. It is true, that no witness testified directly as to what the actual market value of the goods was in this country, either at the time of the importation, or at the time of the sale by the importer, or at the time of the commencement of the suit, or at any other

time; but there was evidence legitimately tending to prove what was wanted. It did appear, that the particular style of goods in question was principally manufactured in Belfast, and that the trade in the United States was almost exclusively supplied from there. Then there was direct evidence as to the market value in Belfast at the time of the exportation. There was, also, evidence tending to show what this defendant supposed the market value was in New York at the same time, exclusive of duties and charges of transportation, for, the managing director testified as to prices he charged in Belfast to American purchasers, as the equivalent of what the New York branch of the house would charge to their customers. This was for the purpose of preventing any competition in prices between the house at home and the branch in New York. This, I think, was proper evidence to be taken into consideration, inasmuch as Belfast was the principal producing point, and the value in New York would ordinarily be regulated by the price at which the goods could be purchased there. The importations were all made during the year 1873, and the suit was commenced in March, 1874. The legal presumptions growing out of the evidence submitted were, as I think, sufficient to place the burden on the defendant, of showing that the market value in New York was less than was indicated. It is possible the value thus shown was less than the actual forfeitable value, but of that, certainly, the defendant cannot complain.

An action in the nature of an action of debt lies, even though there may be some uncertainty as to the amount of recovery. A sum certain must be due, or a sum which can be named to a certainty. Here, the difficulty is not as to the right to recover a sum certain, to wit, the forfeitable value of the goods, but as to the amount of that sum. This the jury is asked to find from the evidence. The suit is not for damages on account of the wrongful acts of the importer, but for the recovery of a certain sum, to wit, the value of the property, as it shall be shown to be.

There are several assignments of error upon exceptions to

rulings below on the admissibility of evidence. These present questions not likely to arise on a second trial, and it does not seem to me necessary to take time for their consideration.

For the single error in respect to the rule for ascertaining the basis of value, the judgment is reversed, and the cause remanded for a new trial.

C. P. L. Butler, Jr., (*Assistant District Attorney*,) and *Sutherland Tenney*, (*Assistant District Attorney*,) for the plaintiffs in error.

Joseph H. Choate, for the defendant in error.

THE CONNECTICUT MUTUAL LIFE INSURANCE COMPANY

vs.

THE HOME INSURANCE COMPANY. IN EQUITY.

A mutual life insurance company issued to B. and to H. a policy insuring the life of B. for the benefit of H., for a premium to be paid on a specified day, annually. By the policy, it was to become void if B. should become so far intemperate as to impair his health. The premiums were paid for 6 years. Two months after the last payment the company cancelled the policy because it learned that B. had become so far intemperate as to impair his health, and notified H. of such cancellation, and offered to pay the surrender value of the policy. H. refused to recognize such cancellation, or to surrender the policy, and tendered to the company the annual premium every year, the tender being always refused. The company filed a bill in equity against H., praying that the policy be declared null, and be surrendered on payment of its surrender value. On demurrer: *Held*, that the bill would lie.

A Court of equity will exercise its power of setting aside contracts for defects not apparent on their face, although such defects arose after the execution of the contracts, in cases where special circumstances render it inequitable or unjust, or a hardship, to compel the plaintiff to await a suit at law at the instance of the other party.

The Connecticut Mutual Life Insurance Co. v. The Home Insurance Co.

The rule, that a Court of equity will not aid to enforce a forfeiture, or to divest an estate for breach of covenant or condition subsequent, is not applicable to the cancellation of a policy of insurance on the life of a living person.

(Before SHIPMAN, J., Connecticut, September 1st, 1879.)

SHIPMAN, J. This is a bill in equity, which alleges, in substance, as follows: On June 20th, 1870, the plaintiff, a Connecticut corporation, duly authorized to issue policies of insurance upon lives, issued to Henry H. Bigelow, and to the defendant, a New York corporation, a policy of insurance, whereby the plaintiff insured the life of said Bigelow, in the sum of $6,000, for the benefit of the defendant, upon the payment of a premium of $180 54, and upon the agreement of the insured to pay a like sum on or before June 20th, in every year, during the continuance of the policy. By said policy it was agreed, that, if the assured should become so far intemperate as to impair his health or induce delirium tremens, the policy should become null and void. The premium payments were made by the insured, or by the defendant, until and including the payment maturing June 20th, 1876. About August 28th, 1876, the plaintiff was first apprised that the insured had become so far intemperate as to impair his health. On said day said policy became null and void by said intemperance, and thereupon, on August 29th, 1876, the plaintiff cancelled said policy, and notified the defendant of said forfeiture and cancellation, and offered to pay, in cash, the surrender value of said policy, upon its surrender. Afterwards, the defendant, who is the true owner of the policy, and has acted as the exclusive owner thereof, on or about the day of , 1877, refused to recognize said cancellation, and declared that it should treat the contract as valid and outstanding against the plaintiff. The plaintiff offered to reinstate the policy, provided it should appear, upon a fair medical examination, that the health of the insured had not been impaired by intemperance since the date of the policy. The defendant refused to assent to such examination, and has the policy in its possession, and refuses to surrender the same,

and has, ever since said cancellation, tendered to the plaintiff, on June 20th in each year, the amount of the annual premium, which tender has always been refused. The defendant holds the contract as, in fact, a valid obligation of the plaintiff, and apparently valuable to any person to whom it may be negotiated. The plaintiff is a mutual company, and, by its charter, each policy holder is entitled to a voice in the election and management of the company. It is important, to the proper management of the company, and to a just distribution of its surplus, that the real holders of its policies be known absolutely. All the defences depend upon facts which do not appear upon the face of the instrument. There are, at present, within reach of legal process, a sufficient number of competent and credible witnesses to fully prove the avoidance of the policy, but the plaintiff fears that these witnesses, by death or other causes, may become unavailable for the purpose of resisting a suit upon the policy, at some future time, at the instance of the defendant. The plaintiff offers to pay the full surrender value of the policy at the time of its avoidance. The bill prays that the policy may be declared null, and that the defendant be ordered to surrender it to the plaintiff for cancellation, upon payment of its surrender value, or for other relief. To this bill the defendant has demurred generally. The ground of the demurrer is the alleged want of power in a Court of equity to cancel the policy at the instance of the insurance company; and it is insisted, (1st,) that, while a Court of equity has power to cancel instruments which are void by reason of fraud in their inception, it has no jurisdiction to cancel instruments which have ceased to be binding since their execution; (2d,) that while, at the instance of the assured, a Court of equity may compel an insurance company to reinstate a cancelled contract, equity will not interfere to enforce a forfeiture.

(1.) Upon the first proposition, it is true, that a Court of equity has not, or will not exercise, jurisdiction to cancel a contract, merely because it has become void or inoperative by reason of some fact which has taken place since its execu-

tion. Such an exercise of power would give a Court of equity concurrent jurisdiction with Courts of law over all contracts which one contracting party may allege to have been broken by the other. (*Thornton* v. *Knight*, 16 *Simons*, 509.) But, while relief from the consequences of fraud is peculiarly the province of a Court of equity, it has not refused to cancel contracts which have been performed, or which have become inoperative, when the special circumstances of the case rendered it unjust or oppressive that the contract should be an outstanding claim against the plaintiff. The reasonable rule is, that a Court of equity will exercise its power of setting aside contracts for defects not apparent on their face, although such defects arose after the execution of the contracts, in cases where the special circumstances render it inequitable or unjust, or a hardship, to compel the plaintiff to await a suit at law at the instance of the other party. (*Hamilton* v. *Cummings*, 1 *Johns. Ch. R.*, 517; *Hoare* v. *Bremridge*, *Law R.*, 8 *Ch. App.*, 22; *Chipman* v. *Hartford*, 21 *Conn.*, 488; *Ferguson* v. *Fisk*, 28 *Conn.*, 501.) Chancellor Kent was inclined to think, in *Hamilton* v. *Cummings*, that a Court of equity had jurisdiction to set aside a bond or other instrument, whether the instrument was void for matter appearing on its face, or from the proofs, "and that these assumed distinctions were not well founded." He says: "Perhaps all the cases may be reconciled on the general principle, that the exercise of this power is to be regulated by sound discretion, as the circumstances of the individual case may dictate; and that the resort to equity, to be sustained, must be expedient, either because the instrument is liable to abuse from its negotiable nature, or because the defence, not arising on its face, may be difficult, or uncertain at law, or from some other special circumstances peculiar to the case, and rendering a resort here highly proper, and clear of all suspicion of any design to promote expense and litigation. If, however, the defect appears on the bond itself, the interference of this Court will depend on a question of expediency, and not on a question of jurisdiction."

(2.) It is true, that Courts of equity will not aid to enforce a forfeiture, or to divest an estate for breach of covenant or condition subsequent, unless, perhaps, under extraordinary circumstances. (*Horsburg* v. *Baker*, 1 *Peters*, 232; *Livingston* v. *Tompkins*, 4 *Johns. Ch. R.*, 415; 2 *Story's Eq. Juris.*, *sect.* 1,319.) When an estate has been forfeited, or when a pecuniary penalty has been incurred, by reason of the happening of a condition subsequent, or of the breach of a covenant, there is usually an immediate remedy at law to regain possession of the estate or to recover the penalty. There being such a remedy, equity will not interfere. "The great principle is, that equity will not assist in the recovery of a penalty or forfeiture, when the plaintiff may proceed at law to recover it." (*Livingston* v. *Tompkins*, 4 *Johns. Ch. R.*, 432.) In this case, there is no estate to be regained, there is no sum in damages to be recovered. The insured is still living, and a cancellation of the contract is the only result which is to be attained. The plaintiff has now no remedy at law, and, unless it can resort to a Court of equity, it must wait and become a defendant at the future suit of the holder of the policy. When such a suit will be commenced is a matter of uncertainty. The rule is not applicable to the cancellation of a policy of insurance upon the life of a living person.

The expediency of interference by a Court of equity is apparent from the following considerations: The cancellation of the policies of delinquent policy holders is a duty which a life insurance company owes to its other policy holders. All the insured have an interest that the covenants of each insured person as to health and the payment of premium shall be performed, and that the lives of the insured and the prosperity of the company shall not be impaired by any act which the insured person has agreed shall not be committed. The company insures the policy holders at a rate based upon the estimated average mortality of ordinary healthy persons at the ages of the insured respectively, and the insured agree, among other things, that they will not im-

pair their health by the immoderate use of intoxicating liquors. If the insured are permitted, with the knowledge of the company, to indulge in practices which notoriously invite disease, the system of insurance and the safety of the investment of other policy holders are endangered. Each insured person has an interest in the continuance of the life of every other insured person. In *N. Y. Life Ins. Co.* v. *Statham*, (3 *Otto*, 24,) Mr. Justice Bradley says: "The insured parties are associates in a great scheme. The associated relation exists whether the company be a mutual one or not. Each is interested in the engagements of all; for, out of the co-existence of many risks arises the law of average, which underlies the whole business."

But, it is said, the corporation possesses, by contract, the power of declaring that policies have been cancelled for the cause of intemperance. The plaintiff has already exercised this power, and has protected itself and its policy holders. It is not necessary that the policy should be judicially declared to be cancelled, and there is no exigency which requires this Court to aid or assist in the cancellation.

It is important both to the company and to the insured that the company should be able to know, in the life time of the insured, whether it has made an error in the cancellation of his policy, and whether it is still bound to receive the premium, and whether he has a right to share in the dividends, or profits, or surplus. The insured is annually tendering his premium, and the company is annually refusing to accept the tender. The postponement till the death of the insured of knowledge whether or not the company is under obligation to receive the tender is inequitable and unjust to both parties, because it is a postponement for an uncertain time, a postponement to the pecuniary damage of one party, and a postponement to a time when the ascertainment of the truth of the facts upon which the action of the company was based may have become doubtful by lapse of time and the death or removal of witnesses. It is important that neither party should be left in doubt, during a series of years, as to his or

its pecuniary rights in the policy. These special circumstances seem to me to be sufficient to justify the plaintiff in its resort to a Court of equity.

The demurrer is overruled, without costs, with leave to answer over.

Henry C. Robinson, for the plaintiff.

Richard D. Hubbard, for the defendant.

JOHN CHRISTMAN AND P. ELMENDORF SLOAN

vs.

JOHN A. RUMSEY AND MOSES RUMSEY. IN EQUITY.

The re-issued letters patent granted to John Christman, March 24th, 1874, for an "improvement in pump filters," on the surrender of original letters patent granted to him November 28th, 1865, are valid, as respects the first claim.

The decision of the Commissioner of Patents as to the existence of a ground for re-issue set forth in § 53 of the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 205,) is conclusive.

The said re-issued patent has not new matter introduced into its specification in violation of said § 53; nor is it open to the objection that it is not for the same invention, or for any invention, described in the original specification as the invention of the patentee.

It was lawful, under the decision in *The Corn Planter Patent*, (23 *Wallace*, 181,) to re-issue said patent with claims to combinations of fewer elements than were contained in the combination claimed in the claim of the original patent, the sub-combinations of the re-issue entering into a larger combination claimed in the original.

The claims of said re-issued patent, namely, "1. The combination of a wire gauze, C, with an open grating or guard, A, of sufficient strength for the purpose required, and a point, A', constructed substantially as and for the purposes described. 2. The combination of a grating, A, having apertures through it for the passage of the water to the interior, forming the lower end

of a pump tube, with a wire gauze, C, for filtering the water, substantially as described," are claims to combinations and not merely to aggregations of parts.

The question of the infringement of the first claim, considered.

The second claim is void for want of novelty.

The plaintiff was allowed to recover on the first claim, on making, before a decree, a disclaimer as to the second claim, it not appearing that there had been any unreasonable neglect or delay to enter such disclaimer, but, as the disclaimer was not made before the suit was brought, costs to the plaintiff were refused.

(Before BLATCHFORD, J., Northern District of New York, September 10th, 1879.)

BLATCHFORD, J. This suit is brought on re-issued letters patent granted to John Christman, March 24th, 1874, for an "improvement in pump filters." The specification says: "In pointed pump tubes heretofore essayed, difficulties have arisen in keeping them free from clogging and rendering them efficient. My invention was made to overcome these difficulties, in which I have fully succeeded. The construction of my apparatus is substantially as follows, referring to the accompanying drawing, which is a side elevation of the filtering point made for driving, affixed to the lower end of a pump tube, with the side grating A broken, to show the wire gauze, C. I form an open grating A, of rods of proper sized wire of a convenient length and form, the upper ends of which are permanently affixed to a collar or head piece, B, on which a screw may be cut, to affix it to the lower end of the pump tube, D. This screw may be cut on the inside, as shown by the drawing, or on the outside, as preferred, the joint being made in any well known way. The open grate A extends down cylindrically in the drawing a sufficient distance, and is thence tapered and brought into a solid point, A′, as in the drawing; or it may be made rounded or square, so there is a solid, compact end adapted to the purposes intended. Inside the grating A, I insert another tube, C, made of wire gauze, and covering the spaces between the bars of the grate A, and properly fastened in place, which, I find, makes, in connection with the strong supporting grating, a perfect filter, to be used at the bottom of pump tubes. Where it is re-

quired, as in quicksands, &c., there may be a filtering medium put inside the wire gauze, to resist the outside pressure; but, for ordinary cases, no such packing is necessary." The claims of the re-issue are as follows: "1. The combination of a wire gauze, C, with an open grating or guard, A, of sufficient strength for the purpose required, and a point, A', constructed substantially as and for the purposes described. 2. The combination of a grating, A, having apertures through it for the passage of water to the interior, forming the lower end of a pump tube, with a wire gauze, C, for filtering the water, substantially as described."

The original letters patent were granted to John Christman, November 28th, 1865, for an "improvement in pump filters." The specification of the original says: "Be it known, that I, John Christman, of the city of Syracuse, N. Y., have invented a new and improved pump filter, and I do hereby declare that the following is a full, clear and exact description of the construction of the same and the form thereof, when complete, reference being had to the annexed drawings making a part of this specification. The letters used represent the same parts wherever they occur. To enable others skilled in the art to make and use my invention, I will proceed to describe the construction of the filter, and its form when complete and ready for use. I use any kind of common wire and arrange sections thereof in a tubular form, A, so that the longitudinal sections *a*, *a*, *a*, *a*, &c., will form an open grate. The ends of the wire sections designed for the lower part of the filter are welded together in a compact form, which may be round, pointed or square across. The ends of the wire sections designed for the upper part of the filter are made to pass between two shoulders, *b* the inner one and *c* the outer one, forming a part of the round head piece B, thus keeping them in a circular or tubular form, and, to hold the same firmly, the outer shoulder, *c*, may be soldered down upon the wire sections, and the same thus held securely in their places. The head-piece will be of sufficient length, so that the upper end thereof may receive the cut of a screw, either on the inside

or the outside, as may be desirable, as seen at *d*, to receive the pump tube D. Fitting the inside of the wire tube thus formed I insert another tube, C, made of common wire gauze, and the two thus formed make a strong and perfect filter to be used at the bottom of pump tubes. The tube of wire gauze may, in case there is quicksand, be packed with charcoal or other filtering substances, but, for ordinary use, no such packing would be necessary." The claim of the original patent was this: "A pump filter, composed of the parts A, B and C, substantially as and for the purposes described."

It is contended, for the defendants, that the re-issue is void. The petition for the re-issue sets forth, that, by reason of an insufficient or defective specification, the original patent is inoperative or invalid, and that such error arose from inadvertence, accident or mistake, and without any fraudulent or deceptive intention. This is a ground of re-issue set forth in § 53 of the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 205.) The decision as to the fact so set forth belonged exclusively to the Commissioner of Patents, and his action conclusively established that fact. (*Seymour* v. *Osborne*, 11 *Wall.*, 516, 543 *to* 545; *Herring* v. *Nelson*, 14 *Blatchf. C. C. R.*, 293.)

It is further contended, that new matter has been introduced into the specification of the re-issue, in violation of § 53 of the Act of 1870. It is urged, that the original specification states the invention to be "a new and improved pump filter," while the re-issued specification states the invention to be "an improvement in pump filters;" that the original claims the whole and nothing less, while the re-issue makes two claims, neither of which claims the whole or includes the collar or head piece B; and that the first two sentences, above cited, in the re-issued specification, are new matter. These two sentences cannot properly be called "new matter," within the meaning of the statute. They do not at all relate to the description or operation of the apparatus of the patentee. The difficulties stated to have existed in prior pointed pump tubes may well have been known to the pat-

entee from hearsay, although the first driven well point he may have seen was his own. Certainly, as the patentee's pump tube is a pointed pump tube, and as it does overcome the difficulties in clogging in such a tube, the presumption is that it was made to overcome such difficulties, and, therefore, that such difficulties had been heard of by the patentee.

It is further urged, that the original specification describes the invention as applicable to all pump filters, whether used upon points for driven wells, or upon well tubes used in open wells or cisterns or streams, while the re-issued specification introduces new matter by confining the invention to driven wells only. This is claimed to be shown by the fact that the original states that "the ends of the wire sections designed for the lower part of the filter are welded together in a compact form, which may be round, pointed or square across." In the re-issue it is stated that the open grating, A, is formed of rods of proper sized wire, of a convenient length and form, the upper ends of which are permanently affixed to a collar or head piece, B, and that the open grate extends down cylindrically a sufficient distance, and is thence tapered and brought into a solid point, A'. The original states that sections of wire are arranged in a tubular form, A, so that the longitudinal sections form an open grate. It is contended, that, as there is no A' in the original drawing, and as A in that drawing includes the whole of the open grate from the welded point to the head piece, B, and as, in the re-issue drawing, the cylindrical part is lettered A, and the tapered part is lettered A", the restriction in the re-issue, of the grating A to the cylindrical part above the taper, and the lettering A' in the re-issue drawing, are new matter not warranted by the original drawing or model. It is contended, that, in this, there is a violation not only of the provision of § 53 of the Act of 1870 in regard to new matter, but a violation of the provision of that section, that, in case of a machine patent, neither the model nor the drawings shall be amended, except each by the other; that a new division or element is made in the drawing, called A'; that the drawing has been amended by dividing

the grating into two parts, without any warrant therefor from the model; and that this was a material change, because it was intended to change the original hollow point, as described in the original specification and as shown in the original drawing and by the model, into a solid point, including all of the tapering part as solid matter.

There is no substantial difference between the drawing attached to the original patent and that attached to the re-issued patent. The form of the whole structure, as a whole, is the same in each. The forms of the several parts are the same in each. In each, the protecting grating is cylindrical above and then tapers below, in the form of an inverted cone, to a point. In the original drawing the whole grating, from the head piece to the point, is lettered A. In the re-issue drawing the cylindrical part of the grating is lettered A, and the tapering part is lettered A'.

It is not perceived that there is any force in these objections taken by the defendants. The drawing of the original patent shows a pointed pump tube, capable of being driven to make a driven well. The original specification says: "The ends of the wire sections designed for the lower part of the filter are welded together in a compact form, which may be round, pointed or square across." There is nothing in this language, properly construed, which indicates that the patentee contemplated the use of the structure in any other well than a driven well. It speaks of the "wire sections designed for the lower part of the filter." The "lower part of the filter" is the part from where the taper begins, downward. The ends of these wire sections, that is, their lower ends, are welded together in a compact form. Why in a compact form? Evidently, to get a driving point. Unless the ends were compact, in the sense of being compacted to a point, there could be no driving. There is no suggestion that the lower ends are to be rounded or square across. If they were, they could not be driven. The words "which may be round, pointed or square across" refer to something which may at the same place be, optionally, either round, pointed or square across. The ex-

treme lower end may be pointed, but, for a driven well, it cannot be round or square across. It is not the "ends" which are to be "round, pointed or square across." It is "the lower part of the filter" which is to be "round, pointed or square across." The lower part of the filter is the part from where the taper begins, downward. Such part may not have its up and down outside line, from the lower end of the cylindrical part downward to the end, the line of a cone, as in the drawing, but such outside line may be rounded and more bulging than the line of a cone, so it be not of greater diameter than the cylindrical part, provided the lower ends of the wires are welded together in a compact form; or, such part may be pointed, that is, its outside line may be the line of a cone, going in a straight line from the lower end of the cylindrical part to the point; or, such point may be square across, that is, it may be an inverted pyramid, with its cross section any where a square, provided the lower ends of the wires in the four sides are welded together in a compact form. This is the only reasonable meaning of the words. They are inartificially put together, but in the re-issue the language is: "The open grate, A, extends cylindrically in the drawing a sufficient distance, and is then tapered and brought into a solid point, A′, as in the drawing, or it may be made rounded or square, so there is a solid compact end adapted to the purposes intended." In the drawing, the open grate, A, does extend down cylindrically for a distance, and it "is then tapered." That is, the open grate continues in the tapered part. The tapered part is not all of it solid. After that part of the tapered part which is an open grate, comes the solid driving point into which the tapered open grate is brought. The letter A′, in the drawing of the re-issue, is not at or near the solid point. It is opposite the open grating, on the tapered part. The statement, that the open grate, after leaving the cylindrical form, "is then tapered and brought into a solid point, A′, as in the drawing," does not mean that A′ is the solid point, or that the solid point is A′, or that the whole of the tapered part is solid. It means that the part below

the cylindrical part is A′, that it is tapered as it goes down, that it is brought at its lower end into a solid point, and that the whole part which is thus tapered and brought into a solid point is designated as A′, in the drawing. The statement further is, that the part which is tapered, that is, conical, or, as in the original, pointed, may, alternatively, be made rounded or square, or, as in the original, round or square across, in the senses before explained. There is a proviso, that, in each one of the three cases, there must be a solid compact end, adapted to the purposes intended, that is, for a pointed pump tube made for driving. This same idea is found in the original specification and drawing, taken together. There is no new matter, in this regard, in the re-issued specification or in the re-issue drawing. Nor is the added lettering, A′, new matter. It is not perceived that any intention is disclosed, in the re-issue, to make the whole of the tapering part solid.

It is further contended, that the re-issue is not for the same invention, or for any invention, described in the original specification as the invention of the patentee. The cases of *Gill* v. *Wells*, (22 *Wallace*, 1,) and *Russell* v. *Dodge*, (3 *Otto*, 460,) are relied on as authorities. The claim of the original patent was this: "A pump filter, composed of the parts A, B and C, substantially as and for the purposes described." It is urged that such claim included the three distinct parts A, B and C, in combination, embracing the whole of the structure described; that there is no suggestion, in the original specification, that the patentee had invented any combination of parts less than the whole; and that each of the claims of the re-issue is for a combination of parts less than the whole, and is, therefore, void. The view taken by this Court, in *Herring* v. *Nelson*, (before cited,) of the decisions in *Gill* v. *Wells* and *Russell* v. *Dodge*, seems to me to be a sound one. Under the decision in *The Corn Planter Patent*, (23 *Wallace*, 181,) which was subsequent to that in *Gill* v. *Wells*, the re-issue in the present case cannot be held to be void. The drawings of the original and the re-issue being the same, and the two specifications describing the same mechanical struc-

ture, with the same mode of operation, it must be held to be lawful to re-issue the patent with claims to combinations of fewer elements than were contained in the combination claimed in the claim of the original patent. The original claimed a general and larger combination, and the re-issue claims sub-combinations which enter into such general and larger combination. Such a re-issue was sustained in *The Corn Planter Patent*, on the ground that the re-issue was for things contained within the apparatus described in the original patent, and against the effort to control the case by the decision in *Gill* v. *Wells*.

It is of no importance that the wire gauze, C, may not, by itself, have been new, or that the open grating or guard, A, may not, by itself, have been new, or that any other ingredient of the combinations claimed in the re-issue may not, by itself, have been new, so long as the combinations, as claimed, were new.

As stated before, A′, in the drawing of the re-issue, and in the text of the re-issued specification, does not mean the solid point alone, by itself, but includes the whole of the tapering part, which tapering part is an open grate from the lower end of the cylindrical part of the open grate down to where the solid compact end begins, and the solid compact end forms the rest of the tapering part, and the rest of A′. The re-issued specification says that the open grate is tapered from where its cylindrical part stops, that is, that the open grate continues into the tapered part down to where the solid compact end begins. The drawing shows that. So, where the first claim of the re-issue speaks of "a point, A′," it means the whole of what is lettered A′, the whole of what is so tapered, from the lower end of the cylindrical part to the lower end of the solid compact end, and it does not mean merely the solid compact end.

It is further contended, that the two claims of the re-issue do not claim combinations but claim merely aggregations of parts. The object of the combination claimed in the first claim is to enable the structure to be driven into the earth,

and there serve for a pump and a filter, without being injured in driving. Nothing less than a combination of all the elements in such combination will accomplish all the objects which such combination will accomplish. So, too, the grating and the wire gauze of the second claim act in combination, in controlling the passage of the water from the outside of the grating to the interior of the wire gauze. The objection is not regarded as tenable.

The application for Christman's original patent was filed in the Patent Office August 1st, 1865. The invention was made by him in the spring of 1864. The model sent by him to the Patent Office was made in the spring of 1865.

The patent to Phelps and Holton, of June 12th, 1855, for a "metallic medium for filtering," describes the use, for filtering water, of several thicknesses of fine wire gauze prepared by passing it through metallic rolls under a sufficient pressure to flatten the wire and reduce the interstices. There is no suggestion of a driven well, or of a protecting grating, or of any necessity for such grating.

The patent to De Buffon, of April 14th, 1857, for an "improved apparatus for filtering liquids," describes a structure consisting of an internal metal tube, perforated with holes, through which the filtered water passes, and surrounded on the outside by a wire gauze cylinder, the space between the two cylinders being filled with permeable materials. There is no suggestion of a driven well.

The patent to May, of August 1st, 1865, is subsequent in date to Christman's invention.

Hewitt's deep well pump, used in 1858, 1859 and 1860, was a perforated basket attachment, with wire gauze wound around its outside, as a water strainer. It could not be taken down by the driving of a well point. The apparatus of Hughes was a perforated pipe with a screen of wire gauze around it, and was not for driving. The apparatus of Suggett was a single tube for driving, with a point, and with perforations in the tube above the top of the point.

In the defendants' apparatus there is a perforated tube,

surrounded on the outside by two thicknesses of finely perforated copper, and a covering of perforated metal outside of the perforated copper. Below this is a solid well point for driving. This solid point is enlarged near its upper part, so as to be larger in diameter than the pipe above, and thus afford additional protection to the finely perforated copper. The defendants allege that their structure does not infringe the claims of Christman's re-issue. They insist that their perforated tube and driving well point are like those used by Suggett before Christman's invention, and that their finely perforated copper, if substantially wire gauze, is the wire gauze of Phelps and Holton and of De Buffon and of Hewitt and of Hughes; that they use no wires, and have no wire grating and no head piece; that their driving point is solid from where the tapering begins, and not at all open; that the plaintiffs' structure cannot have its tapering part enlarged at its upper part; and that it required no invention to cover the perforated part of Suggett's apparatus with wire gauze or finely perforated copper sheets.

The defendants' apparatus can be driven, and then remain as a pump bottom and a filter. The filter in it is substantially wire gauze, and such filter is protected, in driving, by the perforated outside metal. The enlargement of the top of the point may be an added protection, but the office of the metal pipe outside of the finely perforated copper is to protect the latter while the structure is being driven and afterwards. Such outside perforated metal pipe, while it protects the copper inside of it, permits the water to freely pass inwardly through it, and it is substantially an open grating. The combination found in the first claim of the plaintiffs' reissue is substantially found in the defendants' structure. The defendants have substantially a wire gauze filter with a protecting grating or guard outside of it, of sufficient strength for the purpose required, and a tapering driving point. The perforated tube inside of the copper is an addition, which does not destroy the combination of the copper with the protecting guard outside of it. The plaintiffs' tapering part

may have a less part of it solid than the defendants' tapering part, but all that is necessary is to have enough of it solid or compact, beginning at the lowest point, to enable it to be driven, according to the nature of the soil. It is in evidence, that structures like that described and shown in the specifications and drawings of Christman's original and re-issued patents were driven by him in 1865, and have worked successfully ever since. If the solid point for driving is sustained by a rigid metallic tubular grating that connects it with the pump tube above, that is all that is essential. Whether this connection be by a head piece or collar, where the open grating is of wires, or whether the head piece is omitted because unnecessary, where the grating is of inflexible metal, is not of the essence of Christman's invention. In either case, the structure is equally carried by the driving of the tube, so as to arrive at its resting place in a condition to act perfectly as a filter. It, therefore, appears that the combination covered by the first claim of the plaintiffs' re-issued patent is found in the defendants' structure. It also appears, that such combination is not found in any of the prior structures adduced by the defendants, and that it involved the exercise of invention to arrive at such combination, in view of everything that previously existed.

The combination covered by the second claim of the plaintiffs' re-issue seems to be a combination of the grating above the tapering part with the wire gauze inside of such grating, excluding the tapering part and the driving point, and to have no exclusive relation to a driven well, though capable of use in it. Aside from driving, the combination of the grating and the wire gauze, as a filter, is the same thing, as a combination, whether the wire gauze is inside of the grating or outside of it, so long as the apparatus is at the lower end of a pump tube. In this view Hewitt and Hughes anticipated Christman as to such second claim, and it is invalid, provided the testimony is available to the defendants. Hughes, Hewitt, Field and McCue testify to substantially the same prior arrangement. None of them are named in

the answer. Although the testimony of Hughes was objected to, on that account, when taken, the testimony of the other three witnesses was not objected to.

Although the second claim is invalid, for want of novelty, the plaintiff can recover on the first claim, under § 60 of the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 207,) now § 4,922 of the Revised Statutes, although no disclaimer has been made as yet as to the second claim, provided that, prior to the entry of a decree herein, as to such first claim, they make a disclaimer, under § 4,917 of the Revised Statutes, as to the second claim, it not appearing that there has been, heretofore, any unreasonable neglect or delay to enter such disclaimer; but, as such disclaimer was not entered before the commencement of this suit, the plaintiffs will not be entitled to recover any costs of this suit. (*Rev. Stat. U. S.*, § 4,922.)

Let a decree be entered for an account of profits and damages and for a perpetual injunction, as to the first claim.

J. J. Greenough and Irving G. Vann, for the plaintiffs.

David Wright, for the defendants.

THE AMERICAN COTTON TIE SUPPLY COMPANY

vs.

JOHN L. BULLARD AND OTHERS. IN EQUITY.

The plaintiff was the owner of patents covering improvements in metallic cotton ties, consisting of buckles and hoops, for compressing bales of cotton. Neither the plaintiff nor any prior owner of the patents had granted any licenses to make buckles or ties, but they had made and sold the ties. The buckles were stamped, "Licensed to use once only," and were sold with invoices declaring that the ties were licensed to be used once only, as baling

ties. The defendant bought the buckles so once used, from cotton mills and junk dealers, and put up some with new hoops, and some with pieces of the original hoops pieced together, and sold them as cotton ties: *Held*, that the defendant had infringed the patents, and ought to be enjoined from further infringement.

(Before BLATCHFORD, J., Southern District of New York, September 29th, 1879.)

BLATCHFORD, J. The bill in this case sets forth that the plaintiff is "a joint stock company, duly and legally organized under the laws of the State of Louisiana, and having its principal place of business in New Orleans, in said State." It does not aver that the plaintiff is a corporation or that it is a citizen of the State of Louisiana. It avers that the defendants are citizens of the State of New York. The plaintiff is referred to in some of the affidavits as a corporation, and it is, doubtless, a corporation created by the State of Louisiana. This being so, the bill can be amended, and it must be, to show a capacity in the plaintiff to sue.

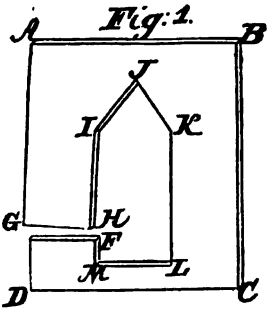
The bill is founded on re-issued letters patent No. 5,333, granted to James J. McComb, March 25th, 1873, for an "improvement in cotton bale ties," (the original patent having been granted to George Brodie, March 22d, 1859, and reissued to him April 27th, 1869, and extended for seven years from March 22d, 1873,) and on letters patent No. 31,252, granted to J. J. McComb, January 29th, 1861, for an "improvement in iron ties for cotton bales," and extended for seven years from January 29th, 1875. The plaintiff is the owner of both of the patents.

The specification of No. 5,333, (called the Brodie patent,) sets forth that the invention is one of "improvements in cotton ties, or metallic bands and their connections, for baling." It says: "My invention relates to the combination with open slot ties of metallic bands having their ends free and held in position by the expansion of the bale. * * * * Fig. 6 is a top view of the open slotted link, shown in Figs. 7, 13 and 14. * * * Figs. 6, 7, 13 and 14 show an open slotted link or tie. In Fig 7 this is shown in connection with pins, and in Figs. 13, 14 and 15 in connection with the band alone,

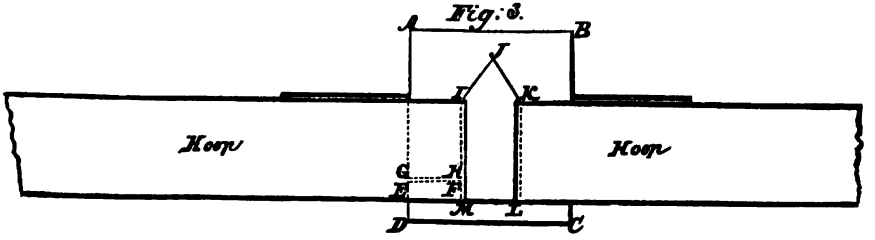
the ends being turned under the link and held in position by the pressure exerted by the expansion of the bale. In the latter mode of use, the slack may be readily taken up by forming the loop in the iron at the moment of making the fastening, and passing the end thus looped through the opening in the side of the link. The band is thus slipped sidewise through the opening into the slot, instead of thrusting it through endwise." The 3d, 4th and 5th claims of the patent are as follows: "3. The combination of an open slot for introducing the band sidewise, with a link having a single rectangular opening for holding both ends of a metallic band, and the band. 4. An open slotted link, when combined with metallic bands, the ends of which are turned under the link and held in position by the expansion of the bale. 5. The method of baling cotton with metallic bands, and of taking up the slack of the band, by bending the same at any desired point into the form of a loop, and passing such loop sidewise, through an open slit, into the slot intended to receive it, and over the bar of the clasp intended to hold it."

The specification of No. 31,252, (called the McComb patent,) sets forth that the invention is "a new and improved mode of fastening iron hoops on cotton bales." It says: "The nature of my invention consists in the use of a peculiarly shaped buckle, as a fastening or tie for the ends of the iron hoops which it is desired to substitute in place of the hemp ropes now made use of in baling cotton, said iron hoops being so much safer in case of fire. * * * * The tie or buckle is a piece of wrought iron or other metallic substance, about the eighth of an inch thick, an inch and three-quarters wide, and two inches long, (the size being modified to suit the width of the hoop used,) with an oblong hole or aperture cut or punched through the centre. The diagram No. 1, lettered A, B, C, D, represents the exact size of one of the ties or buckles, with aperture cut to receive a hoop an inch wide. The sides A, B, and D, C, are equal and parallel, as are also the sides B, C, and A, D. The letters M, I, J, K, L, shows the shape of the aperture or hole which

is punched or cut through the centre of the plate, the two longer sides, M, I, and K, L, being equal in length to the width of the hoop of the size above mentioned. In the side A, D, is cut a slot, which is indicated on the diagram by the letters E, F, and G, H, the side G, H, of the slot being turned outward the eighth of an inch, to facilitate the insertion of the end of the hoop." The buckle is of this shape:



The hoop and buckle are arranged as follows in use:



The claim is as follows: "Forming a link or tie with an oblong aperture, one end of which is arrow shaped, or, rather, presents two sides of an equilateral triangle, the design of this arrow shaped end being not only to force the hoop, or bend of the hoop, over the slot, which it does with unerring precision when the bale expands, after being released from the press, but also to secure an equal bearing upon the separated parts of the slotted side of the tie."

A patent was granted to Frederick Cook, March 2d, 1858, for an "improvement in metallic ties for cotton bales." This

patent was extended for seven years from March 2d, 1872. As extended, it was assigned by Cook to James J. McComb, March 21st, 1872. In June, 1874, McComb assigned the Cook patent and the Brodie patent to a firm called "The American Cotton Tie Company." In March, 1876, that firm assigned those patents to "The American Cotton Tie Company, Limited," a corporation, and at the same time that corporation acquired the title to the McComb patent. From that corporation the title to the three patents passed to the plaintiff. Neither McComb, nor any of the subsequent owners of the patents, granted any licenses thereunder to make buckles or ties, but they retained to themselves the monopoly of manufacture, and made the ties and supplied the market with them, to an extent always equal to any demand. The tie mainly sold since March, 1872, by them, has been the "arrow tie" of the McComb patent. The bands have been cut to the length of eleven feet, bent over upon themselves once, and put up in bundles of thirty each, the buckles being strung upon one of the inner bands.

The defendants have used upon the cotton ties, which they have put up or sold, second-hand buckles, which they have bought from cotton mills and from junk dealers, and which were made and disposed of by the plaintiff, or its predecessors, under the Brodie and McComb patents. These buckles have had stamped upon them the words: "Licensed to use once only," and were formerly put upon the market by the plaintiff, or its predecessors, in the usual course of their business, with the following words printed on the bill-heads or invoices which went to the first transferee of the ties: "The cotton ties included in this invoice are licensed to be used once only, as baling ties, and are sold and purchased subject to this restriction," or the words: "Each bundle of cotton ties charged in this invoice consists of 30 bands. The buckles accompanying these bands are the property of The American Cotton Tie Supply Company, [or, American Cotton Tie Company, Limited,] and are licensed to be used once only, the company reserving the right, after such use, to recover possession of them

wherever found." The first of the above forms of bill-head was used during the years 1873, 1874 and 1875, and the other one during the years 1876 to 1879 inclusive, except that, for a portion of the latter four years, such bill-head used the words, "for one season," in lieu of the word "once."

In this country, cotton is usually sold without tare, that is, the purchaser pays a certain price per pound upon the aggregate weight of the bale, which is made up of the bagging, the ties (bands and buckles) and the material which they confine. In England, cotton is sold with tare, that is, the weight of the ties and bagging is deducted from the aggregate weight of the bale, and the purchaser pays so much per pound for the cotton, net weight, but takes the ties and the bagging with the cotton which they confine.

The ties which the defendants have sold embody the principles of construction which are found in the inventions covered by the 3d, 4th and 5th claims of the Brodie patent, and in the invention covered by the McComb patent. The defendants' ties, as sold, consist of bands eleven feet in length, put up in bundles, each band accompanied by a buckle. In regard to some of such ties, the buckles being second-hand buckles, the bands are entirely new. In regard to others, the buckles being second-hand buckles, the bands are not, as whole bands, the original bands, bought at second hand, but consist of pieces of such original bands pieced together to make the proper length.

The question presented for consideration is, whether, on the foregoing facts, the defendants may lawfully sell such ties, consisting of such bands and such buckles. This question has been before the Courts. In August, 1876, the American Cotton Tie Company, Limited, and others, brought a suit in equity, against one Chapman, in the Circuit Court of the United States for the District of Louisiana, on the Cook, the Brodie and the McComb patents. The defendant had procured second-hand buckles lawfully put into use on cotton bales, under said patents, and had put new bands with them, and sold the combination as ties. It appeared, in that case,

that, at the cotton presses at New Orleans, when the bales bound with the plaintiff's ties, consisting of the bands and buckles, were ready to be compressed, the bands and buckles were stripped off from the bales, and thrown on one side in a pile promiscuously with others, and that, when the bales were in the press, they were fastened together by the first ties that might be reached by the pressman out of the pile, no care being taken to use the same ties upon the bale, when compressed, which were so taken off from it. The facts, before mentioned, were before the Court, as to the sale of cotton in this country without tare, and as to the stamp on the buckles, and as to the contents of the original bill-heads. The buckle used by Chapman was that of the McComb patent. The case came before Judge Billings, the District Judge, on a motion for a preliminary injunction, and he granted the injunction, in November, 1876, after hearing counsel for both parties, and after the defendants' answer and a replication thereto were filed. The decision of the Court is embodied in the order for the injunction. It sets forth, that the Cook and the McComb patents secure the exclusive right to a cotton tie buckle having an open slot or slit, into which a flat iron band can be inserted sideways, known commonly as the open-slot buckle, and that the third and fourth claims of the Brodie patent secure the exclusive right to an open-slot buckle in combination with a flat band of iron, to be combined for and used as a tie for baling cotton or other compressible and elastic material; that the defendant had made and sold to be used a combination of a flat band of iron in combination with an open-slot buckle; that he had so combined and sold both the open-slot buckle in the exact similitude of the invention secured to the plaintiffs, as well as said open-slotted buckle combined with a flat band of iron, without any license, except such as was averred to have resulted from an alleged sale of said buckles by the American Cotton Tie Company, Limited, to other persons than the defendant, whereby it was insisted by the defendant that he acquired the right, by purchase from said third persons, to combine said buckles with flat bands of iron, and sell

the same; that the plaintiffs, in the protection of their rights, did not dispose of said buckles in full property, but with a condition that the same should only be used once for the purpose of baling cotton or other compressible material, and that the said condition was known to the defendant, it being stamped, in a permanent manner, on said buckles; that the contract by which said cotton ties and buckles were disposed of for use by the American Cotton Tie Company, Limited, contained the same condition and stipulation as was stamped on said buckles; that said license to use said open-slot buckles, and a combination of the same with a flat band of iron, as a cotton tie, had, on the terms on which it was granted by the American Cotton Tie Company, Limited, expired and been expended before the same came into the possession of the defendant; and that the sale of the open-slot cotton tie, known in the trade as the arrow tie, and the sale of the said open-slot buckles, in combination with a flat band of iron, to be used as a tie for baling cotton, or other compressible and elastic materials, was a substantial invasion and infringement of the right secured by said patents. It then proceeded to enjoin the defendant from using or selling for use any open-slot cotton tie buckle of the kind commonly known as the arrow tie, described and secured by any of said patents, upon the pretence that the same had, at any former time, been sold by the American Cotton Tie Company, Limited, or its agents, and been once used for the purpose of baling cotton or other material before coming into the possession of the defendant, and from combining any such open-slot cotton tie buckles with a flat band of iron, to be used, or vended to others to be used, as a tie for baling cotton or other elastic or compressible material.

In January, 1877, the American Cotton Tie Company, Limited, and others, brought a suit in equity against Grover, Stubbs & Co., in the Circuit Court of the United States for the Southern District of Georgia, on the same three patents. The defendants set up that they had never made any ties, but had sold ties made by the American Cotton Tie Company,

Limited. The ties they had sold were arrow ties. The facts of the stamps on the buckles, and of the contents of the bill-heads, before mentioned, were before the Court. The ties were spliced. The case came before Judge Woods, the Circuit Judge, on a motion for a preliminary injunction, and he granted it, after hearing counsel for both parties. The order enjoined the defendants from selling ties known as the arrow tie, unless said ties should be purchased directly or indirectly from the plaintiffs, or their duly authorized licensees, or their vendees, or vendees of vendees, and from selling ties stamped with the words, "licensed to be used once only," or words of similar import, after said ties had been used once.

In January, 1877, the American Cotton Tie Company, Limited, and others, brought a suit in equity against A. C. Wyly and others, in the Circuit Court of the United States for the Northern District of Georgia, on the same three patents. The defendants set up that they had bought and sold metallic cotton ties known as piece ties, made by taking ties that had been once used in baling cotton, and afterwards cut from the bales, and rejoining the several parts with rivets, retaining the same buckles. The buckles were arrow buckles. The facts as to the stamps on the buckles, and the contents of the bill-heads, before mentioned, were before the Court. Judge Erskine, the District Judge, in March, 1877, granted a preliminary injunction, in the same terms as in the said suit against Chapman.

In January, 1877, the American Cotton Tie Company, Limited, and others, brought a suit in equity against C. W. Simmons & Co., in the Circuit Court of the United States for the Southern District of Georgia, on the same three patents. The defendants had sold second-hand arrow buckles with pieced bands. The facts as to the stamps on the buckles and the contents of the bill-heads, before mentioned, were before the Court. Judge Erskine, the District Judge, in April, 1877, granted a preliminary injunction, after hearing counsel for both parties, restraining the defendants from making, using, or vending to others to be used, buckles for iron ties for

cotton bales, known in the market as arrow buckles, or ties formed by the combination of an iron band with an open-slot buckle or arrow buckle, except the same should be purchased from or licensed by the plaintiffs, their assignees or their vendees or licensees.

In October, 1876, the American Cotton Tie Company, Limited, and others, brought a suit in equity against Simeon W. Simmons and others, in the Circuit Court of the United States for the District of Rhode Island, on the same three patents. There was an answer and a replication, and the case was heard, at final hearing, on pleadings and proofs, by the Circuit Judge, Judge Shepley. The defendants had procured from cotton mills second-hand buckles and second-hand hoops, which had been once used on cotton bales. The hoops were not of the original length, but were in cut pieces, and the defendants pieced them together, by riveting, to the proper length. The buckles and hoops had been put upon the market by the American Cotton Tie Company, Limited, under the three patents in question. There was evidence as to the stamping of the buckles and as to the contents of the bill-heads, before mentioned. In June, 1878, Judge Shepley gave a decision dismissing the bill, (14 *Off. Gaz. of Pat. Off.*, 967.) He said: "The complainants contend that they sold the buckles under a restriction, which limited them to one use, and did not convey an unrestricted title, and that the buckles never passed out of the monopoly of the patent. * * * The company clearly had the right, in selling a patented article, to put a restriction on its use or sale, and to convey only a restricted title, or to license only a restricted use, and the purchaser under such a restricted title could not convey a greater or better title than he had himself. The law upon this subject was fully stated in *Hawley* v. *Mitchell*, (1 *Holmes*, 42,) and affirmed by the Supreme Court of the United States, (16 *Wall.*, 44.) But, when the proprietor of a patented article sells it for the purpose of allowing it to be used in the ordinary pursuits of life, and to pass into the markets of the country as an ordinary article of commerce, and subject to unrestricted purchase and sale, he waives his right to affix

conditions or restrictions to its use or sale, and consents that, after one sale and the payment of one royalty, it shall pass out of the limits of the monopoly. If a manufacturer of patented pins, or nails, or wood screws, or any similar article, were to affix to his invoice of sale a condition limiting them to one use, and sell them in quantities to retail dealers to be sold again, he must know and intend that they are to pass into the commerce of the country, and to be sold over and over again, and sold only to persons who would not buy anything less than an unrestricted title. Shall the purchaser of a packing box be treated as an infringer, and as pirating an invention, because he uses again, and for another purpose, the screws or nails which held the box together, and which he purchased when he purchased the box and its contents? May he not reasonably presume, with regard to articles of this description, that pins, and nails, and screws do not go into the market with an incumbrance upon their title, or a restriction on their use, and that he is not bound to trace the title, to see if it be unrestricted, for the reason, that he may well suppose no one would expect to affix a restriction on the use of such articles, which would be operative, or, if he could do so, would ever find purchasers of them? The buckles sold by the complainants belong to this class of articles. They are sold for the purpose of being used to confine a bale of cotton, as a nail or screw confines a packing box. It appears in evidence, that, when a bale of cotton is sold, it is without tare, and, consequently, the buckle and the strap it confines are sold and resold with the bale of cotton to which they are attached. If the cotton takes fire, or is otherwise damaged, and requires to be rebaled, must the owner put the same buckle back on the same bale or be liable to the penalties of an infringer? When the cotton bales are opened for use at the factories, the manufacturer who has purchased the ties and buckles with the cotton, having no further use for them, sells them to the junk dealer. From the junk dealer the defendants purchase them and repair them and sell them again. The vendor of the patented buckles sells them to be applied to the bales of cotton, with

the full knowledge that they will be sold and resold as often as the cotton is sold. They impliedly consent to these unrestricted sales. They cannot, under such circumstances, be fairly considered as retaining the title to the buckles in themselves, or as parting with only such a restricted title as would require each vendor of the cotton to sell it accompanied with a restriction on the title and use of the buckles. The very purpose of the original sale, with the knowledge of the subsequent use and sales necessarily incident, imply a parting with the unrestricted title and a passing out of the limits of the monopoly, of the thing sold, as much as it would if the vendor sold patented nails or screws, to be used in fastening packing cases to be sold with the goods packed. The facts in this case show that the owners of the patented buckle intended and contemplated that the purchasers should sell an unrestricted title, inconsistent with any reservation of title or use in the original vendors. Such a sale does not fall within the principle stated in *Hawley* v. *Mitchell*, but clearly falls within the language and principle of the decisions in *Goodyear* v. *Beverly Rubber Co.*, (1 *Cliff.*, 336,) and *Washing Machine Co.* v. *Earle*, (3 *Wall., Jr.*, 320.) The case is very different from that of the sale of a machine easily identified, and to which a restriction may easily be attached, or where a license to use only may be sold, unaccompanied with any title or accompanied with a restricted title. But, where pins, nails, screws, or buckles are sold, if some of them are sold with a restricted and some with an unrestricted title, there are no means of identification which enable the purchaser, after they have passed into the market and common use, to distinguish the articles licensed or restricted in their use from those absolutely sold. In the case of articles of that description, the patentee may fairly be presumed to have received his royalty when he parted with the possession of the articles and allowed them to go into common and general use. The public should not be vexed with litigation about reserved rights or conditions affixed to the title of such articles, or put upon the investigation of incumbrances or restrictions on the title of nails,

screws, buckles, or pins, before they can be safely used by a person who has bought them of parties who obtained them of the patentee, with the right to sell them in the open market. It is more for the interest of inventors that they should obtain their royalty on such articles when they first put them upon the market, than to make the monopoly odious by the attempt to fix restrictions on the subsequent use." The proceedings in the four cases above mentioned, in which injunctions were granted, were put in evidence in the case before Judge Shepley.

In a like suit in equity, by the same plaintiffs, against Williams, Black & Williams, in the Circuit Court of the United States for the District of South Carolina, in which the main issues were like those in the suit before Judge Shepley, the Circuit Judge, Judge Bond, followed the decision of Judge Shepley.

In view of these decisions, the question involved in this case may fairly be considered an open one, on authority as well as on principle. It is manifest, that the owners of the patents intended, by the stamps on the buckles and the imprints on the bill-heads, to grant a restricted license for the use of the ties and the buckles, and that the intended restriction was to a use of them once only, as baling ties. The words "licensed to use once only," stamped on each buckle, was notice to every one who handled it that there was attached to it a restriction in the shape of a license, and of a license merely to use, and of a license to use only once. This was a lawful restriction. The only question is, whether it was an effective and operative one, or whether it was strangled in its birth by the circumstances which attended the original putting of the ties and buckles on the market, or whether, being created, it was waived by the voluntary action of the owners of the patents.

The defendants do not deny that the owner of a chattel may dispose of the same with restrictions upon the title, and they concede that the owner of a patented article has a right to put a restriction on its use or sale, both as to the extent of

the territory within which it can be used and as to a period of use within the term of the patent. But they contend that a restriction thus imposed may be waived by the party who has imposed it, and that such waiver may be the legal result of acts, and be, in fact, contrary to the purpose and intention which the party has in his mind. They further contend, that, notwithstanding any restriction imposed in this case, the planter sold the cotton, and the ties and buckles which bound it into bales, without any restriction, and that the same fact existed with respect to every succeeding sale of the bales, down to the consumer; that the plaintiff permitted the planter to sell the cotton baled with the patented ties which he had purchased by the pound or the bundle, and to pass the property in such ties from purchaser to purchaser in succession, without any restriction; and that all such unrestricted sales were made, by implication of law, with the authority and by the direction of the owners of the patents, and were not the illegal acts of persons having possession of the property without title to it, because such sales were contemplated by the plaintiff as a part of the business of providing the market with ties. They liken the case to that of the license of a machine with a restricted right under a patent, and a subsequent acquiescence by the licensor in the sale of the machine by the licensee in derogation of the restriction. They insist, that, as the original vendors of the ties knew and intended that the cotton, with its bagging, bands and buckles, would and should be sold, and pass from purchaser to purchaser, without restriction, and that the bands and buckles would and should be treated as and become the property of the several purchasers in succession, by either a purchase at a price per pound, or by being given to the purchaser as a perquisite, the price being included in the price of the cotton, each successive purchaser of the baled cotton became the owner of the buckles and bands, and that any owner of the buckles has a right to put them a second time to the use contemplated in the Brodie patent, if they have once paid a patent royalty.

It is difficult to see how, in view of the facts of the case, the owners of these patents can properly be said to have sold the buckles for the purpose of allowing them to be used in the ordinary pursuits of life and to pass into the markets of the country as an ordinary article of commerce. They put them forth with a restriction imposed on them, that they should be used "once only," as baling ties. The good sense of the words "once only" is, that they shall be used to confine the bale until it is opened for use by the consumer and until the cotton has thus ceased to need longer confinement in a bale. A fair and liberal construction, consistent with the necessary intention of the owners of the patents, permits, in the business of pressing, a buckle and a band to be transferred from one bale which is on its way from the planter to the consumer to another bale which is on its way from the planter to the consumer, and does not require that such use should be regarded as a use more than once of the buckle and the band. The original license is fairly a license to have the buckle and the band confine a bale until the consumer needs to confine the bale no longer, and a license for no longer time. There is no purchase of buckle and band by a purchaser of the baled cotton, except as he purchases them confining the cotton and to confine it till it reaches the consumer, and such purchase of buckle and band is, in effect, only a purchase of them subject to such original license. It is quite as reasonable to say that the purchaser of the cotton buys subject to such license as it is to say that the licensor, having imposed the restricted license, permits it to be instantly destroyed. The former view is consistent with the original intention, and the latter view is inconsistent with it. The fact, that, in this country the cotton, the bagging, the iron band and the buckle, which compose the bale, are weighed as a whole and paid for at so much a pound for each pound of the whole weight, cannot have the effect to change the fact that the purchaser buys subject to a restricted license to use the band and the buckle only to confine the cotton which he is buying. What he pays for other than the cotton or the bagging is paid for

subject to such license, the price being computed in the particular way agreed upon.

The foregoing views apply to the use a second time of original buckles, by themselves, or to the use a second time of the original buckles and the original bands. But, the use of a buckle without a band will not confine a bale of cotton, and, although the defendants use a second time the original buckles, they do not use a second time the original bands in the condition in which those bands were originally put forth with such buckles. The defendants use entirely new bands or bands made by piecing together pieces of the old bands. In doing this they infringe the 3d, 4th and 5th claims of the Brodie patent. When they combine the old buckle with the new band they make anew the combination. They do the same when they combine it with a pieced band. Piecing together the pieces of the old bands, after such bands have been voluntarily severed by the consumer of the cotton, is not a repair of the tie in any sense in which the right of repair attaches to the license. If a band were broken in transit, in an intermediate hand, the right of repairing it might exist. The defendants participate in combining the open-slot, the link and the band, as in the 3d claim of the Brodie patent, and in making the combination set forth in the 4th claim of that patent, and in practising the method set forth in the 5th claim of that patent, when they sell ties having the features set forth in those claims, and capable of the use described in those claims, and needing only the bale of cotton and the application of the tie to it to make the combinations set forth in those claims, and to produce the results there set forth by the means there set forth.

The question presented is one entirely of law. There is no disputed question of fact. There is nothing to be elucidated by testimony. The right of the plaintiff is regarded as clear. The validity of the patents and the identity of the defendants' articles with those of the patents is not disputed. There is as much ground, on the question of comity, for following the decisions of Judge Woods, Judge Billings and

Judge Erskine, as for following those of Judge Shepley and Judge Bond, and, the question for decision in all the cases being one of law, on undisputed facts, a decision of it on a motion for a preliminary injunction is of equal weight, on a question of comity, as a decision of it on a final hearing.

The preliminary injunction asked for is granted, to be issued after the bill shall have been properly amended, as before suggested.

S. A. Duncan and *J. R. Beckwith*, for the plaintiff.

C. C. Beaman, Jr. and *B. F. Thurston*, for the defendants.

The Adriatic.

A steamer collided with a sailing ship in the night, having changed her course and stopped and backed her engine, in an endeavor to avoid the collision. It appeared that, if the steamer had kept her course and speed, and the ship had done what she in fact did do, there would have been no collision. But, as the steamer had skilful officers, who exercised good judgment, in view of the appearances of, and changes in, the ship's lights, it was held that the steamer was not in fault.

The ship sank with all on board, and the steamer was held not to have been in fault for her conduct after the collision, in respect to getting out her boats and proceeding on her voyage.

(Before Waite, Ch. J., Southern District of New York, October 3d, 1879.)

This was a libel *in rem*, in Admiralty, filed in the District Court, to recover damages for a collision. That Court dismissed the libel, and the claimant appealed to this Court. The decision of the District Court, (Blatchford, J.,) was as follows: "On the 30th of December, 1875, the ship Harvest Queen, an American vessel, belonging to the libellants, with

a cargo on board, also belonging to them, set sail from the harbor of Queenstown, in Ireland, for Liverpool, in England. The steamer Adriatic, a British vessel, sailed from Liverpool for New York, on the same day, and proceeded down the Irish channel. The libel alleges, that, when the ship was distant about 50 miles from her place of departure, and was proceeding up the Irish channel, the wind blowing a stiff breeze from about southwest, and the weather being clear starlight, she was run into by the steamer, at about 3 o'clock A. M., on the 31st of December, the steamer striking the ship on her port bow, with such violence as to cause her, with her cargo, to sink in a very short time after the collision; that, by said collision, the ship was totally lost, and her master and officers, and all hands on board of her, were lost; that, prior to and at the time of the collision, the general course of the ship was up, and the general course of the steamer was down, the Irish channel, and their courses crossed but slightly, if at all; and that the collision was caused by the negligence and improper conduct of those on board of the steamer, in not having a good and sufficient lookout, in running at too great a rate of speed, in not keeping out of the way of the ship, and in not stopping and backing in time to avoid the collision. The libellants claim to recover against the steamer, as damages sustained by the collision, the sum of $225,000. The answer of the steamer avers, that the ship was either sunk by a collision with some other vessel than the steamer, in the Irish channel, on or about the 31st of December, or was wrecked on or about that day in said channel, and that her loss was caused thereby, and not by any collision with the steamer. Without discussing in detail the evidence on the subject, it is sufficient to say, that it leaves no doubt in the mind, that the steamer, at or about the time and place charged, came into collision with the ship Harvest Queen, belonging to the libellants, in such manner and with such results as to cause the sinking and loss of the ship, and of her cargo, and of every person on board of her. The material question in the case, to be determined on the evidence, is, as to whether the

steamer was in fault. The vessels were sailing on nearly opposite courses. The steamer was heading from west one-quarter north to west one-half north. The ship was heading about east by south half south. They were thus drawing on to the courses of each other from one point to one point and a quarter. The ship was sailing at the rate of from eight to nine knots an hour, and the steamer at the rate of about twelve knots. The steamer made the green light of the ship at about two points on the starboard bow of the steamer. The red light of the ship was not then visible to the steamer. The white and green lights of the steamer, and not her red light, ought then to have been visible to the ship, and undoubtedly were, and it was her duty to heed them. Under the circumstances thus existing, it was the duty of the steamer to keep out of the way of the ship, and it was the correlative duty of the ship to allow the steamer to keep out of her way, and not to embarrass or hamper the steamer in performing such duty. The position was one of safety. The green lights of the two vessels, and only those, were exposed to each other. There was no exposing of green to red. Under this condition of things, the steamer kept on her course, neither porting nor starboarding, nor slowing, nor stopping, nor reversing. It was proper for her to so keep on her course. She had a right to presume, that, in the presence of her exposed green light, the ship would continue to expose her green light, and that only. There was no obligation on the steamer then to starboard, because the vessels were at such a distance apart, probably two miles, that, if both kept their courses, the ship was certain to pass clear, on the starboard hand of the steamer. She would draw more and more on the starboard bow of the steamer. And such was the fact. The ship's green light opened more to the starboard of the steamer, until it got to be some $3\frac{1}{2}$ points on the starboard bow of the steamer. This was a position of safety. The ship would not reach the path of the steamer until she was astern of the steamer. At this juncture, and some four minutes after the ship's green light had first been seen by the steamer, the ship shut in her green

light, and exposed her red light. All the time before that she had exposed her green light, and that alone, steadily, with no glimpse of her red light. Here, then, arose an exigency. Here was danger. The first officer of the steamer, Mr. Bence, was on her bridge, watching the green light off his starboard bow. He had charge of the steamer at the time, and was responsible for her navigation. He had seen the green light for four minutes, and had seen it thus open more on his starboard bow. He could not tell to what species of craft it belonged, whether to a fore-and-aft vessel, which could sail within five points of the wind, or to a square rigged vessel, which could not sail nearer to the wind than from six to seven points. He saw a movement in the approaching vessel, indicated by the change in her lights, which it was reasonable and proper for him, under the circumstances, to take as evidence of her intention to throw herself across his onward path. He was called upon suddenly, and in an exigency, to determine whether he would do anything, and, if something, what. He could, as to the course of his vessel, do one of three things—either let it remain as it was, or starboard, or port. He ported. The libellants insist that he erred in porting; that, if he had not ported, there would have been no collision; that he ought to have starboarded, or, at least, have kept on the same course; that, if he had even kept his course, there would have been no collision, as the ship could not have reached his path ahead of him; and that, if he had starboarded, he would certainly have sailed away from all danger. It is easy to criticise and to be wise after the event. Mr. Bence seems to have been a good seaman, of experience and capacity, watchful, thoughtful and deliberate. Much must be left to the judgment of such a man, charged with the safety of a large steamer and of the lives of those on board, as to which one of two or more methods he will adopt in a given exigency, if it is not shown that the one he adopted was such as to indicate that there was no fair exercise of reasonable judgment in concluding to adopt it. By determining to port and throw the head of the steamer to starboard, Mr. Bence took a course which would

certainly, if the approaching vessel continued to display only her red light, very soon bring the two vessels on parallel courses, with their red lights exposed to each other. That was safety. To take that course was prudent, and, at the distance apart the two vessels were, it would have been successful, if the ship had continued to expose only her red light. The steamer's duty of avoiding the ship did not cease because the ship shut in her green light and exposed her red light. It continued in the altered circumstances. As the exigency was sudden and unforeseen, and as the vessels were nearing each other rapidly, promptness of decision and action on the part of the steamer was necessary. Even if the ship had continued to expose only her red light, the steamer might, it may be conceded, have passed her in safety, by going on at the same speed as before, without starboarding or with starboarding. But, I think it quite clear, that, if the ship had continued to expose only her red light, the steamer would, having ported, have equally avoided a collision with the ship, especially as, on the weight of the evidence, the steamer's engines were slowed at the time her helm was ported. The steamer adopted this manœuvre, of porting and slowing, deliberately and wisely. There was no apparent necessity, at that time, that she should stop and reverse her engines. She discharged her duty of avoiding the ship, by proper movements, for the second time. She did this, although the ship was in fault in her movements, in the presence of what she could and should have seen was a steamer. These movements of the steamer had been made, and she was swinging to starboard under her port helm, when the ship shut in her red light, and exposed only her green light. Seeing this confusion of purpose in the ship, the engines of the steamer were stopped and reversed at full speed. This was proper. There was nothing else for the steamer to do. The ship had twice turned from a course and position in reference to which the steamer had acted, and acted in a way which would have given safety to the ship. Whatever followed, the ship had brought upon herself. For what ensued after the ship ex-

hibited her green light the second time, the steamer was not responsible. Before the collision, the ship made another change, and shut in her green light, and showed only her red light. A strenuous effort was made, on the part of the libellants, to induce the belief that the changes by the ship from green to red and from red back to green were produced by the yawing of the ship in the following sea and with the free wind. But, it is impossible to believe this, for, the green light was visible at first, alone, for four minutes, continuously, with no glimpse of the red light, and the green light opened from two points on the starboard bow of the steamer to three and a half points on the same bow, before the red light appeared. The effects of yawing would have been sooner observed. It is earnestly contended, for the libellants, that the red light of the ship, because of which the steamer ported, was in sight for only one minute, and that, when the green light of the ship again appeared, the steamer should have kept going ahead and should have starboarded. The ship was a third time, and in a third position, imposing on the steamer the duty of avoiding her, after the steamer had twice assumed and discharged that duty. The distance between the vessels was diminishing fast, and, with this erratic vessel nearly ahead, and the danger of collision apparent and imminent, it was the highest duty of the steamer to stop and reverse her engines. She did so, and her engines were reversed at full speed, and, on the evidence, she had got sternway on at the time of the collision. If it were to be conceded that the stopping and reversing was an error of judgment, it could not be held to have been a fault, occurring as it did after what had previously happened, but would be regarded as an error, which the libellants could not make a ground of complaint. But it is not to be admitted that it was an error of judgment. Although the Court is asked to condemn the movements of the steamer, no testimony of any expert in seamanship or in navigation is adduced to show that such movements were faulty or unwise or imprudent or unintelligent. The case of the libellants seems to rest on the

proposition, that it was the duty of the steamer to keep out of the way of the ship, and that it is not established that the ship changed her course. But, the steamer could act only in view of what she saw, and of what she had a right reasonably to infer from what she saw. Her movements were taken with a reasonable certainty that they would give safety to both vessels. She exercised the highest degree of diligence imposed by the law, in her efforts to avoid the ship. She exercised that diligence discreetly throughout to the end, in all the emergencies which the vacillating movements of the ship threw upon her. The libel is dismissed, with costs."

This Court found the following facts: "During the forenoon of December 30th, 1875, the ship Harvest Queen, on a voyage from San Francisco, touched at Queenstown, Ireland, for orders. She was 187 feet long, 42.6 broad, 28.6 deep, and of 1,626 tons burthen, American measurement. She had on board 1,750 tons of grain, in bulk. Both vessel and cargo were owned by the libellants. Her jib-boom was 31.6 feet long and 16.5 inches in diameter. The bowsprit extended from the stem forward 33.6 feet, and from its heel to the stem was 12 feet. The size of the stem was 32 x 33½ inches. On top of the bow and over the bowsprit was a breasthook of oak, about twenty feet long and sixteen inches thick, extending each way from the stem about ten feet. A stick of timber from 28 to 32 inches square was required to make it. It was firmly bolted to the knightheads. Above this was the forecastle rail. Having received orders to go to Liverpool, the ship was towed out of the harbor by a tug, and left, about half-past eight in the evening, four or five miles south-southeast of Roche's Point, headed on her voyage. The wind at the time was blowing a fresh breeze from the southwest. The tide was ebb and running to the westward. The usual route for vessels bound from Queenstown to Liverpool was past Tuskar Light, off the southeastern extremity of Ireland. The proper course for a sailing vessel, from the point where the Harvest Queen was left, would be east by south, but, to make that course, under the circumstances of

wind and sea which prevailed that night, it would be necessary to steer somewhat more to the southward. The Harvest Queen could not sail closer to the wind than seven points, and, with the wind as it then was, she was capable of making eight or nine knots an hour. The Adriatic was an iron steamer, running regularly between Liverpool and New York, in the White Star line. She was 450 feet long, 42 broad and 30 or 32 deep, with no bowsprit and a very sharp bow. She left Liverpool, on one of her regular voyages, at noon of December 30th, 1875, and was in all respects tight, staunch and strong, and properly officered, manned and equipped. She passed Tuskar Light a quarter of an hour after midnight, and the Saltees or Coningbeg Lightship, four or five miles away, at 1.55 A. M. of the 31st. The captain, after passing the Lightship, put her upon a course west ¼ north, which was somewhat further away from the Irish coast than usual, as he was not to stop at Queenstown. At 2.15 A. M. he went into the chart room and lay down on a sofa, without taking off his clothes. He had been on duty all the time after leaving Liverpool, and, when he went away, gave orders to be called at four o'clock, or sooner, if any vessels were seen. The chart room adjoins and opens out of the wheel house. The first officer was then on watch. He stood on the bridge, and most of the time on the starboard side. Three seamen were on the lookout, two stationed one on each side of the No. 3 house, and the other on the port side of the bridge. The third officer was on the saloon deck, where he could pass orders from the bridge to the wheel. One of the quartermasters was at the wheel, and another in the wheel house with him. The forward deck was roofed, and, from its shape, was called the turtle back, or whale back. No. 3 house was just abaft this turtle back. It was one hundred and thirty feet from the stem, and both the turtle back and the saloon deck were reached from it by bridges. The spray dashed over the turtle back, so that the lookouts could not have seen ahead at all times, if they had been stationed there. For this reason they were

put on the house. The bridge was one hundred and seventy-five feet from the stem. At 2.35 A. M., the first officer, from his place on the bridge, and looking through a night glass, saw a green light about two points on his starboard bow. It was so far away that it could not be seen with the naked eye. The steamer was then about fifty-two miles to the eastward of Roche's Point, and fifteen miles south-southeast of the Hook Tower Light. Both Coningbeg and the Hook Tower Lights could be seen from where she was. The wind was from southwest to south-southwest, blowing a fresh gale, and with a force indicated by the figures 7 or 8 on the Beaufort Scale. The night was dark on the water, but the sky was clear, with detached clouds. The sea was high and running strong from the southward. The steamer was going about twelve knots an hour, which was as fast as she could be driven under the existing conditions of wind and sea. She had all her regulation lights in their proper places and brightly burning. None of her sails were set, and she was propelled exclusively by steam. When the first officer discovered the green light, he had no means of telling what kind of a sailing vessel it was on, or what her exact course was. He did not change his course, but called the third officer to the bridge, who also looked at the light through the glass. Not long afterwards a light, bearing in about the same direction, was seen by the starboard lookout on the No. 3 house. He sent the other lookout stationed with him on the house, to give two strokes of the bell placed on the turtle back for signal purposes. This was promptly done, and signified that there was a light ahead off the starboard bow. It gave no indication of the color of the light. At 2.39 A. M. the green light, which had broadened to three and a half points on the starboard bow, or, possibly, something less, changed to red. The first officer thereupon ordered the wheel to port, and telegraphed the engineer to 'stand by,' following this, at once, with a further order, to 'slow.' All these orders were promptly obeyed, and, under the influence of her port helm, the steamer swung slowly to starboard. About a minute

afterwards, the red light changed to green. By this time the bow of the steamer had gone off about a point to starboard, and was swinging more and more in that direction, under the continued port helm. As soon as the green light reappeared the first officer gave an order to stop the engine, and then, as soon as it could be done, to back at full speed. These orders were all obeyed, and the engine got under reverse motion at or about 2.41. No change of the wheel was then made, but the first officer directed that the captain be called, and this was done. The captain, when he was called, came out of the chart room into the wheel house, and, as he passed to the deck on the starboard side, noticed, by the indicator, that the wheel was to port. When he got on deck, the engine was under reverse motion, and this he detected. Looking ahead, he saw a green light not very far away, about two points off the starboard bow. Then green and red lights appeared together, and then the red alone. Without any consultation with the first officer, he gave the order from the deck 'hard a-starboard,' and went on the bridge. This order was obeyed. In going astern the effect of a starboard helm is the same as that of a port helm when going ahead; it swings the bow to starboard. Very soon after the captain got on the bridge the Harvest Queen appeared through the darkness. She was apparently under as much sail as she could carry and headed for the Adriatic. Before anything further could be done on the steamer to avoid a collision, the jib-boom of the Harvest Queen ran over the turtle back and was in some way broken so that it fell down over the side of the steamer. The Adriatic's engines were at the time backing at full speed, and, if the vessel herself was not actually under sternway, she was not going ahead much, if any. She kept on backing, and, when the vessels got separated, as they soon did, a part of the ship's outer jib and its blocks and rigging were found on the turtle back and hanging over the port rail. The fish davits were made of round iron six and a quarter inches through where they leave the turtle back, and bent upwards like a bow. At the time of the collision, they

were ranged forward along the side of the vessel. The anchor stocks were of iron inches through. There were light iron guard rails around the turtle back. After the collision the port fish davit was found bent downwards towards the deck seventeen inches, or thereabouts, the port anchor stock broken and hanging by the lashings, and the guard rails on both sides bent, and some of the stanchions broken. The paint on the bow was somewhat chafed and scratched, but not very much. The first fish davit was thirty-seven feet from the stem, and the bent and broken rails about twenty-eight feet. The broken anchor stock was a short distance forward of the fish davit. No other injury was done to the Adriatic. The shock of the collision was scarcely perceptible abaft the foremast. There was no hail from the Harvest Queen, but, just after the collision, the first officer of the Adriatic hailed her once from the turtle back. No answer was heard. The Adriatic continued backing until 2.53 A. M., when her engines were stopped. After the vessels separated, the Harvest Queen passed across the bow of the steamer from port to starboard. Her masts appeared to be all standing and the sails upon them set, but, in some way, she was injured by the collision, so that she sank not long afterwards, with all on board, and became a total loss. Nothing has since been heard of her or any of her crew. When last seen she was apparently half a mile away from the steamer, and showing her green light four or five points off the starboard bow. Immediately after the vessels got separated, orders were given on the Adriatic to clear away the boats, and the men at once set to work to do so, but, the Harvest Queen still keeping in sight, the order was countermanded, for the moment. The Adriatic then steamed slowly toward the Harvest Queen, until she became lost to view. About the time she disappeared cries for help were heard in the water off in the direction of where she was last seen. The orders to lower the boats were then promptly repeated, and two boats put out. Some confusion occurred in getting the boats away, as the crews had not been assigned

to them, the steamer having only just left port. There was no unreasonable delay, however. The boats were put in command of the second and fourth officers, and rowed in the direction of where the voices came from, and where the ship was last seen. They remained out from half an hour to an hour, when they were recalled by a signal from the steamer. Nothing was found except a piece of timber supposed at the time to be a part of the broken jib-boom, and a piece of rope. At 4.30 A. M., the Adriatic again started on her voyage. The movements of the engine, after it was stopped at 2.53, were thus recorded in the engineer's log: '2.54 A. M., ahead slow; 3.00, stop; 3.15, astern slow; 3.16, stop; 3.23, astern slow; 3.26, stop; 3.45, ahead slow; 4.00, stop; 4.09, astern slow; 4.11, stop; 4.15, astern slow; 4.16, stop; 4.26, ahead slow; 4.30, full speed.' When the green light was first seen from the Adriatic, it is not probable that the Harvest Queen was where she could see the Coningbeg Lightship. She must have been just then coming within the range of that light, which is placed some miles outside of the land. It is at the south-eastern extremity of a series of dangerous rocks extending out a considerable distance from the land, known as the Saltees Rocks. On the 12th of January, 1876, a piece of the port side of the breasthook of the Harvest Queen, seven feet and ten inches long, and a piece of the starboard forecastle rail, extending from the cathead forward to the towing chock, were found cast ashore about a mile and a half west of Carnsore Point, which is on the coast of Ireland about midway between Tuskar and Coningbeg. Near the same place were also found a small piece of the name board of the Harvest Queen, and part of an oar, with her name on it. No other parts of the wreck have ever been found. The place at which these articles were found was where the wreckage would naturally have drifted, if the Harvest Queen went down in the neighborhood of where the collision occurred. The breasthook was broken square off, apparently about eighteen inches or two feet from the stem. The piece found was torn from the frame to which it had been bolted, in such a manner as to

leave the bolts standing in the original position, only a few being bent, and none drawn out. The name board was of light pine, not more than two or three feet long, and a foot wide."

Thomas E. Stillman, for the libellant.

Everett P. Wheeler, and *Joseph H. Choate*, for the claimant.

WAITE, CH. J. Many of the facts disputed below have not been questioned here. The claimant does not deny that the vessels actually collided, or that the Harvest Queen sank with all on board, in consequence of injuries received in the collision. The libellants also concede, that, if the Adriatic was not in fact going astern when the collision took place, she was making little or no headway. These questions are, therefore, out of the way, and the controversy about the facts is reduced to the color of the light first seen by the Adriatic; its distance; the time it appeared; the changes in color and bearing; and the movements of the Adriatic.

It would not be easy to solve all these questions satisfactorily, if the evidence was considered only in its parts. Taking it as a whole, however, I have had no great difficulty in reaching the conclusions stated in the finding of facts. The recollection of witnesses as to time, distances and bearings, cannot be relied on, in all cases, with implicit confidence. It is, at best, but the impression of what the judgment of the witness was about a matter of which no special note was made at the time. In but few instances is it claimed that the time was actually taken from a time keeper, or the bearing by a compass. It is easy to see that such impressions would be more or less influenced by what afterwards happened.

1. As to the time. All agree that no one saw the light until after five bells, or half past two. It was seen by the first and second officers on the bridge before it was by the lookouts. The officers put the time at 2.35, so recording it

in the log, and I see no reason to doubt the accuracy of their estimate or recollection. No witness directly contradicts them, and they are strongly supported by what is known to have taken place afterwards. At any rate, they cannot be far from the truth.

The engineer's log shows that the engine was first stopped, after backing, at 2.53. This was after the collision. It is the duty of the engineer, or his assistant, to make a record of every change in the movement of the engine, and the time when it occurred. Entries are made, at the very time the changes take place, with chalk, on a blackboard kept near at hand for that purpose, and the time is taken from a clock hung where it can conveniently be seen from the place where the engineer stands when working the engine. If the assistant attends to this duty, his place is at the blackboard immediately behind the engineer. From these entries the log is afterwards written up. Such being the duty of the engineer, it is to be presumed, until the contrary is shown, that the log contains a true statement of the time when the engine was stopped.

Upon this evidence, I have found that the light was first seen at 2.35, and that the engine was stopped after the collision, while backing, at 2.53. Consequently, eighteen minutes elapsed between the first discovery of the light and the time when it was deemed safe, after the collision, to stop backing the Adriatic, and go slowly ahead to see what was necessary to be done to save life or property.

2. As to the distance. The regulations require colored lights to be of such a character as to be visible on a dark night, in a clear atmosphere, from the deck of a ship, and with the naked eye, at least two miles. This light was first seen from the bridge of a large steamer and with a glass. The sea was high and the vessels consequently unsteady. Under such circumstances, it has seemed to me that the addition of half a mile or a mile to the regulation distance, on account of the glass and the height of the place of observation, was, probably, enough. This would make the distance

of the light, when first seen, two miles and a half or three miles. The estimate of Hamilton, the lookout, that it was three or four miles off when he first saw it, must be wrong, for it can hardly be believed that he could see such a light that distance, on such a night, and keep it in view, with the naked eye, standing, as he did, on deck, some feet below the bridge. Everything goes to show that the actual distance could not have been more than three miles and that it was probably less.

3. As to the color. The first and third officers both say distinctly it was green, and the lookout on the bridge thinks that was the color. All agree it first appeared off the starboard bow. The vessels would naturally be on nearly opposite courses. The Adriatic was going from, and the Harvest Queen to, Liverpool. The Adriatic, being a steamer, undoubtedly took the shortest practical route to Coningbeg. The Harvest Queen, having the wind free and being able to go substantially where she chose, would be likely to shape her course so as to sail as near as she could conveniently over the course of the Adriatic between Coningbeg and Liverpool. At Coningbeg the Adriatic was set upon a course a little to the southward of that the Harvest Queen would take in coming up from Queenstown. This would naturally place the Harvest Queen, before she reached Coningbeg, to the northward, which would be on the starboard of the Adriatic and expose her green light, unless she was heading outside of and across the Adriatic's course. The evidence that the red light was first seen is not of a character to inspire the fullest confidence, and falls far short of satisfying me that the first and third officers, corroborated, as they are, by other undisputed facts, are mistaken. These officers had the means of knowing, and it was their special duty to know, what the facts really were. Their conduct was consistent with what they say they saw, and the scrap log, written up by the third officer, and afterwards transferred by the first officer, with such corrections as he thought necessary, to the official log, agrees with their testimony. These logs are the official

record of what they saw. The light was either green or red. Whether the one or the other could alone be determined by the eye, and the impressions made at the time would be likely to continue, no matter what happened afterwards. If the logs are not correct, it is because they were intentionally falsified, a thing certainly not to be presumed.

That a red light was seen at some time before the collision is not disputed, and I entertain no doubt that it first appeared after the green.

4. As to the bearing. The log states, that, when first seen, the light bore about two points on the starboard bow, and, when it changed from green to red, about three and a half points. This was the estimate of both the first and third officers. No memorandum was made of it until the scrap log was written up, between four and five o'clock in the morning. In the mean time the collision had occurred, and the attention of all had been directed for more than an hour and a half to a search for the other colliding vessel, and to the saving of life and property. From the other circumstances in the case, I am strongly inclined to think the officers have put the bearing further to the starboard than it really was, but still there is nothing which shows satisfactorily what, if any, change should be made in their estimates, and their record in this particular must be accepted as true.

5. As to the movements of the Adriatic, and, in this connection, as to where the collision occurred and when the changes in her movements were made. There can be no doubt that the steamer ran for some time after seeing the light without changing her course or speed. The first order was to port, and that was followed immediately by orders to "stand by" and "slow." These last were given, according to the engineer's log, at 2.39. The correctness of this entry was disputed on the argument, but I see no reason to doubt it. The chief engineer was alone at the engine when the orders came. The assistant got to his post as soon as he could after he heard the telegraph bell, and remained until the watch was changed. In the absence of the assistant it

was the duty of the engineer to make the necessary memorandum on the blackboard. The presumption is that what ought to have been done was done, and I have found nothing in the case to indicate that this officer was negligent in anything. His record should show the actual time, as given by the clock, when the change was made, and I am satisfied it does.

This being the case, it follows that the Adriatic kept her course at full speed four minutes after the light first appeared. The vessels, during that time, must have been lessening the distance between them at a combined speed of full twenty miles an hour, or about a mile and a third in the four minutes. At 2.39, therefore, they were probably not more than a mile and a half apart. The engine was then slowed, and, before the collision, the speed of the steamer ahead was run down from twelve miles an hour to nothing, if she had not actually acquired sternway. Her average speed from the time she slowed until her headway was entirely overcome was half what it was before, or say six miles an hour. During the same time the average combined speed of the two vessels was fourteen or fifteen miles an hour; and if, at 2.39, they were a mile and a half apart, it would take them six minutes, and, probably, a little more, to get together. The Adriatic stopped backing at 2.53. She was then supposed to be about half a mile from the place of collision. Her maximum speed in backing did not exceed seven miles an hour. Her average speed in getting up to this maximum, after she had stopped going ahead, would, consequently, be three miles and a half an hour, if there were no obstructions in the way. But, we know that, in addition to getting up her own sternway, she had to separate herself from the Harvest Queen almost entirely by the use of her own power, since the effect of the wind was to keep the two vessels together until they got free of each other. I think it fair to assume, therefore, that the steamer continued backing seven or eight minutes after the collision. In this time she would have gone about half a mile. In view of these facts I have

had no difficulty in reaching the conclusion, that the wheel of the Adriatic was ported at 2.39, and that the collision occurred from 2.45 to 2.47.

The first officer says, that, when the green light appeared the second time, he telegraphed to "stop," and followed this order, as soon as possible, with another, to back at full speed. The engineer's log shows that the order to stop came at 2.40, and the one to back at 2.41. Time in seconds is not put on the log, and from entries of this kind it may fairly be inferred that one order followed close on the other.

Some discussion was had at the bar, in this connection, as to the time the captain was called, and how soon he came on deck, but to my mind these questions are unimportant, so far as this branch of the case is concerned.

It only remains to consider, under this head, what changes were made in the course of the Adriatic. At 2.39 the wheel was ported, and at the same time the engine was slowed. At 2.40 the engine was stopped, and at 2.41 put at full speed, under the reverse motion. The steamer could not, therefore, have run more than two minutes under her port helm before her screw began to turn backwards. In two minutes, at her full speed of twelve miles an hour, she would not have gone but two-fifths of a mile, and, under the "slow," it is not probable she made much, if any, more than a quarter of a mile. The estimate of the witnesses is, that, when the orders to stop and go astern were given, she had not swung more than a point or a point and a half. This being so, her departure from her original course could not then have been very great, and, when the screw was reversed, the rudder had but little effect until sternway was acquired. Under these circumstances, I cannot think, that, when the collision took place, the steamer had gone more than two or three points off her course. Very little dependence can be put on the recollection of the officers or men as to the exact heading of their vessel. They were in a position which made it more important to look at the way they were to get out of the

danger that threatened them, than to the exact angle of their course.

Without more as to the particular facts, I proceed to the consideration of what seems to me to be the real controversy in the case; and that is, whether, as a matter of law, the Adriatic was in fault for porting, stopping, or backing, or for starboarding on the order of the captain, when he came on deck. There is now no doubt, that, if she had kept her course and speed, and the Harvest Queen had done what she in fact did do, there would have been no collision. It was a mistake, therefore, to change, but every mistake is not necessarily a fault, in Admiralty. The law requires that those in charge of the navigation of vessels like the Adriatic should possess a very high degree of nautical skill. They are charged with the important duty of directing the movements of the powerful machinery placed under their control, so as not unnecessarily to endanger life or property, either on board or not on board. For this purpose they are required to exercise good judgment. They need not be infallible. It is enough if they do what others, having the requisite skill, and placed in a like situation, would ordinarily have done.

The conduct of those on the Adriatic must be considered in connection with the facts as they successively presented themselves at the time. And, first in order was the green light, seen a point and a half or two points on the starboard bow, two miles and a half or three miles away, and to the leeward. The wind was from the southward and westward, accompanied by a driving sea from the same direction. So long as that light alone was in view in that quarter, it was safe for the steamer to keep her course and speed, and no one could complain if she did. The highest skill would not be likely to suggest anything different. Next, the green light was changed to red, and thus the green of the steamer exposed to the red of another vessel not a very great way off. At this time nothing but a light was seen. Neither the ship nor her sails had appeared. It was only known for a certainty that a red light was on the water, well off the starboard bow

of the steamer, between her and a dangerous lee shore, and that it was probably carried on some kind of a sailing vessel, as no white light accompanied the red. What course the vessel was steering could not then be told with exactness. It was under such circumstances that the first officer was called on to decide whether he would attempt to cross in front of the light at full speed without porting, or whether he would port and slow, or do either alone.

I am aware that it is not every case of meeting port to starboard that will justify a port wheel, to put port to port. The rule is for one vessel not to cross the bow of another at a dangerous proximity, and it is just as wrong to knowingly do this by porting as it is by starboarding. Here, however, there was uncertainty. A light only was seen. It might be on a vessel beating down the channel, or on one coming up. The vessel might be one that could sail close to the wind, or another that was obliged to keep more away. On a steamer going at the rate of twelve miles an hour against or across the wind, it is not always easy to tell the exact direction from which the wind is blowing. Practice will undoubtedly enable some to make estimates that will approximate the truth, but it will not always do to venture on nice calculations, without more accurate observation than can generally be made under such circumstances.

The appearance of the red light in the place of the green indicated clearly that the vessel on which it was displayed occupied a different position towards the steamer from what she did before, and that in some way the courses of the two vessels were changed, so that they crossed ahead of where the steamer then was. How far ahead was uncertain. Under these circumstances it was that the officer in command deemed it prudent to put his wheel to port, so as to bring his red light opposite the same light of the approaching vessel, and, as there was doubt, to bring his vessel under better control in case of an emergency, by reducing her speed. It is now probable, that, if the ship could have been seen, and her exact position made out, neither of these things would have been

done, but the question here is not what, with the knowledge we now have, ought to have been done, but what, with the facts as they then appeared, ordinary prudence would suggest. It needs no argument to show, that a speed of twelve miles an hour, with a vessel weighing, as the Adriatic did, 8,000 tons, would, under some circumstances, be dangerous. The natural impulse of a skilful navigator, if in doubt as to what was before him, would be to reduce this speed, so as to get his ship under better control while the uncertainty continued. So, too, a red light exposed to a green is more likely to be unsafe than red to red; and, where reasonable doubt exists as to the relative position of the two vessels, instinctively, almost, those in command endeavor to bring the two red lights together, as the appropriate way of avoiding all danger.

It has, however, been argued with much force, that, if the red light was first seen a mile and a half away, three points and a half over the starboard bow, the Adriatic ought to have known, that, with the wind as it was, she would cross the course of the approaching vessel long before there could be any danger of collision, and that to attempt to pass otherwise was a clear fault. I have very great doubt whether, when the red light appeared, it was as far over the bow as seems now to be supposed, but, be that as it may, the exact position of the ship could not be seen; and I do not think such a mistake as may have been made ought, under the circumstances, to be visited with the consequences of a legal fault. The change of the green light to red was calculated to induce the belief that the ship on which it was carried had changed her course, and I am by no means satisfied, from the evidence, that she did not do so. As the case stands, it now seems to me probable, that, if the steamer had kept her course, with that light in view, there would have been no collision. Soon, however, the red light went out and the green again appeared, still without ship or sails in sight to aid in determining what ought to be done. This added to the original uncertainty, and clearly made a case apparently for the application of the

rule which requires a steamer in doubt to get away from apprehended danger. To go ahead would look like approaching the peril, while to back would seem to be withdrawing from it. A change of helm at that time was not specially important, because, before it could be made of any practical use, the screw would be under its reverse motion, and then the rudder could have but little effect until the momentum was overcome and sternway obtained. When that was done, the port wheel would have the same effect on the swing of the bow as a change to starboard would have in going ahead. If the witnesses are to be believed, the course of the ship appeared to be unsteady, and, that being so, it is hard to say that backing away from her was a fault. In the darkness which then prevailed that would seem to be the safest thing that could be done.

Complaint is made of the captain, because, after coming on deck, he ordered the wheel to starboard, without consulting the first officer. The captain says he gave the order when he saw the red light change to green, and when, as he supposed, the steamer was under sternway. I am satisfied, however, that the forward motion had not been overcome. The engine was working astern and throwing the "white water" forward, but the steamer herself was still going ahead. If she had been going astern the order would have been right, for the starboard wheel, in backing, would bring the bow to starboard, and thus assist in putting the vessels on parallel courses, with their green lights opposite each other. As long as she was going ahead slowly it made but little difference which way the rudder was, since the backward movement of the screw prevented the operation of the rudder to any considerable extent. The order, therefore, could not have contributed to the collision and did no harm.

It is again insisted, that the Adriatic was in fault for delay in getting out her boats, and for not waiting until daylight before starting on her voyage. The order to clear away the boats all agree was given with promptness, and I cannot find that there was any culpable delay in getting them out.

Before they could be lowered, the steamer was half a mile away from the place of collision and from the ship. It was, certainly, good judgment to wait until the steamer could be got nearer before putting the boats in the water, and it is not seriously contended, that, when the order was given the second time, it was not obeyed with all the promptness that ought to have been expected. The engineer's log, the correctness of which I do not doubt, shows conclusively that the steamer was lying by and moving cautiously about in the vicinity of where the accident occurred for much more than an hour. The gale was all the time increasing, and the lee shore not far away was dangerous. The official report of the weather shows that the next morning at eight o'clock the wind was blowing a strong gale at Tuskar, the nearest signal station. The ship must have gone down before morning, and, probably, while the steamer was lying by. If the ship's boats had been got out, there can hardly be a doubt they would have reached the steamer, lighted as she was from the mast-head. If they were not out, it is probable there was nothing left on the surface of the water to save, after the voices which had been heard were lost; and this must have been considerably more than an hour before the steamer left. In the meantime the steamer's boats had been out for nearly an hour, and diligent in their efforts to do all that could be done. While, therefore, it would have been more satisfactory if the steamer had staid by longer, I cannot say she was in fault for not doing so. The probability is that nothing more could have been done if she had held on, and she owed her first duty to those she had on board.

Complaint is also made of the unsatisfactory account of the collision given in the logs, of the painting over of the scratches on the bow in New York, and of the reticence of officers of the steamer on her arrival. All these furnish just cause for criticism, but I cannot say they overcome the effect of the other facts which to my mind have been satisfactorily established in spite of them.

My attention has also been called to some supposed dis-

crepancies in the cases made by the logs, the answers, and the testimony given on the defence. I have failed to find any such substantial differences as to cast suspicion on the testimony. The difficulty with me has been not so much as to the facts, as to the duty of the Adriatic in connection with the facts I have found.

The case has been presented in the most satisfactory manner on both sides. Nothing has apparently been left undone by counsel or parties that they could do, to aid me in the determination of the facts or of the law; and, after the careful consideration which such laborious preparation deserves, I have been unable to reach any other conclusion than that the fault of the Adriatic has not been shown. A steamer is not justified in coming into collision with any other vessel, if it is possible to avoid it, that is to say, if it can be avoided by the use of such means as those having the requisite skill would ordinarily employ for that purpose under like circumstances. I cannot but think the officers of this steamer have brought their justification within the fair operation of this rule. Much of what was done at the time of this disastrous collision will never be known. It is impossible to tell with certainty how the vessels came together. The ship came and went in a comparatively short time, and necessarily in the midst of great excitement. Almost every witness has his own peculiar theory. Hardly any two of the large number of diagrams in the record, representing what the observers think they saw, agree in the material points, and it would be a useless task to attempt now to ascertain just how the damage was done. It seems almost incredible that so large, and apparently so strong, a ship could be broken into and sunk in so short a time, without inflicting serious injury on the Adriatic. As it was, the iron plating was hardly touched. Not a single indentation has been found which can fairly be attributed to an actual contact with the hull of the ship. The scratches on the paint must have been very slight, and it is by no means certain, from the testimony, that any were found on the stem, or the starboard side of the bow. There is cer-

tainly no satisfactory evidence showing that the sharp bow of the Adriatic went any considerable distance inside the hull of the ship. As the Adriatic was stopped, or nearly so, it is evident that the blow which caused the loss must somehow have come from the Harvest Queen herself.

It is a very remarkable fact, under the circumstances which are known to have existed, that no hail was heard from the deck of the ship before or after the collision. This seems entirely inconsistent with the idea that she could have had her proper complement of men standing watch and attending to their duties at the time. Confessedly, a considerable time elapsed between the collision and the final disappearance of the ship, enough, certainly, to have given an opportunity to lower away her boats, if her crew had been at their posts. But it is not my intention to look for the faults of the ship. I place the decision entirely on the ground, that, upon the case as it stands, the steamer is free from blame.

A decree may be prepared dismissing the libel, with costs in both Courts.

ALEXANDER F. EVORY AND OTHERS

vs.

L. CANDEE & COMPANY. IN EQUITY.

A written license under a patent stated that the patent was "lawfully granted," and provided for the revocation of the license by the licensor, for non-payment of royalty, and declared that such revocation should not impair "the effect of the admission of the validity" of the patent. The licensor revoked the license for said cause and then sued the licensee in equity, for an account and the payment of the royalty which accrued prior to the revocation. The licensee set up that the patent was void, for want of novelty, and that he had never paid any royalty under the license. The plaintiff moved for a decree

on the bill and answer and an affidavit, and the defendant put in counter affidavits: *Held*, that, under Rule 90, in equity, the English practice in 1842 must be followed, and not any later English practice; that the affidavit could not be considered; but that the case should be heard on bill and answer;

Held, also, that the licensee was estopped, by the terms of the license, from setting up the invalidity of the patent, as a defence.

The licensee also set up a parol agreement, made before the written license, reserving to the licensee a right to use the invention without royalty, if he should become satisfied that the patent was void. After the time when such parol agreement was alleged to have been made, the licensee himself drew said written license: *Held*, that he could not be allowed to set up such parol agreement.

(Before SHIPMAN, J., Connecticut, October 6th, 1879.)

SHIPMAN J. This is a bill in equity for an account, and is brought to recover from the defendant the license fees which are claimed to be due to the plaintiffs by virtue of a written agreement between said parties, dated July 10th, 1877, whereby the defendant was licensed, upon an established royalty, to use letters patent dated November 6th, 1866, for a "double expansible gore flap," in the manufacture of boots and shoes. The plaintiffs are citizens of the States of New York and of Michigan. The defendant is a citizen of the State of Connecticut. The bill alleges, upon information and belief, a manufacture and sale by the defendant, between July 10th, 1877, and October 9th, 1878, of a large number of boots and shoes containing the invention described in the letters patent, and prays for an account of the number manufactured or sold between said dates. The license was revoked by the plaintiffs on October 9th, 1878. The agreement, which is made part of the bill, recites as follows: "Whereas, letters patent of the United States, dated the 6th day of November, 1866, numbered 59,375, were lawfully granted unto Alexander F. Evory and Alonzo Heston, for a new and useful invention, consisting of a double expansible gore flap used in the manufacture of boots and shoes; * * * and whereas L. Candee & Co., of New Haven, Conn., manufacturers of rubber boots and shoes, are desirous of acquiring

the privilege and license of using said invention in the manufacture and sale of shoes." The agreement, after authorizing the licensors to revoke the license upon non-payment of the royalty, provides, that such revocation should not impair "the effect of the admission of the validity of said letters patent or re-issue, or of the novelty, utility and practicability of the said invention." A royalty of three cents per pair on all shoes while the licensee should manufacture or sell was established. The licensee further agreed to pay at least five dollars, as a license fee, upon the first days of each quarter, "even though they should not make enough of said patented shoes to amount to that sum, at the royalty of three cents per pair."

The answer denies that the patentees were the original and first inventors of the alleged improvement, and, admitting that an agreement of July 10th, 1877, was entered into, denies that the defendant, in said agreement, admitted the validity of the patent, but avers, that, "before the said license was granted to the defendants herein, the complainant Belcher presented to these defendants a printed form of license, in which was printed an admission of the validity of the said letters patent here in suit; that these defendants had grave doubts whether said letters patent were good and valid, and refused to sign the said printed form, because of said admission, and expressly stated to the said Belcher that they did not admit the validity of the said patent, but were willing to take a license thereunder at the stated royalty of three cents per pair for all shoes made by them, which embodied the alleged invention set forth and claimed in said patent, but that they reserved unto themselves the right to deny the validity of said patent and to contest the same, and to refuse to pay said license money, and to continue to use said invention without payment of said license money, if they should thereafter conclude that said letters patent were void;" that thereafter an agreement or license was prepared, omitting the said admission, which was then, and on July 10th, 1877, executed by the defendant herein; and that the defendant

has never, nor has any one for it, paid any royalties under the said alleged license, and has always refused to pay royalties under said license, on the ground of the invalidity of the letters patent; and that the license was revoked by the plaintiffs on October 9th, 1878. The answer alleges the invalidity of the patent for want of novelty and of patentable subject-matter, and that the license is void for want of consideration, and that the "defendants do not know how many, if any, boots and shoes, containing the alleged invention, they have manufactured and sold between July 10th, 1877, and October 9th, 1878, and they refuse to ascertain and state the same."

In this state of the pleadings, the case was set for hearing upon the bill and answer, and the plaintiffs moved for a decree pursuant to the prayer of the bill, "upon the bill and answer filed herein and the annexed affidavit and the papers therein referred to," and filed an affidavit tending to show that the defendant, in its answer in another case in this Court, had relied upon the validity of the licensed patent. The defendant filed counter affidavits.

The plaintiffs' motion is in accordance with the comparatively recent English Chancery practice, which was authorized by an Act of 15 and 16 Vict. and by the Orders of Court passed in August, 1852. (1 *Dan. Ch. Pr.*, 822 *to* 826.) The 90th Equity Rule of the Supreme Court provides, that, in all cases where the prescribed Rules do not apply, the practice of the Circuit Court shall be regulated by the "present" practice of the High Court of Chancery in England, "not as positive rules, but as furnishing just analogies to regulate the practice." That Rule adopts the English practice, as it was known and understood in 1842, at the time the Rule was ordained. Consequently, the practice of this Court remains unaffected by the new orders, so called, which the Courts of that country have since incorporated into their practice. (*Badger* v. *Badger*, 1 *Cliff.*, 237; *Goodyear* v. *Providence Rubber Co.*, 2 *Cliff.*, 351.) This motion, in the form in which it was made, coupled with affidavits, does not seem to be in accordance with the practice of the Federal Courts, but I shall

regard the hearing as a hearing upon bill and answer, without reference to the affidavit of the plaintiffs.

The question in the case is, whether the answer sets up a legal defence against the admitted facts which are alleged in the bill. "If an answer is insufficient in its responses to the charges and statements in the bill, the objections are to be taken to it by exceptions filed. If it is in substance bad as a defence, and no further proofs are required by the plaintiff, the case can be set down for hearing upon the bill and answer, and will be adjudged accordingly." (*Story's Eq. Pl., sect.* 456.)

Two questions are presented by the answer: (1.) Is the licensee estopped, by the terms of the license, from setting up the invalidity of the patent, as a defence in an action for license fees due prior to the revocation of the license? (2.) Is a parol agreement, made prior to the license, that the licensee shall be at liberty to attack the patent, to be admitted, in view of the recitals and provisions of the license, there being no allegation or claim that anything was inserted, or was omitted, in the written agreement, through fraud, mistake, or accident?

It is not necessary to consider, upon the first point, the question whether, in an action to recover overdue license fees, the licensee is estopped from contesting the validity of the patent, by a naked license, and by an unmolested exercise of the right which the license purported to convey, for, in this case, the licensee expressly admitted the validity of the patent, in the recitals of the agreement. It is admitted that the agreement which is set out in the bill is the one which was executed by both parties. The defendant asserts in the license, that the letters patent were lawfully granted to the patentees for a new and useful invention, and has thereby tersely admitted the novelty and utility of the invention specified in the patent, and the validity of the grant to the patentees. It is not permissible to the licensee, unless the recitals were introduced by fraud, imposition, mistake, or accident, to deny their truth, in an action for license fees which accrued before the revocation of the license.

The defendant next relies upon a parol agreement, made prior to the execution of the license, whereby it reserved to itself the right to deny the validity of the patent. It appears, from the answer and from the defendant's affidavit, that a license was sent to the defendant, which contained an express admission of "the validity of said letters patent, and the novelty, utility, and practicability of the invention therein described and claimed, or that may, or can be, described and claimed in any re-issue thereof." This agreement the defendant declined to sign. The parties subsequently met, and the defendant informed the plaintiffs that it would sign a license, but reserved the right to defend on the ground that the patent was not valid, if it should so conclude, and to use the alleged invention described in the patent without royalty, if it became satisfied that the patent was void. Thereupon, the plaintiff requested the defendant to draw up a license in the form which it would sign. The license set forth in the bill was drawn by the defendant, and was signed by the parties.

The defendant suggests that the parol reservation was a valid collateral agreement, which should be enforced. It is true, that, oftentimes, a collateral parol agreement has been permitted to be proved, "which does not interfere with the terms of the written contract, though it may relate to the same subject-matter." (2 *Taylor on Ev.*, § 1,049.) This parol agreement, reserving a right to use the licensed invention without royalty, if it became satisfied that the patent was void, is substantially inconsistent with the written agreement which the defendant subsequently drew, wherein it promises to pay a royalty during the unexpired term of the patent, reserves no right of revocation, twice admits the validity of the patent, and declares that a revocation by the licensors, for non-payment of royalty, shall not impair the effect of the admissions. The parol agreement is in the teeth of the subsequent written contract.

The bill avers a use of the patented invention by the licensees prior to October 9th, 1878, which, though not denied, is not admitted in the answer. (*Brown* v. *Pierce*, 7

Wall., 205.) But the license also provided for a quarterly payment of five dollars, although no shoes containing the patented invention had been made. The execution of the license having been admitted, it is apparent, from the pleadings, that something is due the plaintiffs. Let there be a decree for an account, in accordance with the prayer of the bill.

Frederic H. Betts, for the plaintiffs.

Charles F. Blake, for the defendant.

CHARLES PARKER

vs.

CHARLES REMHOFF. IN EQUITY.

A patent for making a protuberance from the inside on the outer surface of the rim of the cover of a box, and a like protuberance from the inside on the outer surface of the rim of the box, so that, when the cover closes on the box, the projection on its rim will snap over the projection on the box, and thus form a fastening, is infringed where, instead of the protuberance on the cover, a hole is made in the cover.

The burden of proof is on a defendant, to establish, by satisfactory evidence, the prior use of a patented invention.

(Before BENEDICT, J., Eastern District of New York, October 9th, 1879.)

BENEDICT, J. This action is to recover damages and for an injunction against the defendant, for an infringement of letters patent owned by the plaintiff. The subject-matter of the invention is a method of fastening for metal boxes. The invention consists in producing two indentations, one in the forward part of the rim of the cover, and struck from the inside, so as to produce a protuberance on the outer surface of

the rim; the other, of like character, also from the inside, upon the rim of the box part. These indentations are so placed, that, when the cover closes upon the box, the projection on its rim will snap over the projection on the box, and so form a fastening for the box. The defendant makes a metal box and puts a hole in place of an indentation from the inside of the rim producing a protuberance, into which hole a protuberance on the box snaps, and thus the box is fastened. The difference between the plaintiff's and the defendant's device is, that, in the defendant's fastening, the sides of a hole perform the function which, in the plaintiff's fastening, is performed by the sides of an indentation. The sides of the hole in the rim of the defendant's box perform the same function as that of the sides of the indentation in the plaintiff's box, and produce a similar result. The plaintiff makes an indentation in the rim of his box, to permit the protuberance on the body of the box to snap into it and so fasten the box. The defendant, instead of making an indentation, cuts a hole, which permits the protuberance to snap into it, and, by the action of the sides of the hole upon the sides of the protuberance, the box is fastened. There is no difference in principle or effect between the two fasteners, and, in my opinion, the charge of infringing is made out.

The defendant, as a further defence, denies the validity of the plaintiff's patent, for want of novelty, and produces several witnesses and various boxes, for the purpose of showing that devices similar to the plaintiff's were in use prior to the date of the plaintiff's patent. Here, the burden is upon the defendant, to establish the fact of prior use by satisfactory evidence. This has not been done. Of the various boxes that have been produced, only two of them can make any claim to resemble the plaintiff's invention, and the testimony in respect to these two articles is too indefinite and uncertain to warrant the conclusion that they were in existence prior to the plaintiff's patent, in the face of evidence from several of the largest dealers in this sort of merchandise, that, previous to the plaintiff's invention, no boxes so fashioned were known,

and that, when the plaintiff introduced his fastening, the forms then in use were superseded and no longer salable. The evidence, as it stands, has failed to convince me that any fastening similar to that of the plaintiff was in public use or on sale in this country prior to the invention of the plaintiff. There, must, therefore, be a decree in favor of the plaintiff.

B. E. Valentine, for the plaintiff.

Matthew Daly, for the defendant.

The American Diamond Rock Boring Company.

vs.

Charles Sheldon and others. In Equity.

The re-issued letters patent, No. 3,690, granted to Asahel J. Severance, as assignee of Rodolphe Leschot, October 26th, 1869, for an improved rock drill, are valid.

Where a re-issue is granted to an assignee, it is to be taken that he had title to the patent, unless the contrary is made to appear.

A suit which is dismissed for want of prosecution is no bar to a subsequent suit for the same cause of action.

The question of the infringement of said re-issue, considered.

In determining whether a re-issue is for a different invention from the original patent, the two must be compared, to see if the invention patented in the re-issue is in any manner described in any part of the original and whether it might have been patented there.

(Before Wheeler, J., Vermont, October 9th, 1879.)

Wheeler, J. This suit is brought for relief against infringement of re-issued letters patent, No. 3,690, to Asahel J. Severance, as assignee of Rodolphe Leschot, October 26th, 1869, for an improved rock drill, and has been heard upon

pleadings, proofs, and argument of counsel. The plaintiff shows title from Severance. The defendants claim that Severance had no title, and that, therefore, the plaintiff has acquired none, and is not the owner of the patent; that Leschot was not the first inventor of the invention patented; that the re-issue is for a different invention from that in the original patent and is, therefore, void; that the plaintiff is estopped from maintaining this suit, by a decree of the Circuit Court of the United States for the District of New Hampshire, dismissing a bill brought by the plaintiff against the Sullivan Machine Co., of whom these defendants bought the machines claimed here to be an infringement of the patent, for an infringement there of this same patent; and that the defendants do not, in fact, infringe.

That the patent was valid, and that it was infringed by a drill then in use by the Sullivan Machine Co., was adjudged in favor of the plaintiff, in a suit in favor of the American Diamond Drill Co., from whom the plaintiff derives title to the patent, against the Sullivan Machine Co., from whom the defendants acquired title to the machines in question, in the Circuit Court of the United States for the Southern District of New York. (*Am. Diam. Rock Boring Co.* v. *Sullivan Machine Co.*, 14 *Blatchf. C. C. R.*, 119.) That was a suit between privies to these parties, and would seem to settle those questions, as between them. And, if that judgment would not be technically conclusive, the authority of it would be sufficient ground for determining the same questions in the same way here, unless presented upon different facts; and there is nothing before the Court here which was not produced there, that should vary the result.

An English patent to Robert Bearl, before Leschot's invention, is presented here, as showing an anticipation, and was not presented there; but, the devices described in that patent are not like Leschot's. It made use of water, but not in the same way, and did not have diamonds, as Leschot's has, nor anything equivalent to them, for the purpose for which they were used. Other things prior have been put in evi-

dence, properly enough for the purpose of showing what was in existence at the time of Leschot's invention, to construe the patent by, but not pleaded, or stipulated about, so as to be properly in the case to be considered upon the question of anticipation of the entire invention. There are, however, none of them, as they have been viewed, which would appear adequate for that purpose, if properly set up in the answers. These matters are, therefore, left to stand as they were placed by that decision.

As the re-issue was granted to Severance, it is to be taken that he had title, unless the contrary is made to appear. The defendants have introduced an abstract of title, which shows that Severance acquired title from one Dow, and shows a contract between him and Leschot, upon which there is some question about whether it carries title or not. But, showing that title does not show that there is no other, and there is a lack of any competent evidence in the case to show that there is not, by some other line of conveyances, a perfect title. If the certificate to the copies could be said to imply that there was no other title of record, it would not be evidence of the fact. Such copies are evidence of what is of record, as the originals would be, but are not evidence of the fact that there are not other records. (*Rev. Stat. U. S., sec.* 892; 1 *Greenl. Ev.*, § 498.) But, even if this was not so, the abstract produced shows that Dow had full title to one-half of the patent which would pass to Severance and to the plaintiff, and, as there has been no objection to any non-joinder of any other party, that title would be sufficient to maintain this suit, for the protection of that interest, at least.

The defendants set up the decree in the District of New Hampshire, as a bar, legal or equitable. The plaintiff traverses the answer, which makes it necessary for the defendants to make proof of that defence, because it is not responsive to the bill. The proofs do not at all show that the bill there was for the same relief as this one. The making and selling these machines to these defendants may have been long subsequent to the bringing of that bill, and even to the de-

cree. If the bill had been for the same relief, and had been dismissed on its merits, it would have been entirely conclusive as between the parties to it and their privies, as to that cause of action, upon every question which might have been raised concerning it, whether actually made upon pleadings or evidence or arguments of counsel, or considered by the Court, or not. But, where a judgment upon a different cause of action is relied upon as settling a question, it must be shown that the question was actually raised and decided. (*Cromwell* v. *Sac*, 94 *U. S.*, 351; *Davis* v. *Brown*, 94 *U. S.*, 423.) The record produced, and that is the only evidence upon this subject, fails to show that any question open here was, in fact, passed upon there. It shows that the bill was dismissed, with costs, but shows no ground upon which it was dismissed, except the want of appearance of the plaintiff; and a dismissal for that cause is not conclusive in favor of the defendant, even upon another suit for the same relief. (*Mitf. Eq. Pl.*, 238; *Carrington* v. *Holly*, 1 *Dick.*, 280; *Rosse* v. *Rust*, 4 *Johns. Ch. R.*, 300; *Badger* v. *Badger*, 1 *Cliff.*, 237, 245; *Porter* v. *Vaughn*, 26 *Vt.*, 624.) That suit appears to have been, in reality, dismissed for want of prosecution, and, in effect, is like a nonsuit in an action at law.

This leaves the question of actual infringement, by the machines now in use by these defendants, to be determined here. This question was expressly left open and undecided by Shipman, J., in *Am. Diam. Rock Boring Co.* v. *Sullivan Mach. Co.*, (*before cited.*) The drill now in use is precisely like that adjudged to be an infringement in *Am. Diamond Drill Co.* v. *Sullivan Mach. Co.*, except that, in the latter, the diamonds at the circumference projected beyond it, while in the former the stock is enough larger than in the latter to fill out and be flush with the diamonds at the circumference. The diamonds themselves stand precisely as they did before, and the proof is quite full, especially that on the part of the defendants, that they operate precisely as they did before. It was supposed that, with the stock flush with the outer edges of the diamonds, there would not be room for the detritus to

be carried up outside of the stock, even if the drill would penetrate the rock far enough to make any to be carried up; but it was found, on experiment, that the diamonds, when projecting, always cut a hole larger than the circle they would describe when centred accurately, and enough larger to permit the detritus to pass upward with the spaces between them filled, and that filling the spaces, by bringing the stock out flush with them, would not interfere with their operation. The diamonds are the operative things, and the drill, with the stock flush with them at the circumference, has all the elements for cutting that one with the diamonds projecting there has, and operates in precisely the same way. The flush stock is better than the other, in some respects. Making it flush is, probably, an improvement upon the other, but, if so, it is an improvement, made by adding to the other, and not by altering its constituent parts or their mode of operation. As the use of the other without the addition to the thickness of the stock was an infringement, it would seem that the use of this in the same way, with the addition, would be.

Besides this, Leschot's patent was not merely for a drill with the addition of laterally projecting diamonds. It did not purport, on its face, to be for such an invention; neither is it necessary, on account of the prior state of the art, to construe it as being only for that, in order to sustain it at all. The patent was as much for the forward projecting diamonds and their mode of operation, as for any other part. No one before had ever made a drill, either annular or cylindrical, armed with diamonds, and worked by a rotary and direct forward motion communicated to it by power. Still less had any one ever invented such a drill, assisted in its operation by water carried in through a tubular bar and stock. The original patent did not cover the mode of using water, although the specification showed that to be a part of the invention. This made it a very proper case for a re-issue, to cover that part before omitted. It is, probably, true, as argued by counsel for the defendants, that the first re-issue was altogether too broad and could not have stood, which made it proper to have

that corrected by another surrender and re-issue, as was done. The second re-issue was proper, as stated by Shipman, J., in the case before cited, and it would not be affected at all by the faults of the first re-issue, but would correct them. In *Thomas* v. *Shoe Manufacturing Co.*, (16 *Off. Gaz. of Pat. Off.*, 541,) Mr. Justice Clifford said: "Where the Commissioner accepts a surrender of an original patent and grants a new patent, his decision in the premises, *in a suit for infringement*, is final and decisive, and is not re-examinable in such a suit in the Circuit Court, unless it is apparent upon the face of the patent that he has exceeded his authority, that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced or secured in the original." "Inquiries in such a case are restricted to a comparison of the terms and import of the two patents, in view of the drawings and Patent Office model. If, from these it results that the invention claimed in the re-issue is not substantially different from the one described, suggested or indicated in the specification or drawings of the original patent or Patent Office model, the re-issued patent must be held valid, as all other alterations and amendments plainly fall within the intent and purpose of the provision in the Act of Congress, which allows a surrender and re-issue; or, in other words, if the re-issued patent does not, upon the face of the instrument, embrace anything not substantially described, suggested or indicated in the specifications, drawings or model of the original, the defence that the re-issued patent is not for the same invention as the original must be overruled." Under this rule, upon this question in this case, there is nothing to do but to compare the re-issue upon which the suit is brought with the original patent, disregarding all else, to see if the new invention patented in this re-issue is the same that is in any manner described in any part of the original; not whether it was patented, or even thought or sought to be, there, but whether it appears, from what is there, that it might have been patented there if it had been thought of

and desired. Upon such comparison, there is nothing in the re-issue which is not in the specification of the original distinctly mentioned, although, as argued, it is not all claimed. It is quite clear, upon principle and authority, as well as upon the former adjudication, that this re-issue is valid.

Upon the question of infringement, it appears that the defendants make use of as much of Leschot's invention as he would, in removing as much of the rock as he would remove, by cutting. By his method he would cut an annular hole and leave a core to be removed otherwise. They cut what would be the annular hole by the same means and in the same way. They have added, in the middle of their drill, enough similarly cutting material to cut away the core also, but they none the less cut away the rest by his method. This addition is an improvement, when it is not desirable to save the core, but Leschot's drill is made use of as a basis for the improvement, and the owners of the patent, as also held by Judge Shipman, in the former case, cannot be improved out of their right to it. The case, in this respect, is somewhat like *Electric Telegraph Co.* v. *Brett*, (4 *Eng. Law & Eq. R.*, 347.) That patent was for giving signals at distant places by means of electric currents sent through metallic circuits consisting of wires extending to the places and back. The defendants made use of the earth, to complete the circuits, in place of the returning wire, and claimed that this constituted the whole a different machine that was not an infringement. It was held, however, that they made use of so much of the patented invention as was involved in the wire which they did use and its operation, and they were made liable for that infringement.

It is stoutly insisted, in behalf of the defendants, that the invention was of, and the patent for, a mere tool, and not for any machine, combination or arrangement, and that the drill used by the defendants is a very different tool, especially in form and appearance. It is true, that the two do not, at first, look alike, but that is not by any means a full or accurate test. The outward form of them is not at all material. Their

operation and performances are what are important. In *Machine Co.* v. *Murphy*, (97 *U. S.*, 120,) Mr. Justice Clifford, in speaking of such a question, again said: "Except where form is of the essence of the invention, it has but little weight in the decision of such an issue, the correct rule being, that, in determining the question of infringement, the Court or jury, as the case may be, are not to judge about similarities or differences by the names of the things, but are to look at the machines, or their several devices or elements, in the light of what they do, or what office or function they perform, and how they perform it, and to find that one thing is substantially the same as another, if it performs substantially the same function, in substantially the same way, to obtain the same result, always bearing in mind, that devices in a patented machine are different, in the sense of the patent law, when they perform different functions, or in a different way, or produce a substantially different result. Nor is it safe to give much heed to the fact, that the corresponding device in two machines organized to accomplish the same result is different in shape or form, the one from the other, as it is necessary, in every such investigation, to look at the mode of operation or the way the device works, and at the result as well as at the means by which the result is attained. Inquiries of this kind are often attended with difficulty, but, if special attention is given to such portions of a given device as really do the work, so as not to give undue importance to other parts of the same which are only used as a convenient mode of constructing the entire device, the difficulty attending the investigation will be greatly diminished, if not entirely overcome."

Here, the thing invented and the device which the defendants use are parts of machines. The operative things which do the work are the diamonds which abrade the rock, and the water which carries off the detritus. The stock merely holds the diamonds in place upon itself and imparts its motion to them. In each machine the diamonds work with their forward faces, by having a rotary and progressive forward motion given to them by means of the stock; and, in each, the

water does its work by being injected through the stock and flowing out around it. The form of the stock is of no importance, further than to hold the diamonds and admit the flow, in and out, of the water. The flush stocks or heads do both of these precisely as the receding ones do. They, doubtless, hold the diamonds more firmly and better, because the diamonds are imbedded deeper in them, but not because they are held otherwise than by being imbedded in them. They cut more of the hole, but do it by the same means, operating in the same manner. The corresponding parts in each perform no different functions and produce no different results. It is quite plain, upon this comparison, in the light of the rule laid down in the case mentioned, that the defendants do make use of the patented invention, and thereby infringe upon the exclusive rights of the orator.

Let a decree be entered for an injunction and an account, according to the prayer of the bill.

Charles F. Blake, for the plaintiff.

E. J. Phelps and *W. G. Veazey*, for the defendants.

The New Orleans.

Where, in a suit *in rem*, in Admiralty, in the District Court, the claimant, after a decree for the libellant, appeals to this Court, and this Court decrees for the libellant for a sum sufficient to allow of an appeal by the claimant to the Supreme Court, which may be a supersedeas, no summary judgment can be rendered by this Court against the sureties in the appeal bond executed on the appeal to this Court, until after the expiration of ten days after the rendering of the decree by this Court.

(Before Blatchford, J., Southern District of New York, October 11th, 1879.)

BLATCHFORD, J. This is a suit in Admiralty. The District Court, on the 11th of June, 1877, rendered a decree that the libellants recover against the steamer, for damages, interest and costs, $16,505 65. The claimants of the steamer were John H. Clark, Samuel H. Seaman, Cornelius H. Delamater, John Baird and Alfred Moulton. The said claimants appealed from the said decree to this Court. On said appeal, the said Seaman, Clark and Delamater executed a bond to the libellants in the penalty of $18,000, with the condition that the obligation should be void, "if the above-named appellants shall prosecute said appeal with effect, and pay all damages and costs which shall be awarded against them as such appellants therein, if they shall fail to make said appeal good," and that otherwise said obligation should remain in full force and effect. The libellants appealed from other parts of the decree of the District Court. This Court, by a decree filed September 5th, 1879, affirmed in all things the said decree of the District Court, and ordered that the libellants recover against the steamer the damages ascertained by the decree of the District Court, namely, $15,904 98, and interest at the rate of 6 per cent. per annum, from June 11th, 1877, on $14,026 92, (being so much thereof as is exclusive of the interest allowed by the District Court,) and amounting to $1,866 67, being, in all, $17,771 65, and also the costs of the District Court, taxed at $690 67, and that the costs of this Court be divided and set off each against the other. The decree further provided as follows: "And it is further ordered, that, unless an appeal be taken from this decree within ten days after its entry, and service of a copy thereof, and security given on such appeal to stay execution, John H. Clark and Samuel H. Seaman, the stipulators for value of the said steamer, cause the engagements of their stipulations to be performed, or show cause, within four days after the expiration of such ten days, or on the first day of jurisdiction thereafter, why execution for the sum of $40,000, the amount of their said stipulation, should not issue against their goods, chattels and lands; and it is further ordered, that the same

persons cause their stipulations for costs to be performed, or show cause, in like manner, on the same day as aforesaid, why the like execution should not issue for the sum of $250; and it is further ordered, that John H. Clark, Samuel H. Seaman and Cornelius H. Delamater, the sureties of the claimants upon their said appeal, show cause at a Circuit Court to be held at the Court rooms, in the city of New York, on the 11th day of September, 1879, at the opening of Court, why a summary judgment should not be entered against them for the sum of $18,000, the amount of their said bond."

In accordance with the last of the foregoing provisions, the libellants have moved this Court, on the 11th of September, 1879, to enter a summary judgment against the said Clark, Seaman and Delamater, as sureties on said appeal bond, for the sum of $18,000. The said sureties oppose said motion, on the ground that the case is one in which an appeal can be taken by the claimants of the steamer to the Supreme Court of the United States, from so much of the decree of this Court as awards a recovery against the steamer, and that, therefore, the motion cannot be made until the expiration of ten days after the rendering of the decree. It is provided as follows, by § 1,007 of the Revised Statutes of the United States: "In any case where a writ of error may be a supersedeas, the defendant may obtain such supersedeas by serving the writ of error, by lodging a copy thereof for the adverse party in the clerk's office where the record remains, within sixty days, Sundays exclusive, after the rendering of the judgment complained of, and giving the security required by law on the issuing of the citation. But, if he desires to stay process on the judgment, he may, having served his writ of error as aforesaid, give the security required by law within sixty days after the rendition of such judgment, or afterwards, with the permission of a justice or judge of the appellate Court. And in such cases where a writ of error may be a supersedeas, executions shall not issue until the expiration of ten days." It is provided, by § 1,012, that appeals from the Circuit Courts "shall be subject to the same rules,

regulations and restrictions as are or may be prescribed by law in cases of writs of error." Section 997 provides for a citation, and § 1,000 provides, that the judge who signs a citation on a writ of error, shall "take good and sufficient security that the plaintiff in error or the appellant shall prosecute his writ or appeal to effect, and, if he fail to make his plea good, shall answer all damages and costs, where the writ is a supersedeas and stays execution, or all costs only, where it is not a supersedeas as aforesaid."

It is contended for the sureties, that proceedings against the sureties upon the appeal bond are collateral to and for the enforcement of the decree, and are no part of the decree; that, where an appeal may be a supersedeas, no proceedings against the sureties in the appeal bond can be taken so long as no proceedings can be taken to issue execution on the decree; and that the words "process on the judgment," in § 1,007, include the entry of judgment against the sureties in the appeal bond.

The condition of the appeal bond is, that the appellants shall pay the damages and costs which shall be awarded against them by this Court, as appellants, if they shall fail to make their appeal good. The appellants are not under obligation to pay the sum awarded against them by the decree until the time when execution can issue on the decree, which is not until the expiration of ten days after the rendering of the decree. The obligation of the sureties being an obligation only that the appellants shall pay when obliged to pay, cannot be enforced against them in any manner, even to the extent of the entry of judgment against them, until the obligation of the appellants to pay comes into force; and such obligation of the appellants does not, in a case like the present, where the appeal may be a supersedeas, come into force until the expiration of ten days after the rendering of the decree. This is a case in which an appeal lies to the Supreme Court and may be a supersedeas, if taken by the claimants, and where no execution could issue on the decree against the vessel prior to the time when the motion for judgment against the sureties

in the appeal bond was made. It follows, that the motion was prematurely made and must be denied.

Scudder & Carter, for the libellants.

Man & Parsons, for the sureties.

The Jesse Williamson, Jr.

Where, in a suit *in rem*, in Admiralty, in the District Court, the libellant, after a decree dismissing the libel, appeals to this Court, and this Court dismisses the libel, and the sum claimed in the libel is sufficient to allow of an appeal by the libellant to the Supreme Court, which may be a supersedeas, no summary judgment can be rendered by this Court against the sureties in the appeal bond executed on the appeal to this Court, until after the expiration of ten days after the rendering of the decree by this Court.

(Before Blatchford, J., Southern District of New York, October 11th, 1879.)

Blatchford, J. As the decree of this Court in this case dismisses the libel, and as the libellant, in his libel, claims damages to the amount of over $27,000, and as the District Court has dismissed the libel, it follows that this is a case in which the libellant can appeal to the Supreme Court and can have his appeal operate as a supersedeas and stay of execution. As the bond of the sureties on the appeal to this Court is, in its condition, the same as that in the case of *The New Orleans*, (*ante*, *p.* 216,) just decided, it follows, that the motion for judgment in this case against said sureties must be denied, for the reasons assigned in the decision in that case.

Benedict, Taft & Benedict, for the sureties.

Scudder & Carter, for the claimants.

The Blanche Page.

Where, in a suit *in rem*, in Admiralty, in the District Court, the claimant, after a decree for the libellant, appeals to this Court, and this Court decrees for the libellant for a sum not sufficient to allow of an appeal by the claimant to the Supreme Court, a summary judgment can be rendered at once by this Court against the sureties in the appeal bond executed on the appeal to this Court.

(Before Blatchford, J., Southern District of New York, October 11th, 1879.)

Blatchford, J. As this is not a case in which the claimants can appeal to the Supreme Court, there can be no supersedeas or stay of execution on the decree made by this Court against the vessel libelled. Hence, the claimants, as appellants to this Court, are obliged to pay at once the amount of such decree, and the obligation of the sureties in the appeal bond to this Court came into force without waiting for ten days to expire after the rendering of such decree. The motion for judgment against such sureties must, therefore, be granted.

Scudder & Carter, for the libellants.

Benedict, Taft & Benedict, for the sureties.

In the Matter of the Petition of the Norwich and New York Transportation Company.

A collision occurred between a steamboat and a schooner, caused by negligence on the part of the former, without any design, neglect, privity or knowledge of her owners. She immediately took fire, and burned and sank in deep water, the fire being caused by the collision. She had a cargo, being carried on freight, which was totally lost. None of her pending freight was earned or received. She was raised and repaired. After that she was libelled, in

Admiralty, in the District Court, by owners of part of the lost cargo. On a claim to her, she was appraised at $70,000, as her value after being raised and repaired, and she was released on a stipulation for that amount, purporting to be for the benefit of all persons having liens on her for losses by the collision. After decrees for the libellants, her owners petitioned the same District Court, for the benefit of a limitation of liability under the Act of March 3d, 1851, (9 *U. S. Stat. at Large*, 635.) That Court appraised her value, as she lay immediately after the collision and fire and before she was raised, at $2,500, and ordered that amount to be paid into Court. That was the value of the interest of the petitioners in her as she was immediately after the disaster. The value of that interest immediately before the collision was $70,000. At the time of the collision she was insured against fire and her owners received, on such insurance, over $49,000. She was not surrendered or transferred to a trustee: *Held*,

(1.) The value of the interest of the owner of the steamboat, to be taken, under said Act, is not the value of her and her freight before the collision;

(2.) The valuation of $70,000 is not to be taken as the measure of the liability of such owner;

(3.) Such measure is the value of the steamboat in the condition in which she was immediately after the disaster, and not her value after she was raised and repaired;

(4.) Such value in this case was $2,500, with nothing added for freight;

(5.) After the collision, the value of the steamboat was not greater before the fire than after it;

(6.) The proceeds of the fire insurance ought not to be added to the appraised value of the steamboat;

(7.) It was proper for the District Court to restrain the libellants in the suits *in rem* from further prosecuting those suits or suits against the stipulators for the $70,000.

(Before STRONG, J., Eastern District of New York, October 13th, 1879.)

THIS was a proceeding commenced in the District Court, by the Norwich and New York Transportation Company, as petitioners, to obtain the benefit of the provisions of the Act of Congress, approved March 3d, 1851, (9 *U. S. Stat. at Large*, 635,) providing for the limitation of the liability of ship owners. The decisions of the District Court in the matter are reported in 6 *Benedict*, 330, and 8 *Benedict*, 312. After those decisions, appeals were taken to this Court by several parties. This Court found the following facts: "On the morning of the 18th of April, 1866, a collision took place between the steamboat City of Norwich, then owned by the

petitioners, and the schooner General S. Van Vliet, then owned by William A. Wright and others. It occurred on Long Island Sound, nearly opposite Huntington, and it was caused by the negligence of the steamboat's officers or hands, without any design, neglect, privity or knowledge of her owners. Very soon, within half an hour, after the collision, the boat took fire, her deck and upper works were burned off, and she sank in about twenty fathoms of water. The fire was a direct consequence of the collision and inseparable from it. It was caused by the rushing of the water through the broken hull of the boat, whereby the fire was driven out of the furnaces upon the wood work, and the boat sank by reason of her filling with water. At the time of the disaster the boat had a cargo of merchandise on board, belonging to different freighters, all of which was totally lost. The freight then pending amounted to six hundred dollars, but none of it was earned, or received, by the ship owners. Sometime after the steamboat was sunk, and her cargo destroyed, as aforesaid, she was raised by salvors, taken to the Long Island shore, where she was repaired, and she was subsequently brought to the port of New York. On the 9th day of May, 1866, William A. Wright and others, the owners of the schooner, filed, in the District Court for the District of Connecticut, a libel against the petitioners, The Norwich and New York Transportation Company, the owners of the steamboat, to recover damages *in personam*, for the loss of the schooner and her cargo, caused by the collision. To this libel an answer was put in, denying any fault of the steamboat; and the respondents also preferred a claim to the benefits of the Act of Congress of March 3d, 1851, (9 *U. S. Stat. at Large*, 635,) limiting the liability of ship owners. On the 23d of April, 1867, a final decree was made by this Court, in favor of these libellants, adjudging to them and to the owners of the schooner's cargo the sum of $26,657 28. (1 *Benedict*, 156.) From this decree an appeal was taken to the Circuit Court, where it was affirmed, (8 *Blatchf. C. C. R.*, 14,) and it was subsequently affirmed by the Supreme Court of the United

States. (*Norwich Co.* v. *Wright*, 13 *Wallace*, 104.) The affirmance by the latter Court was at its December Term, 1871. On the 23d of August, 1866, while the suit in the District Court of Connecticut was pending, and after the steamboat had been raised, repaired and brought into the port of New York, George and Charles Place, two of the appellants, filed their libel *in rem* against her, in the Eastern District of New York, claiming as owners of part of her cargo. Other libels *in rem* were also filed at the suit of other owners of cargo. In due course the steamboat was seized by the marshal, and, the petitioners having intervened as claimants, an appraisement was ordered, and, a stipulation for the appraised value, in the sum of $70,000, having been given, the steamboat was released to them. (1 *Benedict*, 89.) The stipulation purported to be for the security not only of the Messrs. Place, but also for the benefit of all persons who might, by due proceedings in said Court, show themselves entitled to liens upon the vessel by reason of the said collision. The appraisement was of the value of the vessel as it was after she had been raised and repaired. It was returned into the Court on the 11th of March, 1867, and the stipulation in the amount of the appraisement was filed on the 29th day of the same month. On the 20th day of December, 1869, the District Court ordered decrees to be entered in favor of the libellants, in all the suits commenced against the steamer, as aforesaid. (3 *Benedict*, 575.) Such was the condition of the litigation when the present petition was filed, in July, 1872, after the rendition of the judgment by the Supreme Court, in the case of the libel of William A. Wright and others, in the District Court of Connecticut. The petition prayed, that, in conformity with the Act of Congress, the decision of the Supreme Court, and the Admiralty Rules made in pursuance thereof, (13 *Wallace*, xii,) the Court would cause an appraisement to be made of the value of the interest of the petitioners in the steamboat and her freight for the voyage in which she was employed, for which they were liable, and that an order should be made for paying the amount of such valuation into

Court, or for giving a stipulation therefor with sureties. It prayed, further, for a monition against all persons claiming damages arising out of the said collision and fire, citing them to appear and make proof of their claims, and it prayed, also, for a restraining order against the further prosecution of all or any suits against the steamboat or the petitioners, for any damages caused by the collision, fire and loss. There was, also, a prayer for general relief. The monition was issued, the appellants appeared, and an order was made for an appraisement of the amount of the value of the interest of the petitioners, as owners respectively of said steamboat and her freight pending for the voyage upon which she was employed, for which the petitioners were liable. A restraining order, as prayed for, was also made. Pursuant to the direction of the Court, (6 *Benedict*, 330,) an appraisement was made. The appraiser ascertained and reported the value of the steamboat as she lay immediately after the collision and fire, and before she was raised, to have been $2,500, and the District Court confirmed the report, (8 *Benedict*, 312,) and ordered the amount to be paid into the registry, which was accordingly done. The value of the interest of the petitioners in the steamboat, as she was immediately after the disaster, was $2,500, and no more. The value of that interest immediately before the collision was $70,000. When the collision occurred the steamboat was insured against fire, (not against marine disaster,) and upon the several policies the petitioners, as owners, have recovered from the underwriters the sum of $49,283 07. The steamboat itself has never been surrendered or transferred to a trustee for the persons injured by her fault."

J. W. C. Leveridge, for the Norwich and New York Transportation Co.

J. Langdon Ward and *Kittridge & Rice*, for owners of cargo.

R. H. Huntley, for William A. Wright and others.

STRONG, J. In *The Norwich and New York Transportation Company* v. *Wright*, (13 *Wall.*, 104,) a case in which these petitioners, and some of the appellants, were parties, the Act of Congress of March 3d, 1851, (9 *U. S. Stat. at Large*, 635,) entitled "An Act to limit the liability of ship owners, and for other purposes," was under consideration. Some things were then determined which I am not at liberty to disregard. Among them were the following: (1.) The Act adopts the rule of the general maritime law, as measuring the liability of ship owners for faults of the master, by which others are injured, and not the rules of the English statutes relating to the same subject; (2.) The rule is applicable to the claims of all persons injured by a collision, as well as to claims by freighters of cargo on the offending vessel; (3.) The present petitioners are entitled to the protection of the Act against the owners of the colliding schooner; (4.) They are not debarred by any laches of theirs; (5.) The District Court, sitting as a Court of Admiralty, has jurisdiction to administer the law. In that case, also, the proper mode of proceeding for obtaining the benefit of the Act was pointed out, and the course directed has been substantially followed in the present case. An appraisement of the steamboat has been made, under the direction of the District Court, and an apportionment has been ordered. The important question now, the question raised by these appeals, is, whether the sum to be apportioned has been correctly ascertained, and whether it is all that for which the petitioners, who are the owners of the steamboat, are liable.

The limit of liability prescribed by the Act of Congress is, that it shall in no case exceed the amount or value of the interest of the owner or owners in the offending ship or vessel, and her freight then pending. This presents the question—at what point of time is the value of the owner's interest to be taken? Is the measure of the owner's liability, or its maximum, the value of the ship and her freight before the injury was done? or the value at some time subsequent to the injury, when proceedings may be instituted to ascertain its

amount? or is it the value immediately after the fault has been committed, as, for example, in a case of collision, immediately following the destruction caused by it?

Very clearly, it is not the former. The English statutes restricting the liability of ship owners do not adopt the measure recognized by the general maritime law. They measure the extent to which the owners of an offending vessel are liable, by the value of that vessel immediately before the collision, adding the freight due, or to grow due, for and during the voyage; and they make no provision for the abandonment or surrender of the vessel. Such has been the construction given to them, first, by the Courts of common law and Chancery, and followed by the Courts of Admiralty. (*Brown* v. *Wilkinson*, 15 *M. & W.*, 391; *Wilson* v. *Dickson*, 2 *Barn. & Ald.*, 2; *Dobree* v. *Schroeder*, 6 *Sim.*, 291; *The Mary Caroline*, 3 *W. Rob.*, 101.) The English Courts have founded their judgments upon the statutes. They do not attempt to assert that such is the rule of the maritime law of the Continent. Indeed, in England, the general maritime law has never been adopted, in all its breadth.

But it is the rule of that law which is to be applied to this case. Even if it were not the rule in this country, without the aid of any statute, (upon which I express no opinion,) it is the rule which Congress has adopted and prescribed. By the maritime law, all that the sufferers by the misconduct of an offending vessel are entitled to is the vessel itself, after the injury has been committed, together with her freight. The liability of the owners is discharged by the surrender of the vessel and freight. Their loss, therefore, cannot exceed the value of the thing surrendered. What it may have been worth before the injury was committed is immaterial. Now, it is this measure of liability, recognized by the general maritime law, which the Act of Congress has adopted, instead of the English measure. It follows, necessarily, that the steamboat owners are not liable to the extent of the value of the vessel immediately before the collision. And such I under-

stand to have been the decision in the case to which I have referred, reported in 13 *Wallace*.

The appellants contend, however, that, conceding the value of the vessel is to be estimated as it was after the collision, the measure of the owners' liability is not the value *immediately* after the collision, but the value at a subsequent time, when the vessel, or its equivalent value, shall be delivered into Court by the owners, for the purpose of apportionment among the sufferers by its fault, or when, the vessel, or its value, being already in the custody of the Court, the owners, or the persons injured by it, shall take the proper proceedings for an apportionment.

The collision occurred on the 18th of April, 1866. After the steamboat was raised, repaired and brought into the port of New York, she was libelled and seized, at the suit of sundry owners of her cargo. Having been claimed by her owners, an appraisement was ordered by the District Court, and she was valued at $70,000, and released to her owners on their stipulating for that sum. This was in March, 1867, nearly a year after the collision. The appellants now insist that the sum ascertained to have been the value of the vessel at that time, by that appraisement, and then stipulated for, is to be taken as the measure of the owners' liability, and apportioned accordingly. To this I cannot assent. It is true, the present proceeding for an apportionment was not commenced until a later day; not, indeed, until the Supreme Court, by its decision and Rules, had pointed out the course to be pursued to obtain the protection of the Act of Congress. But, the owners had claimed their right to the statutory limitation, alike in the libel in *personam* in the District of Connecticut, and in the suits *in rem* in the Eastern District of New York, though the right had not been accorded to them. But, independently of this, I am of the opinion that the sum at which the steamboat was valued in March, 1867, is not the measure of her owners' liability in these proceedings for an apportionment. That appraisement was in proceedings that had no relation to the question as to what is the extent of the owners'

liability. Its purpose was to determine the value of the vessel at the time when she was seized, under the libels *in rem* filed by the freighters, and when she came into the custody of the Court, and was claimed by her owners. It would have been unnecessary if the owners had surrendered her, and the stipulation for her appraised value was to enable them to recover possession of her. It was taken under the general powers and usage of Admiralty Courts, and not under the Act of Congress or the Rules of the Supreme Court. Besides, the appraisement was one made of the value of the vessel at the time when she was seized by the marshal, after she had been raised at an expense of $22,500, and repaired at a cost of many thousand dollars more. It did not purport to be an estimate of her value at the time of the collision or immediately after. To hold that the owners are liable to the extent of that valuation, would be substantially to require them to surrender not only the ship and her freight, but also a sum of money equal to all they expended upon her in raising and repairs. Such, I think, would be a departure from the obvious meaning of the statute, and not required by the maritime law. Under that law, in cases of maritime abandonment, a seizure, or a judicial sale of the ship, if procured adversely to the owner, but without resistance by him, had no effect in determining the limit of his liability, and did not deprive him of his right to abandon, though the ship or its proceeds were thus brought within the jurisdiction of the Court. (*Pouget, Droit Mar., vol.* 2, *p.* 412; *Trib. of Commerce, Marseilles*, 1828; *Do., Aix*, 1825.) The stipulation for value given in March, 1867, cannot be said to estop the owners from showing what was the value of the vessel immediately after the collision. Nothing in it warrants such a construction.

I cannot doubt that the measure of liability recognized by the maritime law and by the Act of Congress is the value of the offending ship in the condition in which she was immediately after the disaster, adding the freight. Then the claims of the persons injured arose, the claims which the

statute limits. The extent of the limitation is not a shifting one, varying with the times when the protection of the Act may be sought, any more than it can be enlarged or diminished by the choice of the mode of obtaining that protection. Certain it is, that if, immediately after the collision, the steamboat owners had surrendered the vessel and freight, or transferred them to a trustee, they would have been discharged. Her value and her freight then pending were then all that they were liable for. That was then the extent of their loss. I cannot see how their liability can be increased by anything that may have occurred thereafter. It is the vessel as she then was that could have been transferred in satisfaction of all claims, if the owners had elected that mode of obtaining their discharge. And it is the value as it then was, which is the equivalent of the vessel, that might then have been paid in pursuance of an apportionment made by the Court. Had the vessel proceeded on her voyage after the collision, and had she met with a second disaster, occasioned by the fault of the master, by which her value had been greatly reduced, could she then have been surrendered or transferred, in full satisfaction of the claims against her, or her owners, arising out of her first fault? Would her value after the second disaster have been the measure of the owners' liability? I cannot think such a position can be maintained. Surely, such is not the spirit of the statute. And, if not, it seems equally plain, that the liability of the owners is not enlarged by the fact that, after the collision, the boat has been raised and repaired by them, at large expense, or, in other words, has increased in value. It may, perhaps, be conceded, that if, after the vessel was raised and repaired, the owners had sought the protection of the statutory limitation, by transferring her to a trustee, the creditors would have been entitled to her as she then was, in her improved condition. This, not because her value then was the value for which they were, at all events, responsible, but by force of the transfer. But they have made no such transfer. They never offered to make one. They elected the other course of proceeding allowed to them by the law. They

retained the vessel, and asked the Court for an apportionment of the amount for which they were liable. To hold them now to the value of the vessel when she had been repaired, would practically deny to them the advantages of that election which the statute accords to them.

It is to be observed, that the Act of Congress not only adopts the maritime rule or measure of limitation, but it prescribes two modes, in either of which the ship owners may secure the benefits of the rule. The measure of liability and the modes allowed for obtaining the limitation are not to be confounded. One of the modes is the transfer by the owners of the vessel in fault, with her pending freight, to a trustee for those who may be legally entitled thereto. This is substantially the course pursued under the maritime law. The other is an apportionment by the proper Court, on their petition, of the sum for which they are liable, among the parties entitled thereto, when the whole value of the vessel and her freight for the voyage is not sufficient to make compensation to each of them. In other words, the liability of the owners is discharged, either by transferring the vessel and freight, or by paying their equivalent, that is, the value of what they might have transferred in discharge, according to the apportionment of the Court. The owners have their option of these two modes. They may give up the vessel and freight, or they may retain them and pay their value. But, the measure or limit of liability in each case is the same. Very plainly, it is not intended that the creditors shall obtain more when one mode of proceeding is adopted than when the other is followed. But, as I have said, all that the owners are required to transfer is the ship in her damaged condition, as she was immediately after the injury was inflicted. Equivalent to that is her value at that time.

I am, therefore, of opinion, that the District Court was correct in determining that the value of the steamboat immediately after the collision and fire, as she then was, lying at the bottom of the Sound, together with her pending freight, is the extreme measure of the owners' liability, and is the

amount to be apportioned. That value has been ascertained to have been $2,500, and I see no reason to doubt the correctness of the appraisement. It is true, that sum is the value of the vessel alone, without any thing added for freight. But, no freight was earned. Six hundred dollars was the amount pending at the time of the collision, but it was of no value. Had the owners selected the other mode of discharging their liability—that of surrendering or transferring the vessel and freight to a trustee—the fact that there had been six hundred dollars of freight pending would have been of no importance. The value of the subject transferred would have been only that of the vessel, the same as that which the District Court fixed for apportionment. The transfer of the freight would have been the transfer of a valueless thing. And, as I have said, the measure of liability is the same, whether the vessel and freight be transferred, or whether their value be paid into Court for apportionment. In neither case do the owners have more at risk than their sea venture. I think, therefore, the owners are not answerable to any extent for freight wholly lost, though it was pending at the time of the collision, for it had no value immediately after.

It was suggested, though not pressed, during the argument before me, that, even if the value of the steamboat in the condition in which she was directly after the collision is the maximum of the owners' liability, the appraisement should have been made of her value in the interval between the collision and the fire. But, if this were conceded, the result must have been the same. Plainly, the vessel was worth no more then than she was after she had sunk. She was then a vessel inevitably doomed to partial destruction by fire, and to immediate foundering. The fire was as much a part of the original disaster as was the breaking of the hull by the impingement of the schooner, and so was the sinking. It is impossible to separate them. By the collision, the hull of the steamboat was stoven, and water poured in, driving the fire out of the furnaces into contact with the woodwork, which was mostly destroyed before the hull had sufficiently

filled to cause it to sink. Now, had the owners transferred to a trustee the boat, at the instant after she came into contact with the schooner, and before the water had risen within her sufficiently to drive her fires out from the furnaces, confessedly, they would have been discharged. But, what would the trustee for the sufferers, the owners of the schooner and the freighters, have taken? Surely, only a vessel in process of destruction by fire, and destined to sink. She would then have been worth no more than she was at the bottom of the Sound, and that value the sufferers have now, under the appraisement that was made. Besides, a transfer could not have been made before the fire, because no trustee could have been appointed by any Court.

I come, then, to the more important question, whether the proceeds of the fire insurance should have been added to the appraised value of the steamboat. At the time of the collision her owners had policies insuring her against fire, upon which they have recovered the sum of $49,283 07; and it is strenuously insisted, that the sum thus recovered should be added to the value of the boat and brought into the apportionment. This presents again the question—what is the limit of the liability of ship owners, defined by the maritime law, and adopted by the Act of Congress? As I have said, the sum to be paid into Court for apportionment is the equivalent of what would pass to the trustee by a transfer under the statute. In substance, then, the question is this—according to the rule of the maritime law, or the Act of Congress, (which is the same,) does the limit of the owners' liability extend, beyond the vessel and her freight, to the insurance which may be upon her at the time of the disaster? The language of the statute is, "it shall be deemed a sufficient compliance with the requirements of this Act, on the part of such owner or owners, if he or they shall transfer his or their interest in such vessel and freight, for the benefit of such claimants, to a trustee to be appointed by any Court of competent jurisdiction, to act as such trustee for the person or persons who may prove to be legally entitled thereto, from and after which

transfer all claims and proceedings against the owner or owners shall cease." The subject to be surrendered is the interest of the owners in the vessel and freight. Not a word is said of transfer of insurance. A transfer of property insured is not, "*ex proprio vigore*," a transfer of policies of insurance thereon. Generally, indeed, it avoids the policies. It seems to have been held, in *Lynch* v. *Dalzell*, (4 *Bro. P. R.*, 432.) that insurances against fire do not attach on the realty, or in any manner go with the same, as incident thereto, by any conveyance or assignment, but they are only special agreements with the persons insuring against such loss or damage as they shall sustain. There is nothing in the Act of Congress to indicate that the transfer of the interest of the owner to a trustee was intended to have any different effect from that of an ordinary transfer of personal property, which neither in law nor in equity carries with it insurance, or any collateral contract. It seems to me, therefore, that, were I to hold that the owners are responsible, not only to the extent of the value of the vessel and her freight, but also for the insurance collected, I should, in effect, interpolate in the statute words which Congress refrained from using, and extend the liability beyond the limits prescribed.

I do not feel the force of the suggestion, that, because the statute declares that the liability of the owner "shall in no case exceed the amount or value of the interest of such owner in such vessel" and her freight then pending, instead of declaring that it shall not exceed the value of the vessel and freight, something beyond the value of the vessel and freight, such as insurance, may have been intended; first, because a policy of insurance is no interest in the thing insured; and, secondly, because the words of the statute are plainly not designed to enlarge liability, but have, for their purpose, making provision for part owners of offending vessels. Instead of holding a part owner liable to the extent of the whole value of the vessel, they limit his liability to the value of his interest or share, leaving the other owners liable to the extent

of the value of their shares. I cannot doubt such is the meaning of the statute.

There is nothing, then, in the Act of Congress, that extends the liability of the owners beyond that existing under the general maritime rule, and by that rule there seems to be no room for doubt that the liability does not extend to the surrender of insurance upon the abandoned vessel. Upon this subject the Continental authorities are substantially in unison. Indeed, I have been able to find no one that asserts the rule is otherwise. Only one intimates an opinion to the contrary. I do not propose to quote these authorities at length. Copious reference was made to them by the learned judge of the District Court, and I shall not repeat what he has said. His citations from *Caumont*, (*Dictionnaire de Droit Maritime, title, Abandon Maritime*, §§ 54, 55,) from the *Code de Commerce* and from *Pouget*, (*Droit Maritime, vol.* 2, 415, 419,) are quite sufficient to show what the maritime measure of liability was, and long had been, when our Act of Congress was enacted, and to establish that it did not extend to insurance upon the abandoned vessel. I may add a quotation from *Boulay Paty*, and one or two other sources. In his *vol.* 1, *p.* 297, *Boulay Paty* says: "The product of the insurance is the price of the premium which the ship owner has paid to insure the ship. This premium is not bound as a security for the debts and obligations of the captain. The law expressly binds only the ship and the freight to that. The Code of Commerce gives to shippers a lien only on ship and freight; consequently, they have none on the insurance. In general, the ship is not represented by the insurance, which, after the loss of the ship, becomes a right existing by itself, which gives a direct personal action in favor of the insured." "All these principles, besides, agree with equity and with the well understood interests of commerce." He says more to the same effect, and refers to *Valin* as sustaining him. So, in *De Villenevee et Massé, Dictionnaire du Contentieux Commercial*, word *Armateur*, 20, it is said: "The surrender of the ship and freight does not extend to the insur-

ance which the owner has put upon the ship." Other similar authorities might be cited. The subject has not been passed without debate. In 1841, an effort was made in the Chamber of Peers to amend the rule, so to make it require a surrender of the insurance procured by the owner, besides the ship and freight, in order to exonerate the owner. The proposition was much debated, but it was voted down. (*Bédarride, du Com. Mar., vol.* 1, 359.) It was then declared, that, by the Code of Commerce, the ship owner is not required to bring in the insurance money, when he makes the maritime abandonment. Now it was in view of this rule limiting liability, and intending to adopt it, that the Act of Congress of 1851 was enacted, as was held by the Supreme Court in the case reported in 13 *Wallace.* The purpose of the Act was to extend to American ship owners the benefits which the general maritime law gave, viz., to limit their liability as it was limited by that law. I find nothing in the Act to enlarge the measure of liability. In the case in 13 *Wallace*, the Court was not called upon to consider or decide whether the proceeds of insurance must be transferred, or accounted for, in addition to the vessel and freight. The question was not before the Court, and it was not decided. Nor does *Pardessus* assert, as the doctrine of the maritime law, that insurance as well as vessel and freight must be abandoned to the freighters; certainly, not in the later editions of his work. At most he says, he had brought himself "to the belief, that, if the ship was insured, the creditors to whom the surrender was made would have the right to demand the amount of the insurance," for a reason, which he gives, that appears to me to be quite unsatisfactory. But he does not claim that such a right has ever been acknowledged, (*Droit Commercial, ed.* 1841;) and, as I have said, I find no Continental authority that recognizes it. I am, therefore, of opinion, that the petitioners in this case, who were the owners of the steamboat, are not bound to pay into the registry of the Court the sum they received for insurance. I may add, that, after reflection, I am unable to perceive that the proceeds of fire insurance are

any more liable for the claims of the creditors than those of marine would be.

Of the remaining questions presented by these appeals not much need be said. The appellants urge that they should not be restrained from the further prosecution of their suits against the steamboat, or against the stipulators for value in those cases. They argue, that, in the proceedings *in rem* the personal liability of the petitioners is not involved, and that the Act of Congress does not apply to such proceedings. The position thus taken cannot be sustained. It rests upon a very narrow view of the statute. A limitation of the liability of the owner of property is a limitation of resort to his property, at the suit of his creditors. Let it be conceded that the freighters had a lien upon the vessel. Yet, where the liability of its owner is discharged, the lien is gone. No liability can rest upon the vessel which does not exist against the owner. (*The Druid*, 1 *W. Robinson*, 398, 399.) It would be a strange anomaly, and one which would defeat the object of the Act of Congress, if, after an owner of a vessel had taken all the steps required to release him from liability, his property, that is to say, his vessel, should still remain liable to the claim from which he had been discharged. Neither the statute, nor the 54th and 57th Rules in Admiralty, justify such a conclusion. A suit *in rem* is, in a very proper sense, a suit against the owner of the thing, even though he may be unknown, and may, in fact, have no knowledge of the suit. And especially is this true, when, as in the present case, the owner appears in the suit and claims the thing attached.

I have only to add, that the taxation of costs, to which some of the appellants object, appears to me to have been correct.

It must be admitted, that the appellants recover a very inadequate compensation for the injuries they have sustained. On the other hand, the injuries were inflicted without any "privity or knowledge" of the owners, by the fault of the master of the steamboat, who remains liable to the fullest extent. And the Act of Congress limiting the liability of the

owners, together with the proceedings under it, rest upon a public policy recognized throughout the commercial world, the policy of encouraging investments in ships, by limiting the liability of the owners for wrongs done by the master, to the value of the sea venture.

The decree of the District Court is affirmed.

THE UNITED STATES *vs.* CHARLES ANDERSON.

An indictment purporting to be founded on § 5,346 of the Revised Statutes, charging the commission of an assault with a dangerous weapon, on board a vessel belonging in whole or in part to a citizen of the United States, alleged the assault to have taken place "in the harbor of Guantanamo, in the Island of Cuba," but did not allege that that place was out of the jurisdiction of any State of the United States: *Held*, upon the authority of *United States* v. *Jackelow*, (1 *Black*, 484,) that the indictment was bad, for want of such allegation.

(Before BENEDICT, J., Southern District of New York, October 13th, 1879.)

BENEDICT, J. This case comes before the Court upon a motion to quash the indictment. The offence intended to be charged in the indictment is that enacted by § 5,346 of the Revised Statutes of the United States, where it is provided: "Every person who, upon the high seas, or in any arm of the sea, or in any river, haven, creek, basin or bay within the Admiralty jurisdiction of the United States, and out of the jurisdiction of any particular State, on board any vessel belonging in whole or in part to the United States, or any citizen thereof, with a dangerous weapon, or with intent to perpetrate any felony, commits an assault on another, shall be punished by a fine of not more than three thousand dollars, and by imprisonment at hard labor not more than three years." The act charged is an assault with a dangerous weapon on board the brig Sarah and Emma, a vessel belong-

ing in whole or in part to a citizen of the United States, in the harbor of Guantanamo, in the Island of Cuba, on waters within the Admiralty jurisdiction of the United States. The objection taken to this indictment is, that it contains no averment that the place where the offence is said to have been committed is out of the jurisdiction of any of the States of the Union. In the case of *United States* v. *Jackelow*, (1 *Black*, 484,) it was held by the Supreme Court of the United States, that the question whether a particular place be out of the jurisdiction of any State, when material in determining the extent of the jurisdiction of a Court, is a question of fact, to be passed on by the jury; and, in that case, the Supreme Court set aside a special verdict which found the offence to have been committed in waters adjoining the State of Connecticut, between Norwalk harbor and Westchester County in the State of New York, at a point five miles eastward of Lyons' Point, (which is the boundary between the States of New York and Connecticut,) and one mile and a half from the Connecticut shore at low water mark, upon the ground, that, in the absence of a finding by the jury that the place so described was out of the jurisdiction of any State, it was impossible for the Court to determine such to be the fact. If it was not competent for the Supreme Court, from such a description of the place as was given in *Jackelow's Case*, to say that the Court had jurisdiction to try the offender, certainly, it will not be competent for this Court to say that it has jurisdiction to try the defendant for an offence committed "in the harbor of Guantanamo, in the Island of Cuba." There may be an island called Cuba within the jurisdiction of some of the States of the Union, and, for all that is stated in this indictment, therefore, the place described may be within the jurisdiction of such State. If, as the Supreme Court held in the case referred to, the question whether a certain place is out of the jurisdiction of a State be a question of fact, to be determined by the jury, then the fact must be averred and proved. No such averment is contained in this indictment, and, upon the authority of the

Supreme Court of the United States, the omission must be held to be fatal.

The motion to quash the indictment is granted.

William P. Fiero, (*Assistant District Attorney*,) for the United States.

Benjamin B. Foster, for the defendant.

ANDREW J. SMITH *vs.* THE TOWN OF ONTARIO.

After the Court has heard and denied a motion for a new trial, in a suit at law, and a judgment has been rendered and paid and satisfied, it has no power to grant leave to re-argue the motion for a new trial,

The decision in *Smith* v. *The Town of Ontario*, (15 *Blatchf. C. C. R.*, 267,) commented on.

(Before WHEELER, J., Northern District of New York, October 23d, 1879.)

WHEELER, J. This is a motion for leave to re-argue a motion for a new trial made after a verdict for the defendant at June Term, 1877, and heard and denied as of June Term, 1878. (15 *Blatchf. C. C. R.*, 267.) The principal grounds upon which this motion is made are, as alleged, that there were material differences between the case as drawn up and printed, on which the former motion was heard, and the case as actually tried, and that the decision upon the former motion, while professing to follow, was contrary to, the decisions of this Court upon the same questions, when held by resident judges. It is opposed upon the ground that it is made out of time, and upon its merits.

The action was brought upon coupons to the amount of $525, from bonds issued in aid of the Lake Ontario Shore Railroad, under a special law of the State of New York, passed April 19th, 1869, (*Laws of New York, of* 1869, *chap.*

241.) The case was made to turn upon the sufficiency of the affidavit of the assessors to prove consent to issuing the bonds, required by the Act before the bonds should be issued. By the printed case on which the motion for a new trial was heard, it appeared that some of the consents were filed in the county clerk's office on different days from others in December, 1870, and the affidavit in that month, without showing on what day of the month; and, in the decision of the case, stress was laid upon this diversity of filing, as showing that the affidavit was not so connected with the consents as to be helped out by their contents. On production now of the papers used at the trial, it appears that the affidavit and consents were each filed separately, and then all together as one roll, on the 23d day of that December, and that at some time they were all tied together. This does not seem to vary the case much from what it appeared to be before. The point was, that, although the affidavit showed that consent to something had been given, it did not show to what; and that, not referring or being attached to any consent, it could not be gathered that the affidavit meant that consent had been given to what was contained in the consents. The fact that the affidavit and consents were filed together as one roll, and attached together, would, standing alone, have some tendency to show that the affidavit, made after the consents, was made with reference to them, as was held by Blatchford, J., in *Phelps* v. *Lewiston*, (15 *Blatchf. C. C. R.*, 131). But, when it appears that each paper was before filed separately, as if it came from different sources from the others, this tendency is done away with. If any other facts existed, tending to show that the affidavit was made with reference to the consents produced, they were not shown.

It is true, that the Court professedly intended to follow the former decisions of the Court, all of which had been made by resident judges, so far as appeared, in like cases. But, up to the time when the decision upon the motion for a new trial was made, no former case was produced, which, in its facts, appeared to be like this. It was not expected that

this case would be decided for the plaintiff because all actions upon such bonds or coupons had been so decided, nor because all actions upon such bonds or coupons in aid of the same road, or issued by the same town, had been; nor was it expected that an ambulatory decision, which would follow such as might thereafter be made, was to be rendered. It now appears, that cases like this upon their essential facts have been decided in favor of the plaintiffs, but no opinion has yet been produced in which any judge has discussed the sufficiency of any affidavit like this standing by itself, nor holding that the production of an affidavit is not necessary in order to recover upon such bonds or coupons. Such affidavits have been held to be sufficient, but upon what grounds they have been so held, and whether those grounds would be applicable to this case as it was in fact presented at the trial, has not yet been made clearly to appear. The motion was considered upon what was in fact proved, and not upon what might have been proved at the trial.

But, the motion was denied, judgment for the defendant, to recover its costs, was rendered on the verdict, and the costs appear to have been paid and the judgment satisfied, before this motion was filed. So, there is no motion to be re-argued, pending anywhere, in this case. The question might be re-argued, but there would be nothing to be decided thereupon, if this motion for leave to re-argue should be granted. After the decision was made, the Court might at any time during the same term have, for good cause, changed it. And this might have been done at any time afterwards, while the matter was still depending in Court. (*Harris* v. *Hardeman*, 14 *How.*, 334.) But, here, the term had ended and another intervened, and the whole matter had ceased to be depending anywhere long before this motion was filed. It was not filed in any cause, for there was no such cause depending; and granting it would be wholly unavailing. Courts frequently, or sometimes, overrule former decisions upon the same question, and decide it differently in new cases; but the former judgments, nevertheless, stand. (*Hepburn* v. *Griswold*, 8

Wall., 603; *Legal Tender Cases*, 12 *Wall.*, 457.) It would not be practicable, nor tolerable, for Courts to go back and change all judgments, to make them conform to every change of opinion of the Court, held by different or even the same judges. There is no doubt but that Courts have power, after cases therein have been ended, on direct application for that purpose by one party and service upon the other, to bring forward causes and correct the judgments therein; but, when so done, the corrected judgments are entered as of the time when the corrections are made, and in causes brought forward and made to be again pending between the parties. Here, no attempt is made to bring forward the cause. The application is not at all for that purpose, nor adequate to that end. It is based upon the supposition, that now the Court can take up the motion for a new trial, and decide it over again. If now, then it might for a long time hereafter, and the judgments of Courts, instead of ending litigation absolutely with reference to matters litigated, would end it only at the satisfaction of all parties, or the pleasure of the judges.

The cause was tried as the parties chose to present it, was heard on a motion for a new trial, in due course, and decided upon grounds satisfactory to the Court as then constituted. This proceeding does not appear to be adequate to disturb the judgment. The motion is denied.

Albertus Perry, for the plaintiff.

William F. Cogswell, for the defendant.

JAMES SARGENT

vs.

THE YALE LOCK MANUFACTURING COMPANY. IN EQUITY.

Reduction of prices and consequent loss of profits, caused to a patantee by the competition of an infringer, is a proper ground for awarding damages against the infringer.

In this case, on the evidence, it was held, that the reduction of prices by the plaintiff on safe locks containing his patented invention, was directly and solely caused by the defendant's infringement, after allowing a proper sum for any other patented device contained in the defendant's locks, and for any other causes which gave to the defendant an advantage in selling his locks.

The plaintiff, as owner of the patent, was held to be entitled to recover the damages, although he might be accountable to a copartner for a part of them, as the copartner could not sue for them.

(Before BLATCHFORD, J., Southern District of New York, October 29th, 1879.)

BLATCHFORD, J. The master reports, that there is no basis, from the proofs adduced before him, to find what profits have been made by the defendant by the use of the "turning bolt," (the infringing device,) in the locks made and sold by it; and that, therefore, on the testimony before him, he cannot find what profits, if any, are due from the defendant for the use of the "turning bolt."

The patent on which this suit is brought is a re-issue granted January 2d, 1872. The master reports that, after that time, and in 1873, in consequence of the defendant's offering and selling to the plaintiff's principal customers, and to the trade generally, locks containing the infringing device, at a less price than the plaintiff was obtaining, a reduction of prices was enforced on the plaintiff, such reduction being, in round numbers, $1 on each No. 5 lock, and $2 on each No. 3 lock. Exception one of the defendant is to such finding and report, and alleges that the master should have re-

ported that no such reduction was enforced, and that there was no proof of the amount of any reduction caused by the defendant's infringement, and that there was no method of computing such reduction, even if it actually existed.

The master also reports, that it is in evidence, that, during the period covered by the accounting, the plaintiff could have manufactured, in addition to the locks he did manufacture, and without materially increasing his manufacturing facilities, all the locks manufactured and sold by the defendant. Exception two of the defendant is to such finding and report, and alleges that the master should have reported that no such additional manufacture by the plaintiff was possible, or that it was impossible without a very great extension of his facilities.

The master also reports, that it is in evidence, that, during the period covered by the accounting, the plaintiff would have made sales to many of the persons who were induced to purchase from the defendant, at his own established prices, had not the defendant offered its locks at lower prices. Exception three of the defendant is to that part of the report, and alleges that the master should have found and reported that no such sales would have been made, or that, even if made, they would not have been at the plaintiff's own established prices.

The master also reports, that the plaintiff has suffered damage in respect to the matters to which exceptions two and three relate. Exception four of the defendant is to that part of the report, and alleges that the master should have found and reported no damage whatever from the competition of the defendant.

The master further reports, that the locks sold by the defendant contained, in addition to the "turning bolt," a device patented by the Rosner patent, for which infringement a claim is made against the defendant, in another suit; that, as to the proportion of the reduction of prices above set forth, which should be allowed to the device claimed under the Rosner patent, it is claimed by the plaintiff, and nowhere

effectually disputed by the defendant, "that, in computing the profits on these locks, one-third belonged to and was charged by him to the Rosner patent;" and that, admitting this proportion, and allowing, in addition thereto, for any superior external attractions of the defendant's locks, and for the number of combinations which they had over those of the plaintiff, and for the shape of the case of the lock, and for the commercial success of the defendant in effecting sales, where the plaintiff would have failed, the master is of opinion that the plaintiff is entitled to recover from the defendant, as damages, one-half of the amount of the reduction in prices caused by the defendant since January 2d, 1872, that is, on 1,009 No. 3 locks, $1 per lock, being $1,009, and on 13,524 No. 5 locks, at 50c. per lock, $6,762, being a total of $7,771. Exception five of the defendant excepts to the finding and report, that the plaintiff is entitled to recover from the defendant, as damages, one-half of the amount of the reduction in prices caused by the defendant since January 2d, 1872, and alleges that the master should have reported "no reduction in prices, or no proof of such," caused by any infringement by the defendant since said date, and "hence no damages" to the plaintiff, "and, consequently, no method of calculating them." Exception six of the defendant excepts to the report for that the master erred in making the apportionment of the alleged reduction in the plaintiff's prices, charging one-half thereof to the alleged infringement of the "turning bolt" patent, and alleges that no basis existed, in the proof or in law, for such or for any apportionment, or for any award of damages. Exception seven of the defendant excepts to the report for that the master erred in assessing damages which are not the damages suffered by the plaintiff, but are those suffered by the firm of Sargent & Greenleaf, and alleges that the master should have reported, that the damage, if any, found to have been suffered by said firm, is not the damage of the plaintiff, who is only one member of said firm, but that the plaintiff's damage is merely a portion thereof. Exception eight of the defendant excepts

to the report for that the master erred in finding and reporting, as damages, the sum mentioned in his report, or any damages whatsoever, and in not reporting that there was no proof of any actual damage suffered by the plaintiff from the alleged infringement.

The defendant contends that the competition of the defendant was not the sole cause of the reduction of the plaintiff's prices, and that the proportionate effect of the defendant's competition is not attempted to be estimated or ascertained by the proofs. It alleges that the defendant is not responsible for the reduction made in 1873; that there were many other causes which contributed to this reduction; and that the lowering of prices was caused principally by the competition of other fire-proof safe lock makers, and, notably, the New Britain Lock Co., by the fact that safe makers were making and threatening to make their own safe locks, and by the general lowering of the prices of material and labor and the depression of business. Reduction of prices and consequent loss of profits, enforced by infringing competition, is a proper ground for awarding damages. The only question is as to the character and sufficiency of the evidence, in the particular case. I think, that, on the whole evidence, the reduction of prices by the plaintiff, after January 2d, 1872, on safe locks containing his invention, is shown to have been directly and solely caused by the defendant's infringement.

The master, in his report, allows damages only for the reduction of prices on the locks sold by the plaintiff, that is, 1,009 No. 3 locks and 13,524 No. 5 locks. Although the master states that the plaintiff suffered damage in losing the sale of locks sold by the defendant, he awards no damages for that cause. He confines his award to the loss on the locks which the plaintiff sold.

The defendant also contends, that the plaintiff is not entitled to recover from the defendant, as damages, the entire amount of the reduction enforced by the defendant's competition, but only the damages occasioned by the effect of the presence of the infringement; that the burden of proof is

on the plaintiff to fix the value of, and to separate the effect of, the infringing devices; that he failed to do so by any proper proof; and that no basis was afforded to the master on which such damages could be computed. But, as the master allowed damages only for the reduction of prices on the locks sold by the plaintiff, and as the essential feature of those locks was the "turning bolt" device, and as an essential feature of the infringing locks was the infringing "turning bolt" device in them, and as the plaintiff could not sell his "turning bolt" device unless it was embodied in a lock, and as he was thereby enabled to make his profit on the entire lock, and as he was deprived, by the acts of the defendant in selling at low prices locks containing the patented "turning bolt" device, of the profit he would otherwise have made on the locks which he actually sold containing the "turning bolt" device, it seems plain that the defendant's infringement must be held to have caused the entire loss of the plaintiff by the reduction of prices, after allowing a proper sum for any other patented device contained in the defendant's locks and for any other causes which gave to the defendant an advantage in selling its locks. This is the basis on which the master proceeded, and it seems to me, on a consideration of the evidence, that the master has made all proper allowances and has arrived at a correct conclusion in fixing, as damages, one-half of the amount of reduction in prices.

The plaintiff, as the owner of the patent, is entitled to recover the damages in this case. He may be accountable to his copartner for a part of them, but the copartner could not sue, on the patent, for such damages or any part of them.

Exceptions 2, 3 and 4 are overruled, as immaterial. The other exceptions are overruled on the merits.

Edmund Wetmore and *George T. Curtis*, for the plaintiff.

Frederic H. Betts, for the defendant.

JAMES SARGENT

vs.

THE YALE LOCK MANUFACTURING COMPANY. IN EQUITY.

The interlocutory decree in a suit in equity for the infringement of a patent, referred it to a master to take an account of the plaintiff's damages and of the defendant's profits. The master reported that there were no damages and no profits, but that the plaintiff was entitled to a compensation for the use of his patent by the defendant. It appeared that the use of the patent restored the salable character of the article the defendant made, and thus saved the defendant from loss: *Held*, that the money value of such advantage could be recovered, as compensation.

Opinions and estimates as to such value are not competent evidence.

The amount paid by the defendant for a license to use another patented invention, which he used after he ceased to infringe the plaintiff's patent and in substitution for the plaintiff's device, was held to be the proper measure of the value of the invention to the defendant.

(Before BLATCHFORD, J., Southern District of New York, October 29th, 1879.)

BLATCHFORD, J. By the interlocutory decree in this case, it was referred to the master "to ascertain, and take and state and report to the Court, an account of the damage sustained by the complainant, and of the gains, profits and advantages which the said defendant has received, or which have arisen or accrued to it, since the 4th day of January, 1870, from infringing the said exclusive rights of the complainant by the manufacture, use or sale of the said improvements set forth and described in said letters patent."

The master reports, that, in the summer of 1869, the plaintiff had picked a lock of the defendant's in a safe; that this made it necessary to discover a device to protect such lock; that the plaintiff then invented, for such purpose, the device covered by the patent in suit; that this accounting is upon such patent; that the device so patented was of no use or benefit to the plaintiff in the manufacture of his own

locks, and was of no use or benefit to any manufacturers of locks other than the defendant; that the plaintiff never parted with his patent, or any interest in it, or granted any license under it; that it is not a question of damages, for the plaintiff did not make, or sell, or license others to use, his invention; that it is not a question of profits, because none have been shown, as such; and that it is a question of compensation to the plaintiff, for the benefit derived by the defendant from the use of his invention. The master then sets forth, that a witness, Munger, estimated the value of the plaintiff's device to the defendant at $10 per lock, for the double dial and No. 2 locks, and $5 for No. 3; and he also sets forth the testimony of a witness, Cady, as to the value of the plaintiff's device to the defendant; and he adds, that the testimony of those two witnesses does not form a basis upon which the master can make a computation of the money value of the device, which the defendant should pay to the plaintiff, it being the opinion and estimate only of those witnesses. The master then proceeds to say: "The defendant, however, offers a method for calculating the value of Sargent's device; for, in 1872, it abandoned the use of Sargent's invention, and adopted the devices claimed in a patent granted to Emory Stockwell, dated July 25th, 1871, and for which it pays royalty as follows: On the double-dial lock, per lock, $1; on the No. 1, (old No. 2,) 75 cents; on the No. 3, 50 cents. It is fair to believe, that the patentee, Stockwell, in accepting these royalties, was induced thereto by other considerations than the actual value of his invention. He had been, for a long time prior to his invention, was then, and still is, in the employment of the defendant company. His time, paid for by the company, had been frequently employed in experimenting for its benefit. His relations with, and continued employment by, the defendant company, must have controlled the bargain made with it for its use of his said invention. What value or what amount should be added to the royalty paid Stockwell, to represent these considerations? We have two factors, one known, *i. e.*, the money value paid Stockwell;

the other unknown, *i. e.*, the consideration inducing Stockwell to accept the same. Judge McKennan, of the Third Circuit, in his opinion on the coming in of the master's report, in the case of *Witherill* v. *The New Jersey Zinc Company*, said, in substance, that, where there were two factors, the value or proportion of one of which was known, and the other unknown, and which coöperated with each other, they must necessarily be treated as co-equal in their contribution to the joint result. Following this principle, I am of the opinion, that, to the royalties paid to Stockwell, (a known factor,) there should be added an equal amount to represent the considerations (an unknown factor) which caused him to accept those royalties, to determine the fair value of his (Stockwell's) invention. As the defendant company used the invention of the complainant until the discovery of Stockwell, it seems equitable to allow complainant, for the use of his patented device, an amount equal to the value, above shown, of Stockwell's subsequent invention, during the period his device was used by the defendant. I, therefore, find, that the complainant should recover from the defendant company, as follows: On 250 double-dial locks, $2 per lock, $500; on 31 No. 1 locks, $1 50 per lock, $46 50; on 255 No. 3 locks, $1 per lock, $255; total, $801 50."

The plaintiff excepts to the finding of the master, that the testimony of the witnesses Munger and Cady does not form a basis upon which the master can make a computation of the money value of the device, which the defendant should pay to the plaintiff, for the reason that the estimate and opinion of experts is competent evidence of value in cases like the present. The plaintiff also excepts, in that the master bases his finding of the amount due the plaintiff on the royalty allowed Emory Stockwell, and the circumstance of Stockwell's employment by the defendant, as set forth in the report, and does not take into consideration not only the said circumstance, but the opinions of the witnesses Munger and Cady, and the other circumstantial evidence in the case relating to the requirements of the market, the effect of the plaintiff's picking

of the defendant's lock, the impossibility of substituting any other device, except the patented device, to serve the same purpose, during the period when said patented device was used by the defendant, and all the other evidence introduced by the plaintiff. The plaintiff also excepts to the finding of the master, that the compensation due to the plaintiff is $801 50, for the aforesaid reason, and because it is calculated without taking into consideration all the evidence and circumstances tending to prove and establish the actual amount due from the defendant to the plaintiff.

The defendant excepts to the finding and report of the master awarding any "compensation" to the plaintiff, because the master had reported that the plaintiff "did not suffer any damage," and that no profits on the part of the defendant were shown, and because the interlocutory decree only authorized the master to assess damages and take an account of profits, and the master had no jurisdiction or power to estimate, find or report what he deemed a compensation to the plaintiff. The defendant also excepts because the master reports that any compensation to the plaintiff could be measured by the amount of royalty paid by the defendant to Stockwell for the use of his patented device. It also excepts to so much of the report as states that any amount or value should be added to the royalty paid to Stockwell; and to so much of the report as states that there were any considerations inducing Stockwell to accept the royalty specified as paid to him, other than the mere payment thereof; and to the finding, that the plaintiff should recover from the defendant the sum reported, or any sum.

The master was right in reporting a compensation to the plaintiff. Such compensation was either damages to the plaintiff or advantage to the defendant. It was the value of the use of the invention to the defendant. The defendant's lock became unsalable, and the use of the plaintiff's patented device restored its salable character. By using such device the defendant was saved from loss. This was an advantage

which, on proper evidence, may be measured by a money value, and recovered. (*Cawood Patent*, 4 *Otto*, 695, 710.)

I think the master was right in rejecting the estimate of the witness Munger, and the general evidence of the witness Cady. I also think, that, under the circumstances of this case, the proper measure of the value of the invention to the defendant was the amount it paid Stockwell for a license under his patent, and that there is no sufficient ground, in the evidence, for adding anything to that amount. The amount of the plaintiff's recovery must be limited to $400 75. The plaintiff's exceptions are disallowed. Exceptions one, two and five of the defendant are disallowed, and exceptions three and four of the defendant are allowed.

Edmund Wetmore and *George T. Curtis*, for the plaintiff.

Frederic H. Betts, for the defendant.

HALBERT S. GREENLEAF

vs.

THE YALE LOCK MANUFACTURING COMPANY. IN EQUITY.

In this case, the report of the master as to the amount of damages sustained by the plaintiff, by the infringement of his patent, was set aside, on the ground that what he had reported as an established license fee was not shown to have been such.

(Before BLATCHFORD, J., Southern District of New York, October 29th, 1879.)

BLATCHFORD, J. The accounting in this case relates to the infringement of the first claim of the plaintiff's patent, in making and selling safe locks, and of the fourth claim, in making and selling bank locks. The master says: "The com-

plainant has successfully prosecuted infringers of these claims, and, in one case, for infringement of the fourth claim, in the manufacture and sale of bank locks, a settlement was arrived at, and the infringer, one George Damon, of Boston, was licensed at $20 per lock. Several suits against infringers of the first or 'key-changing tumbler' claim of this patent were also successfully prosecuted by complainant and settlement obtained. One of such infringers, Timothy J. Sullivan, of Albany, after settlement for past infringement, was granted a license under this patent and the patent granted to Lyman F. Munger, known as the Munger patent wheel, owned, or owned in part, by complainant, at a license fee of $500 per year for the privilege of making 75 locks per year, that is, $6 66 per lock, and, if he manufactured more than 75 locks in a year, he was to pay $10 per lock. Of the licenses granted by complainant under this and the Munger patent, two-thirds of the royalty received was allowed to the Munger patent and one-third to the Rosner patent, on which this suit is brought. Under this division of royalty, the license fee on bank locks, for the use of the Rosner patent, would be $6 66 per lock; and on the fire-proof safe locks, taking the smaller license fee of $500 a year, for 75 locks, $2 22 per lock. These licenses form, in my opinion, under the decision of the Supreme Court in *Burdell* v. *Denig*, (2 *Otto*, 716, 719,) the measure of damages which the complainant is entitled to recover from the defendant for its infringement of this patent. I, therefore, find that the complainant should recover from the defendant the sum of $6 66 per lock on 536 bank locks, $3,569 76, and $2 22 on 2,999 fire proof safe locks, $6,657 78 —in all, $10,227 54."

The defendant excepts to the finding that the settlements arrived at with Damon and Sullivan, or either of them, were any measure of the damages which the plaintiff should recover from the defendant, whereas the master should have reported that no established license fee was shown to have existed for the use of the plaintiff's invention, and that the damages could not be ascertained by reference to any license fee

or settlement. The defendant also excepts to the report because the master reports the sum assessed as damages, notwithstanding the fact that the master has not found or reported that the plaintiff had any established license fee or fees for the use of the patented invention, and notwithstanding the fact that it was conceded that the settlements upon which his finding was based were exceptional cases, unlike, and inapplicable to, the case, or the situation and condition, of the defendant, and notwithstanding the fact that the plaintiff himself testified that he had no established license fee and never intended to establish one, and notwithstanding the fact that the alleged settlements on which the said finding is based were manifestly inapplicable to the case of the defendant, or any rule of damage. It further excepts to the report for that the rule and amount of damage derived from following the exceptional settlements upon which it is based, give to the plaintiff more than his actual damage; and for that the prices and amounts imposed upon the defendant, by following said exceptional settlements, are plainly extravagant and ruinous, and more than the actual damage of the plaintiff, and impossible to have been realized or received by the plaintiff as license fees from such a business as the defendant's, and impossible to have been paid in the course of business by the defendant; and for that the master erred in reporting that the sum of $10,227 54, or any other sum, should be recovered by the plaintiff from the defendant; and for that the master erred in not reporting that no profits and no damages were shown.

I think that the defendant's exceptions must be allowed and the report be set aside, and the case be referred back to the master, for further consideration and report, either with or without additional evidence, as he may determine. The evidence does not show that any established license fee was proved in respect to either of the devices. The report is not on the basis of profits. It is on the basis of damages. The amount awarded seems to me to exceed the actual damage, on any fair view of the case. The views set forth in *Black* v. *Munson*, (14 *Blatchf. C. C. R.*, 265,) show, that, on the evi-

dence in this case, no fixed and established license fee can be held to have been proved by the plaintiff, or any fee which can be properly taken as a measure of the actual damage sustained by the plaintiff.

Edmund Wetmore and *George T. Curtis*, for the plaintiff.

Frederic H. Betts, for the defendant.

OLIVER S. GARRETSON

vs.

CHARLES B. CLARK AND OTHERS. IN EQUITY.

An allowance is not proper, in a bill of costs, in this Court, of a solicitor's fee for an overruled exception to a master's report, because, under Rule 84, in Equity, no standing rule has ever been made by this Court on the subject, and because no allowance for such fee is found in § 824 of the Revised Statutes of the United States.

(Before BLATCHFORD, J., Northern District of New York, October 30th, 1879.)

BLATCHFORD, J. In this case the Court overruled all the exceptions taken by the plaintiff to the master's report, and awarded costs to the defendants for all proceedings upon the reference to the master and subsequent thereto. (15 *Blatchf. C. C. R.*, 70.) In the bill of costs presented by the defendants to the clerk for taxation, there was a charge of $25 for each of the exceptions overruled. The clerk declined to tax such charge. The defendants now move for an order directing the clerk to allow and tax, as a part of the defendants' costs, the sum of $25 for each of said exceptions, or such other sum therefor as shall seem reasonable and just.

In March, 1842, the Supreme Court promulgated Rule 84,

of the Rules of Practice for the Courts of Equity of the United States, in the following words: "And in order to prevent exceptions to reports from being filed for frivolous causes, or for mere delay, the party whose exceptions are overruled shall, for every exception overruled, pay costs to the other party, and for every exception allowed shall be entitled to costs, the costs to be fixed in each case by the Court, by a standing Rule of the Circuit Court." No standing Rule of this Court has ever been made on this subject. There is no authority for this Court to impose any costs in this case, under Rule 84, except in pursuance of a standing Rule, previously made. Moreover, under section 823 of the Revised Statutes of the United States, which is a re-enactment of a provision in section 1 of the Act of February 26th, 1853, (10 *U. S. Stat. at Large*, 161,) no other compensation to attorneys and solicitors in the United States Courts can be taxed and allowed against a party to a cause than that prescribed by statute. No specific allowance of a solicitor's fee in respect of exceptions overruled is prescribed by statute, and, therefore, none can be allowed. The only fees or compensation which can be taxed in this case in favor of the defendants are what is found specifically set forth in section 824 of the Revised Statutes or some other statutory provision.

The motion is, therefore, denied.

James A. Allen, for the plaintiff.

F. A. Macomber, for the defendants.

The United States *vs.* David J. Nagle and others.

The fact that an indictment against a person has been quashed because of insufficient averments is no ground for quashing an information subsequently filed by the District Attorney against the same person for the same offence.

It is no objection to an information filed in open Court by the sworn assistant of the District Attorney, that the signature of the District Attorney to the information was written by such assistant by virtue of a general authority conferred upon him by the District Attorney.

(Before Benedict, J., Southern District of New York, November 3d, 1879.)

Benedict, J. The fact that these same defendants were indicted by the Grand Jury for the same offence described in this information, which indictment was quashed because of insufficient averments, affords no ground whatever upon which to ask that this information be quashed. The District Attorney had the right to proceed by information notwithstanding the fact that, on a former occasion, he had elected to proceed by indictment and had submitted the case to the consideration of a Grand Jury.

It is no objection to an information filed in open Court by the sworn assistant of the District Attorney, that the signature of the District Attorney attached to the information was written by such assistant, by virtue of a general authority conferred upon him by the District Attorney.

The motion to quash the information is denied.

Sutherland Tenney, (*Assistant District Attorney*,) for the United States.

Augustus F. Bays, for the defendant.

THEODORE M. DAVIS, AS RECEIVER OF THE OCEAN NATIONAL BANK IN THE CITY OF NEW YORK, PLAINTIFF IN ERROR

vs.

CALVIN A. STEVENS, AS EXECUTOR OF CALVIN STEVENS, DECEASED, DEFENDANT IN ERROR.

A purchaser of stock in a national bank, who, to conceal his ownership and escape individual responsibility, causes it to be transferred to another person pecuniarily irresponsible, is, so long as he remains the actual owner, a shareholder, within the meaning of § 12 of the Act of June 3d, 1864, (13 *U. S. Stat. at Large*, 102,) now §§ 5,139 and 5,151 of the Revised Statutes of the United States, and liable as such.

(Before WAITE, Ch. J., Southern District of New York, November 5th, 1879.)

WAITE, Ch. J. This was a suit at law by the receiver of an insolvent national bank to enforce the individual liability of an alleged shareholder, under section 5,151 of the Revised Statutes. The bank failed December 12th, 1871, and it is conceded that Calvin Stevens, the decedent, did not then appear on the books as a shareholder, and had not appeared as such since October 29th, 1870. On that day one hundred and seventeen shares stood in his name, which he caused to be transferred to one Elston, an irresponsible person, and a porter in the office of his New York broker. At the time of this transfer, so far as appears from the evidence, there was no suspicion of the insolvency of the bank, and it remained in good credit for more than a year afterwards. Subsequently, Stevens made other purchases of the stock of the bank and sometimes made sales. His purchases were put to the credit of Elston on the stock books, and, to meet his sales, he, acting as the agent of Elston, under a power of attorney for that purpose, caused the necessary transfers to be made from the same account. On the 22d of November, 1871, there stood

to the credit of Elston, on the books, one hundred and sixty-one shares, for which a formal certificate was issued in his name, and delivered to Stevens, as his agent. It did not appear, from the testimony, that any of the shares which once stood in Stevens' name were included in this certificate. The account on the books remained unchanged from that time until the failure.

Upon this state of facts, the Court below directed a verdict in favor of the defendant; and the single question now presented is, whether that was right. For all the purposes of this inquiry it must be assumed, that, as between Stevens and Elston, Stevens was the real owner of the stock. Clearly, the evidence tended to prove that fact, and there was enough to make it wrong to take the question from the jury. There is no pretense that Elston did not give his assent to the transfer to him on the books. This made him liable as a shareholder. (*Upton* v. *Tribilcock*, 91 *U. S.*, 48; *Webster* v. *Upton*, *Id.*, 65; *Pullman* v. *Upton*, 96 *U. S.*, 328.) The point to be decided now is, whether, in an action at law, by a receiver of the bank, the real owner of stock in a national bank, standing, by his procurement, in the name of another, and never having been in his own name on the books, can be charged, as a shareholder, with the statutory liability for debts.

The banking Act, (Act of June 3d, 1864, 13 *U. S. Stat. at Large*, 106, *sec.* 6, now *Rev. Stat.*, *sec.* 5,134,) provides, that the certificate of organization shall specify, among other things, "the names and places of residence of the shareholders, and the number of shares held by each of them." Section 12 of the original Act is as follows: "That the capital stock of any association formed under this Act shall be divided into shares of one hundred dollars each, and be deemed personal property, and transferable on the books of the association in such manner as may be prescribed in the by-laws or articles of association; and every person becoming a shareholder by such transfer shall, in proportion to his shares, succeed to all the rights and liabilities of the prior holder of such shares, and no change shall be made in the articles of associa-

tion by which the rights, remedies or security of the existing creditors of the association shall be impaired. The shareholders of each association formed under the provisions of this Act * * * shall be held individually responsible, equally and ratably, and not one for another, for all contracts, debts, and engagements of such association, to the extent of the amount of their stock therein at the par value thereof, in addition to the amount invested in such shares; * * *" In the Revised Statutes these provisions are separated and reproduced as sections 5,139 and 5,151, but, for the purposes of construction, they are to be considered together. (*Rev. Stat., sec.* 5,600.) Section 63 of the original Act, (now *Rev. Stat., sec.* 5,152,) provides, "that persons holding stock as executors, administrators, guardians and trustees shall not be personally subject to any liabilities as stockholders; but the estates and funds in their hands shall be liable in like manner and to the same extent as the testator, intestate, ward, or person interested in said trust funds would be, if they were respectively living and competent to act and hold the stock in their own names." Section 40, (now *Rev. Stat., sec.* 5,210,) requires, that a full and correct list of the names and residences of all the shareholders shall be at all times kept in the office where the business of the association is transacted, subject to the inspection of shareholders and creditors, and that a verified copy of this list must be transmitted to the Comptroller of the Currency.

Under these provisions of the law, it is contended, that the registered shareholders alone can be charged with the statutory liability, and that an assignee of stock does not make himself responsible unless he accepts an actual transfer in his own name on the books. As has just been seen, the registered holder is liable. By holding himself out to the world as owner, as he does when he permits his name to appear to that effect on the books kept for the information of shareholders and creditors, he estops himself from denying that he is in fact what he represents himself to be. The question still remains, however, whether the person for whom

the registered owner holds the stock, if actually the owner, may not also be liable.

The Supreme Court, at its last term, held, in *National Bank* v. *Case*, (99 *U. S.*, 628,) that if a registered owner transferred his stock in a failing corporation to an irresponsible person, for the mere purpose of escaping liability, or if his transfer was colorable only, the transaction was void as against creditors. At the same time, in *Case* v. *Marchand*, (not reported,) an effort was made to charge Marchand with liability as the real owner of stock standing in the name of one Lubie, the allegation being that Marchand, having bought the stock from one Keenan, caused it to be transferred to Lubie, for the purpose of concealing his ownership and avoiding liability under the Act of Congress. The Court decided the case on the ground that the evidence was not sufficient to show the actual ownership of Marchand, but there is nowhere an intimation that, if the facts had been as alleged, the action might not be sustained.

The present case shows that Stevens bought the stock from registered owners, and took assignments of their certificates, with authority to complete the transfers on the books. As between Stevens and the vendors this made Stevens the owner. At that time the vendors could have registered their transfers, and thus, while relieving themselves from liability, charged Stevens. (*Webster* v. *Upton*, 91 *U. S.*, 65.) If Stevens had omitted to register the transfer, and on that account his vendors had been compelled, as registered owners, to respond to their statutory liabilities for debts, I cannot think there would be a doubt of their right to call upon him to reimburse them for the money so paid. The reason is obvious. While the vendors were the registered owners, Stevens was the actual "shareholder," and the money paid by the vendors would have been for his use and recoverable from him as such.

Stevens, by his transfers on the books, undoubtedly released his vendors from all future liability, because, as to them, the transfers were "out and out," in the language of the English cases, and not colorable only. They retained no interest whatever, and Elston, the registered transferee, al-

though pecuniarily irresponsible, was capable in law of assuming the obligations of a shareholder. As between Stevens and Elston, however, Stevens was the real owner, and Elston his authorized representative in the bank. As such representative, Elston could vote the stock at elections and receive and receipt for dividends. So, too, he could sell and transfer the stock on the books, and such sale and transfer to a *bona fide* purchaser would pass the title, free from any claim of Stevens. Neither would the bank, under ordinary circumstances, be liable to Stevens for permitting the transfer to be made. So far as Elston was concerned, the transfer to him was colorable only; and it is apparent that the only object Stevens had in causing it to be made was to conceal his ownership, and thus, if possible, escape all statutory liability. Such being the case, I am unable to see how he can occupy any different position from what he would if the stock had been taken directly from his own name on the books and put in that of Elston. He is still the real owner, with Elston as his agent specially authorized to hold for him the legal title. Every principal is responsible for the obligations of his agency. The debt of the agent is the debt of the principal, and always recoverable from the principal. By the rules of law which govern the relation of principal and agent, the registry on the books in the name of Elston was, as between Stevens and Elston, in legal effect, the same as a registry in the name of Stevens. The obligations which Elston assumed by reason of such registry were the obligations of Stevens.

Assuming, then, as I must, for the purposes of this case, that the facts were as they are claimed by the plaintiff to have been, I cannot reach any other conclusion than that Stevens, the decedent, was, in law, a "shareholder" of the bank at the time of its failure, and, as such, liable in this action. It was error, therefore, to direct a verdict for the defendant.

The judgment of the District Court is reversed, and the cause remanded for a new trial.

John E. Parsons, for the plaintiff in error.

C. W. Bangs, for the defendant in error.

SUSAN HAMILTON

vs.

GILBERT J. KINGSBURY AND GEORGE T. DAVIS. IN EQUITY.

Three instruments relating to rights under letters patent, and none of them purporting to grant anything more than a license, were executed between the same parties contemporaneously and as parts of the same transaction. One of them was recorded in the Patent Office and the other two were not. A person having purchased the right covered by the recorded instrument, *bona fide*, and without notice of the unrecorded instruments: *Held*,

(1.) That the recorded instrument was one not required by § 11 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 121,) to be recorded;

(2.) That the unrecorded instruments were not required by that statute to be recorded;

(3.) That the instruments were all of them valid as against such purchaser, without being recorded;

(4.) That such purchaser acquired no greater rights than were conveyed by all three of the instruments, construed together.

(Before BLATCHFORD, J., Northern District of New York, November 7th, 1879.)

BLATCHFORD, J. This suit is brought on letters patent granted to Palmer Hamilton, December 5th, 1865, for "improvements in saw mills." The bill alleges infringement by the defendants by making, constructing, using and vending to others to be used, machines containing the patented invention. Palmer Hamilton, by an instrument in writing executed August 1st, 1866, conveyed to Milton A. Hamilton and to his legal representatives all the right, title and interest which he, the said Palmer Hamilton, had in the patented invention "as it was, or might be, applied to muley or single upright mill saws." This instrument was recorded in the Patent Office August 27th, 1866.

By an instrument in writing executed August 27th, 1866, and recorded in the Patent Office October 15th, 1866, and which recited the said conveyance from Palmer Hamilton to

Milton A. Hamilton as being one of all the right, title and interest of Palmer Hamilton in and to the invention "as it is or may be applied to muley or single upright mill saws," Milton A. Hamilton conveyed to Clinton A. Lombard and John Thompson, as copartners, under the name and style of Lombard & Thompson, "and to their legal representatives, the full and exclusive right to use and to sell to be used the said saw hangings," (the invention patented being stated in said conveyance to be known as "Hamilton's oscillating and reciprocating saw hangings,") "as they are or may be applied to muley or single upright mill saws, as secured by the said letters patent, for, to and in the State of New York, I excepting and reserving the right to manufacture the said invention for myself and legal representatives." On the same 27th of August, 1866, and at the same time, a written agreement was executed between Milton A. Hamilton of the first part and Lombard and Thompson, as copartners under the name of Lombard & Thompson, of the second part, which contained the following language: "The party of the first part, in consideration of the conditions hereinafter named, to be kept and performed by the party of the second part, hereby agrees to furnish as many sets of 'Hamilton's patent oscillating and reciprocating saw hangings' as they may use or sell to be used in the State of New York, as they are or may be applied to single or upright muley mill saws, as secured by letters patent from the United States, the said party of the second part having the right to use and sell the said patent saw hangings according to a deed of assignment bearing even date herewith, upon which this article is based, and to deliver the said machinery; * * * the said party of the second part agrees to pay to the party of the first part sums of money for the said machinery according to the following prices and rates; * * * and the said party of the second part further agrees that they will not manufacture the said machinery or its parts so long as they are supplied by the said party of the first part, as above specified, or by his legal representatives; and, further, it is understood and

agreed that the said second party is not to sell the said machinery to be used in any other than the said State of New York." This instrument was never recorded in the Patent Office. On the same 27th of August, 1866, and at the same time, Milton A. Hamilton executed and delivered to Lombard & Thompson an instrument in writing, which recited that they had purchased and paid him for certain rights in "Hamilton's patent oscillating and reciprocating saw hangings," and referred to the said patent, and then proceeded thus: "and whereas I, Milton A. Hamilton, have also given them, the said Lombard & Thompson, a certain contract, bearing even date herewith, for the supply of the said saw hangings, I reserving for myself and legal representatives the right to manufacture the said hangings, now this indenture witnesseth, that, in case I, or my legal representatives, are unable, from any circumstance or emergency, to furnish the said Lombard & Thompson saw hangings according to the above-mentioned contract, I, for myself and legal representatives, agree that the said Lombard & Thompson shall have the right to manufacture the said hangings for use in the State of New York. The purport of this article is to secure to them the said machinery against failure on my part to fulfil the conditions of the said contract, which, being fulfilled, this is to be null and void; otherwise, to be in effect." This instrument was never recorded in the Patent Office.

Lombard & Thompson, by an instrument in writing, executed April 29th, 1868, and recorded in the Patent Office August 7th, 1868, conveyed to Robert P. Russell, Montgomery Reese and the firm of Strong & Woodbury, in equal shares of one-third each, "all the right, title and interest which we have in the said invention, as secured to us by said letters patent, for, to and in the State of New York." Reese, by an instrument in writing executed July 18th, 1868, and recorded in the Patent Office August 7th, 1868, conveyed to Russell and the firm of Strong & Woodbury, in equal shares of one-half each, "all the right, title and interest which I have in the said invention, as secured to me by said letters

patent, for, to and in the State of New York." Strong and Woodbury, by an instrument in writing executed December 10th, 1869, conveyed to the defendants in this suit "all our right, title and interest therein, as secured by the letters patent and assignment before-mentioned, which consists of the right, title and interest of the said Robert P. Russell, Henry A. Strong and Edmund F. Woodbury to the right for the whole State of New York, except one-half interest held by Robert P. Russell, and the counties of Cayuga and Franklin, previously assigned to John Busby and Sidney A. Paddock, respectively."

The bill alleges, that Milton A. Hamilton, by an instrument dated March 20th, 1867, and duly recorded in the Patent Office, conveyed to Palmer Hamilton all his right, title and interest in and to the said patent and invention; and that the recorded conveyance from Milton A. Hamilton to Lombard and Thompson was not intended by the parties thereto to convey to Lombard and Thompson any right to manufacture said invention, and that the practical construction placed upon said instrument by the acts of said parties at the time of the execution thereof and subsequently, was, that the sole right to manufacture said invention remained in said Hamilton. It also sets forth the two unrecorded instruments of August 27th, 1866, and avers that ever since the three instruments were executed the said Milton A. Hamilton and his assignee have been at all times and now are ready and willing to furnish such saw hangings to said Lombard and Thompson and to their assigns, and did so furnish such saw hangings to said Lombard and Thompson, and that the defendants have not applied to the said Milton A. Hamilton or to his assigns to be furnished with such saw hangings, but have assumed to manufacture the same themselves; that Palmer Hamilton, by an instrument dated April 18th, 1873, and recorded in the Patent Office, assigned to the plaintiff all the right, title and interest of him, the said Palmer Hamilton, in and to said invention, and also all rights of action for infringements of said patent which had accrued to him, the

said Palmer Hamilton; and that she is the sole owner of said invention.

The defendants have filed a plea to the whole bill. It sets up the conveyance of August 1st, 1866, from Palmer Hamilton to Milton A. Hamilton, the recorded conveyance of August 27th, 1866, from Milton A. Hamilton to Lombard and Thompson, the conveyance of April 29th, 1868, from Lombard and Thompson to Russell, Reese and Strong & Woodbury, the conveyance of July 15th, 1868, from Reese to Russell and Strong & Woodbury, and the conveyance of December 19th, 1866, from Strong and Woodbury to the defendants. It then avers, that the defendants "never made, contributed or used, or vended to others to be used, any machine or machines, containing the invention of said Palmer Hamilton, described in the letters patent in said bill of complaint mentioned, or any part of such invention, prior to the time of the execution of the said assignment from Strong & Woodbury to them, as above-mentioned, excepting that, within a year prior to the time of said assignment, they manufactured for said Strong & Woodbury, and at their request, a small number of said machines, the exact number they cannot state, and that, since the time of the execution of the said assignment, these defendants have neither made, constructed or used, or vended to others to be used, any machine or machines containing the said invention, or any part thereof, excepting that they have made, constructed and vended to others to be used muley and single upright mill saws, containing said invention, or some part thereof, within the State of New York, and not elsewhere, and not in the counties of Cayuga and Franklin in the said State, as they lawfully might, in pursuance of the authority given them by virtue of the several assignments above-mentioned." The plea further alleges, that the instrument of March 20th, 1867, from Milton A. Hamilton to Palmer Hamilton, was not recorded in the Patent Office until after the time when the defendants made the purchase from Strong & Woodbury, and received from them the assignment above-

mentioned; that the defendants never had any notice of such assignment from Milton A. Hamilton to Palmer Hamilton, until after the commencement of this suit; that the defendants made the purchase from Strong & Woodbury, and received from them the assignment above-mentioned, and paid them therefor, in good faith, the consideration of one thousand dollars therein expressed, without any knowledge or notice that any such assignment as that from Milton A. Hamilton, above-mentioned, then or ever existed, and in the full belief that the said assignment from Strong & Woodbury gave to the defendants a perfect title to such interest in said patent as it purported to convey. The plea further alleges, that the defendants have no knowledge or information as to what was intended by the parties to the assignment from Milton A. Hamilton to Lombard & Thompson, save such as is derived from the language of said assignment, and no knowledge or information of the practical construction put upon said assignment by the acts of the parties, at or subsequent to the time of the execution thereof, save such as is derived from the bill, and no knowledge or information, save such as is derived from the bill, that Milton A. Hamilton ever entered into two or any contracts, as mentioned in the bill, or any other contract of any kind, except the assignment to Lombard & Thompson, and that they never heard of said two contracts, or had any notice thereof, until they learned of the mention thereof in the bill.

The plaintiff put in a replication to the plea, and proofs have been taken and the case has been heard thereon. The bill above-mentioned is an amended bill. The suit was before the Court on the original bill and a plea thereto, at the June Term, 1878. (*Hamilton* v. *Kingsbury*, 15 *Blatchf. C. C. R.*, 64.)

The pleadings then brought before the Court all the instruments now before it, except the two unrecorded instruments of August 27th, 1866. The question then presented for consideration was solely as to the construction of the recorded conveyance of August 27th, 1866, from Milton A.

Hamilton to Lombard & Thompson. The Court held, that, under and by that conveyance, Lombard & Thompson acquired the right to make, as well as the right to use and to sell to be used, "the said saw hangings, as they are or may be applied to muley or single upright mill saws, as secured by the said letters patent, for, to and in the State of New York," such right to use and to sell to be used being exclusive, but the grantor reserving to himself a right to make in common with the grantees. The plea was allowed.

On the present pleadings and the proofs thereunder it is contended for the plaintiff, that, under the three instruments of August 27th, 1866, taken together, Lombard & Thompson acquired no right to make the invention, except in a certain contingency, which has never happened; that the three instruments are contemporaneous and are all portions of the same transaction, and must all be read together to determine the intent of the parties to the transaction; that those three instruments are consistent with no intention other than the one set up in the bill; that, if the recorded conveyance of August 27th, 1866, gives to Lombard & Thompson the right to manufacture, the other two instruments have no meaning; and that the instruments are (1) a license, which, in terms, gives the licensees no power to manufacture; (2) an agreement, by which the licensor agrees to furnish the hangings to the licensees at fixed prices, and the licensees agree that they will not manufacture so long as the licensor keeps his agreement; (3) a permission from the licensor to the licensees to manufacture, in case the licensor fails to perform his agreement.

It seems plain that the three instruments, taken together, must have the interpretation claimed for them by the plaintiff. But, the defendants contend that they are *bona fide* purchasers, without notice of any instrument but the recorded conveyance of August 27th, 1866, and that they are protected from any unrecorded agreement between Milton A. Hamilton and Lombard & Thompson, in the absence of any actual notice thereof.

The recording Act in force when the defendants took their conveyance from Strong & Woodbury, on the 10th of December, 1869, was section 11 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 121,) which provided, "that every patent shall be assignable in law, either as to the whole interest, or any undivided part thereof, by any instrument in writing, which assignment, and also every grant and conveyance of the exclusive right under any patent, to make and use, and to grant to others to make and use, the thing patented, within and throughout any specified part or portion of the United States, shall be recorded in the Patent Office within three months from the execution thereof." It is well settled, that mere licenses, or contracts conferring the limited and not the exclusive right to exercise some of the privileges secured by the patent, are not the subjects of regulation by this statute, and that it relates solely to grants or conveyances of the exclusive right, or legal estate, vested in the patentee, which leave no interest in the patentee for the particular territory and the particular right to which they relate. (*Curtis on Patents, 3d ed.*, § 179.) Within this rule, the recorded conveyance of August 27th, 1866, from Milton A. Hamilton to Lombard & Thompson, is not an assignment of the whole interest in the patent, or of any undivided part thereof, nor is it a grant or conveyance of the exclusive right, under the patent, to make and use, and to grant to others to make and use, the thing patented, within and throughout any specified part or portion of the United States. It is only a license. It reserves to the grantor "the right to manufacture the said invention." Whatever right to manufacture the grantees acquired by the face of it, such right was not exclusive in them. Therefore, such in strument was not one required to be recorded. Nor were the other two instruments of August 27th, 1866, instruments which it was necessary to record. The recording of the instrument of August 27th, 1866, which was recorded, was not notice to the defendants that they could safely rely on the record, as showing the whole transaction between the parties to the instrument in respect to its subject-matter. The three instruments

were all of them valid, without recording, as against the defendants, although *bona fide* purchasers without actual notice. Although the recorded instrument of August 27th, 1866, may, on its face, convey the right to make to the grantees, seeing it on the record is of no more avail to the defendants than if they had seen it out of the record. The existence of the three instruments, taken together, as limiting the right of Lombard & Thompson, affects the defendants with the consequences of such limitation, for they can have no greater right than Lombard & Thompson had.

The plea is overruled, with costs to the plaintiff to be taxed, with leave to the defendants to answer, on payment of such costs, within 30 days after service of a copy of the order to be entered on this decision.

A. C. Coxe, for the plaintiff.

W. F. Cogswell and *George B. Selden*, for the defendants.

JOHN S. PERRY, TRUSTEE, &c.

vs.

DENNIS G. LITTLEFIELD AND THE LITTLEFIELD STOVE MANUFACTURING COMPANY. IN EQUITY.

The decision of the Supreme Court, in *Littlefield* v. *Perry*, (21 *Wallace*, 205,) construed.

The invention covered by the claim of the letters patent re-issued to Dennis G. Littlefield, May 31st, 1870, for an "improvement in the mode of hinging covers to stoves, tea kettles and other open-topped vessels," on the surrender of the original letters patent granted to said Littlefield, March 13th, 1866, namely, "A détachable cover and its seat, respectively provided with a pin and an opening, so constructed as to engage or lock with each other, for the purpose of hinging and securing a cover upon an open-topped vessel, substan-

tially as described," is an invention the exclusive right to which for the States of New York and Connecticut, as applicable to stoves covered by the patents embraced in the assignment of April 5th, 1853, and in the supplemental agreement of the same date, referred to in *Littlefield* v. *Perry*, belongs to the plaintiff, as against Littlefield and all persons claiming under him.

A bill in equity being maintainable in some respects, a demurrer to the whole bill was overruled.

The parties to the suit being all of them citizens of New York, this Court has no power to decree that the defendant execute to the plaintiff a transfer of letters patent.

(Before BLATCHFORD, J., Northern District of New York, November 10th, 1879.)

BLATCHFORD, J. The assignment of April 5th, 1853, recites the granting to Littlefield of a patent on the 15th of April, 1851, "for a coal burner so constructed as to produce combustion of the inflammable gases of anthracite coal," and the fact that he had applied for a patent "securing to him a certain improvement in the invention so as aforesaid patented by him," and then assigns to Treadwell and Perry all the right, title and interest which Littlefield "now has, or can or may hereafter have, in or to the aforesaid inventions, improvement and patent, or the patent or patents that may be granted for said inventions, or any improvements therein, and in any extension or extensions thereof, within and throughout the district and territory embraced within the States of New York and Connecticut, for and during the term for which the aforesaid letters patent were granted, and the terms for which any patent for the aforesaid improvement, and any other improvement or improvements thereof, or extensions for or of either thereof, may be granted." The Supreme Court of the United States, in *Littlefield* v. *Perry*, (21 *Wallace*, 205,) held that this assignment, "taken by itself, contains, in most unmistakable language, an absolute conveyance by the patentee of his patent and inventions described, and all improvements thereon, within and throughout the States of New York and Connecticut;" and that this assignment and a supplementary agreement executed between the same parties at the same time, when construed together, operated to constitute Treadwell and Perry the assignees of Littlefield, within the patent laws,

in respect to the subject-matter of the assignment, and to give them, and those claiming under them, the right to sue in this Court, to prevent any infringement upon their rights. On the 22d of July, 1853, Littlefield withdrew the application before-mentioned, which had been filed December 30th, 1852, and filed a new application, on which a patent was issued to him January 24th, 1854. The Supreme Court held, in the case referred to, that the assignees became, in equity, the owners of this patent of 1854, under the assignment of April, 1853; that all the patents outstanding, and the subject of the controversy in that suit, exclusive of the patent of 1851, were either re-issues of the patent of 1854 or improvements upon it; and that the use of the said patents, issued after January, 1854, by Littlefield and his co-defendant Jagger, was an infringement of the rights of said assignees. The patents so referred to were these: a patent issued June 25th, 1861; re-issues in two parts, 132 and 133, made November 19th, 1861, of the patent of January 24th, 1854; re-issues in four parts, 1,332, 1,333, 1,334 and 1,335, made August 26th, 1862, of the patent of January 24th, 1854, on the surrender of re-issues 132 and 133; re-issues in two parts, 1,426 and 1,427, made March 3d, 1863, of the patent of January 24th, 1854, on the surrender of two of the four re-issues of August 26th, 1862; re-issues in two parts, 1,478 and 1,479, made May 19th, 1863, of the patent of January 24th, 1854, on the surrender of the remaining two of the four re-issues of August 26th, 1862; re-issues in two parts, 1,813 and 1,814, made November 8th, 1864, of the patent of January 24th, 1854, on the surrender of re-issues 1,426 and 1,427; re-issue 1,815, made November 8th, 1864, of the patent of January 24th, 1854, on the surrender of one of the two re-issues of May 19th, 1863; re-issue 1,823, made November 22d, 1864, of the patent of January 24th, 1854, on the surrender of the remaining one of the two re-issues of May 19th, 1863; a patent issued December 19th, 1862; a patent issued August 18th, 1863; and re-issue 1,594, made December 22d, 1863, of the patent of August 18th, 1863. The outstanding patents, when the bill of revivor and

supplement was filed by John S. Perry, trustee, &c., against Littlefield and Jagger, on the 6th of February, 1865, were (exclusive of the patent of 1851) the patent of June 25th, 1861, the patent of December 9th, 1862, re-issues 1,813, 1,814, 1,815, and 1,823, of the patent of January 24th, 1854, and the re-issue 1,594, of the patent of August 18th, 1863.

The present bill is filed by the same plaintiff who filed the said bill of revivor and supplement in the former suit, and in the same right and on the same title. He claims to be the equitable owner, by said title, of a patent re issued to the defendant Littlefield, May 31st, 1870, on the surrender of a patent granted to him March 13th, 1866, so far as the States of New York and Connecticut are concerned, and charges that the defendants have infringed said patents of 1866 and 1870. The bill prays for an account of the profits of the defendant and of the plaintiff's loss, and that the plaintiff's title for New York and Connecticut, under said patents of 1866 and 1870, may be established.

The specification of the re-issue of 1870 states that Littlefield has invented an "improvement in the mode of hinging covers of stoves, tea-kettles and other open-topped vessels." It proceeds: "In covering stoves, tea-kettles and other vessels opening upwardly, it has long been found useful and advantageous to so adjust and cover the vessel, that the former may be swung aside in a horizontal plane, without its falling off, and so connected to its seat that it may be readily detached from it. Some years ago I designed and applied to the covers of a stove oven which opened upwardly, a hinge of novel construction, by which the objections to a permanent fastening were, in a measure, obviated. Said device consisted in placing an oval shaped pivot-pin upon the under side of the cover near its edge, which fitted into an oval shaped aperture in the rim or upper plate of the stove. A recess or notch cut upon a narrow side of the oval pivot, deep and wide enough to embrace the thickness of the stove plate, permitted the cover to be swung open horizontally and supported in all those positions in which there was not a coincidence of

the larger axis of the pivot with the oval aperture. This mode of hinging the cover to its seat was defective, in that it made an extremely loose joint, and permitted a detachment of the cover at two distinct points, thereby permitting it to fall off on being swung half around. The object of my present invention is to improve upon the hinge there constructed, and to obtain a hinge for the cover of open-top stoves, tea-kettles and other vessels, which shall work closely and evenly, and be so formed that the cover may be readily swung open, and avoid all possibility of its falling from the vessel by its own weight when so swung aside, and also be removed, when desirable to do so, without trouble or inconvenience. This invention relates to hinging and securing covers upon open-topped vessels, and consists in forming with a cover and its seat respectively, a circular opening and a cylindrical pin, so constructed that they will engage or lock with each other." Drawings are annexed to the specification and it refers to them in these words: "Figure 1 is a plan view of the under side of an annular cast-iron plate, designed as a portion of the top piece of a stove, with a cover attached thereto by means of my improved hinge. Figure 2 is a side elevation of the same. Figures 3 and 4 are views in perspective of detached portions of the top and cover respectively, embracing the pivot and pivot aperture forming my improved hinge." The specification also says: "My invention, as represented in the drawing, may be described as follows: The plate or rim A has a circular opening *a*, and the cover B has fitted to or cast with it a cylindrical pin *b*, or *vice versa*. The opening *a* is so formed, that, when the cylindrical pin is introduced therein, the two engage or lock with each other and form a hinge joint, the pin fitting closely and flush in the aperture at all times, whether the cover is at a state of rest or being turned. The close and accurate manner in which the cylindrical pin is embraced within the circular aperture prevents, at the same time, all loose play or movement thereof. Thus, while the cover B, as with the former hinge, has an easy horizontal movement, it cannot, owing to the cylindrical form of the

pivot pin, and the circular form of the aperture, become accidentally detached, when swung open, although the cover, as with the former hinge, may be as readily lifted off as if there were no hinge attached to it. Hence, no inconvenience can arise from the employment of my present improvement, and it presents the advantage of creating but little expense in its construction, its parts being cast with the plates proper." The claim of the re-issue is in these words: "A detachable cover and its seat, respectively provided with a pin and an opening, so constructed as to engage or lock with each other, for the purpose of hinging and securing a cover upon an open-topped vessel, substantially as described."

The specification of the surrendered patent of March 13th, 1866, contained this language: "In covering tea-kettles, stoves and other vessels opening upwardly, it has long been found useful and advantageous so to combine the cover proper with the vessel as that the former may be swung aside in a horizontal plane without falling off. Heretofore, however, this result has been accomplished by means of rivets, bolts or other similar secure joints, so formed as that, although the cover had free play horizontally, it could not be lifted off or detached from the vessel without great trouble and inconvenience. Some years ago I designed and applied to the ornamental covers of open stove ovens, an improvement in these swing joints, by which the objection of a permanent fastening was in a measure obviated. This improvement consisted simply in placing an elongated or oval shaped boss or projection upon the under side of the cover, near its edge, which fitted into a similarly shaped aperture in the rim of the upper plate of the stove. A recess or notch, cut upon one end of the oval projection, deep and wide enough to embrace the thickness of the stove plate, permitted the cover to swing around and be supported in all those positions in which there was not a coincidence of the larger axis of the projection and aperture. This mode of pivoting was defective, however, in that it made an extremely loose joint, which, by its complete articulation in opposite positions, allowed a de-

tachment of the cover at two distinct points. The object of my present invention has been to improve upon the plan then invented, and to obtain a pivoted or swing joint for the cover of open-top stoves, tea-kettles, and other vessels having vertical openings or recesses, which shall work closely and evenly, and be so formed as that the cover may be not only readily swung aside, in order to fill the vessel, without the necessity of lifting it off, or the possibility of its falling away by its own weight when so swung aside, but can, also, when closed, and then only, be readily removed without trouble or inconvenience. The nature of my improvement consists chiefly in the substitution of a circular aperture in the rim or top plate of the vessel, and a round pivot pin or projection upon the under side of its cover, in the place of the elongated or oval aperture and projection, heretofore designed. * * * I do not claim broadly the combination of a swing cover with a vessel, in such a manner as that it may be readily detached therefrom, but what I do claim as my invention and desire to secure by letters patent is, the use of a cylindrical keyed pivot pin, in combination with a circular notched aperture, for the purpose of hinging and securing swinging covers upon stoves, tea-kettles, or similar open-topped vessels, substantially in the manner herein set forth." The other parts of the specification of the original patent do not differ substantially from the corresponding parts of the specification of the reissue.

The bill alleges, that the stove to the cover of the oven of which Littlefield so applied, as stated in said specifications, the hinge made by the oval shaped pivot pin in connection with the oval shaped aperture, was the stove patented by said patent of April 15th, 1851; that, by virtue of the said assignment of April 5th, 1853, and the said supplementary agreement of the same date, the plaintiff has the exclusive title, for the States of New York and Connecticut, to the said patent of 1851; and that, by reason of the premises contained in the original bill in the former suit, and in the bill of revivor and supplement therein, and in the present bill, the plaintiff has

the exclusive title, for the States of New York and Connecticut, to the said patent of 1866 and the said re-issue of 1870.

The specification of re-issue 1,823, of the patent of January 24th, 1854, sets forth, that Littlefield has "invented new and useful improvements in stoves for burning anthracite and other concentrated fuels," and that what follows therein is a description of his invention. It also says: "My invention relates to an improvement in stoves which are supplied with an excess of fuel and the excess or reserve fuel fed to the fire as fast as consumption takes place, and for which I have applied for letters patent in even date herewith, and my invention consists in the adaptation of a swinging cover to the top of the stove, so as to permit said cover to be swung open on a horizontal plane without falling off, when necessary to supply fresh coal or to cool the stove." It further states, that this cover is hinged to the top of the stove by a rivet, so that it may be swung aside on a horizontal plane, without its becoming detached and falling off, "whenever it may be required to open the chamber G, or to supply fresh coal, cool the stove, or for other purposes;" and that the inventor does not broadly claim hinging a cover to the top plate of a stove, but claims "the arrangement, adaptation and combination with a fuel supplying stove, of a cover so hinged to the top plate of the stove that it may be swung open on a horizontal plane, substantially in the manner and for the purposes specified."

The bill is accompanied by an affidavit made by the plaintiff, which states that he has in his possession a stove made by Littlefield about the year 1851 or 1852, in accordance with said patent of April 15th, 1851, which had and still has a double sliding cover attached to its open top, rim or upper plate, and an oval shaped pivot pin upon the under side of the cover, near its edge, fitting into an oval shaped aperture in the rim or upper plate of the stove, substantially according to the description of such arrangement in the specification of said patent of 1866, and in the specification of said re-issue of 1870; that another stove, made by said Littlefield during the

year 1853, in accordance with said patent granted January 24th, 1854, and subsequently re-issued as aforesaid, and now in the possession of the plaintiff, had and still has a cover so hinged to the top plate, that it may be swung open on a horizontal plane, as more fully described in said re-issue 1,823; that the exclusive right to the use, within the States of New York and Connecticut, of the said patents of April 15th, 1851, and January 24th, 1854, and of the said re-issue 1,823, has been adjudged to have been conveyed to the plaintiff; that the said bill of revivor and supplement was filed January 25th, 1865; that, subsequently thereto, Littlefield made further inventions in said stove patented April 15th, 1851, and in the subject-matter of the invention patented by re-issue 1,823, which resulted in there being granted to him the said patent of 1866 and the said re-issue of 1870; that said inventions are legitimate improvements upon said inventions shown and described in said patent of April 15th, 1851, and said re-issue 1,823; that it is true that said improvements may also be applied to tea-kettles and other open-top vessels, but they were primarily adapted by Littlefield to stoves of the character conveyed to Treadwell & Perry, and their assigns, by the assignment of April 5th, 1853; that Littlefield, since March 13th, 1866, has, with his associates, made and sold stoves embracing the said improvements, within the States of New York and Connecticut, and licensed other manufacturers of stoves to put in practice the same within the said territory; that Littlefield threatens to continue such invasion of the plaintiff's rights; and that the successors of Treadwell & Perry have on hand a large stock of stoves which embody said inventions patented in 1866 and re-issued in 1870, and are ready to supply the demand therefor in said States of New York and Connecticut.

There is, also, an affidavit by James Gray, a metal plate worker, with an experience of more than thirty years in stoves, ranges and hot air furnaces. He states that he is familiar with the stove constructed by Littlefield under said patent of April 15th, 1851; that such stove is not a cooking stove, as known to the trade, but is a parlor heating stove,

combining an oven for culinary or air heating purposes; that the mode of attaching the swinging cover to the top plate of said stove is substantially described in the paragraph commencing "Some years ago I designed and applied," in said patent of March, 1863; that the mode of attaching the swinging cover to the top plate of the stove constructed by Littlefield under the original patent of re-issue 1,823, is substantially in accordance with the claim of re-issue 1,823; and that the device covered by the patent of 1866 and the re-issue of 1870 is a natural and legitimate improvement of the devices applicable to the swinging covers of the open tops of stoves, as patented by Littlefield April 15th, 1851, and by re-issue 1,823. Two other affidavits of experts, to the same purport as the affidavit of Gray, are produced by the plaintiff.

The bill prays for an account and an injunction, and also for a decree that the plaintiff is vested with the exclusive right, within the States of New York and Connecticut, to make and vend, and cause to be made and vended, stoves embodying the improvement covered by the said patent of 1866 and the said re-issue of 1870, and that Littlefield be decreed to execute and deliver to the plaintiff all further transfers and evidences of title to the said exclusive right within the said territory, as may be necessary for the protection of the plaintiff in his said rights.

The defendants have put in a demurrer to the whole bill, assigning for cause that the plaintiff has not made or stated such a case as entitles him to any such relief as is prayed for, and that the plaintiff has an adequate remedy at law, and specifying the following additional grounds of demurrer: (1.) The complaint does not state facts sufficient to constitute a cause of action; (2.) It does not show that the plaintiff has any title to the patents set out in the bill; (3.) This Court has no jurisdiction to compel the performance of the contract of 1853, referred to in the bill.

It is contended, for the defendants, that the patent of 1866 does not relate to the subject-matter transferred by the assignment of 1853; that the device patented by re-issue 1,823

is different from the subject-matter described in the patent of 1866; that re-issue 1,823 does not describe the construction of any hinge, but describes a cover fastened to the top of the stove by a rivet, and claims the adaptation of such cover to the top of the stove only when combined with a fuel supplying stove; that the patent of 1866 would be infringed by the use of the hinge therein patented in combination with any cover and its seat, where the cover would swing open horizontally; that this Court cannot take jurisdiction of the matter in controversy in this suit, for the reason that the only patent alleged to have been infringed was applied for and granted after the assignment of April, 1853, was made; and that the invention of March, 1866, was not an improvement in the inventions involved in the former suit.

The original patent of January 24th, 1854, describes a reservoir over the fire pot serving the purpose of a magazine or receptacle for the fuel, where it is designed to feed the fire but once in twenty-four or forty-eight hours. The invention is stated to consist in employing a cylindrical grated fire pot, surmounted by such reservoir which receives the gases arising from the burning of the fresh coal, besides containing the supply of fuel; and the object of the invention is stated to be to effect a simultaneous combustion of the waste gases with the carbon of the coal. The reservoir and the exterior cylinder of the stove have each of them a cover.

Re-issues 132 and 133 are to the same purport. In each of the re-issues 1,332, 1,333, 1,334 and 1,335, it is stated that the patent of January 24th, 1854, is "for and upon a new method of constructing that class of stoves using a supplying cylinder for the reserve coal." Each of these re-issues describes the outer cylinder and its cover and the reservoir and its cover. Re-issues 1,426 and 1,427 contain, each of them, a like statement with that in re-issues 1,332, 1,333, 1,334 and 1,335, as to the patent of January 24th, 1854, and also describes the outer cylinder and its cover and the reservoir and its cover. The same is true of re-issues 1,478 and 1,479. Re-issue 1,813 states that the invention "relates to improvements

in stoves which are supplied with an excess of fuel and the excess or reserve fuel fed to the fire as fast as consumption takes place," and describes the reservoir and its cover and the outer cylinder and its cover. The same is true of re-issues 1,814 and 1,815. The contents of re-issue 1,823 have been before specifically recited. Figure 4 of that re-issue is "a plan view of the top of the stove and cover opening thereto." That re-issue must have been justified by the original specification, drawings and model. Its text shows that Littlefield declared the arrangement, in a fuel supplying stove, of a cover hinged to the top of a stove by a rivet, so as to be swung aside on a horizontal plane without falling off, to be an improvement in a stove for burning anthracite and other concentrated fuels. The specification of the original patent of January 24th, 1854, shows that the stove described was designed and arranged to burn anthracite coal. All the re-issues of that patent show the same thing. The assignment of April 5th, 1853, recites that the patent of April 15th, 1851, is a patent "for a coal burner, so constructed as to produce combustion of the inflammable gases of anthracite coal." By the supplemental agreement of the same date, Littlefield agrees to sue, for the benefit of Treadwell & Perry, all persons who shall infringe, within New York or Connecticut, the said patent of April 15th, 1851, "or any patent or patents which may hereafter be obtained in respect to the subject-matter thereof;" and he also agrees, that, in case the said patent, "or any patents which may hereafter be obtained by him, as aforesaid, for the subject-matter thereof, shall be adjudged invalid," so as to deprive Treadwell & Perry "of the use and enjoyment of the rights and interests conveyed by the aforesaid assignment," the agreements on the part of Treadwell & Perry shall thereby become void; and he also agrees to furnish to Treadwell & Perry, before the first day of August then next, at the cost price thereof, at their furnace, "undressed cast iron patterns for four several sizes of the coal burner patented in and by the aforesaid letters patent, and embracing all the improvements therein for which letters patent shall then have been

secured, suitable to mould and cast from, and that he will also furnish at the place and price aforesaid, within a reasonable time after letters patent have been secured by him therefor, undressed cast iron patterns of the several sizes, of all improvements upon said coal burner which shall be made or invented by him." It is entirely clear, that the plaintiff is entitled, as against Littlefield and all persons claiming under him, to the exclusive right, title and interest in and to any invention made by Littlefield, so far as it is applicable to the stove covered by the patents embraced in the assignment and the supplemental agreement, which facilitates or improves the method of hinging a cover to the top of the stove, so as to enable it to be swung aside on a horizontal plane without falling off. In re-issue 1,823 the cover is hinged by a rivet. In the original patent of March, 1866, the invention covered by that patent is stated to be an "improvement in the mode of attaching and hinging covers to stoves and other vessels, when said covers are designed to swing open in a horizontal plane." That patent also states, that, "in covering tea-kettles, stoves and other vessels opening upwardly, it has long been found useful and advantageous so to combine the cover proper with the vessel as that the former may be swung aside in a horizontal plane without falling off;" and that "heretofore, however, this result has been accomplished by means of rivets, bolts, or other similar secure joints, so formed as that, although the cover had free play horizontally, it could not be lifted off or detached from the vessel without great trouble and inconvenience." Then follows, in that patent, the statement, that, some years ago, Littlefield "designed and applied to the ornamental covers of open stove ovens, an improvement in these swing joints, by which the objection of a permanent fastening was in a measure obviated," such improvement being the oval shaped projection on the under side of the cover, in connection with the oval shaped aperture in the rim of the upper plate of the stove. Then follows a statement, that the object of the new invention is to improve on the oval projection and oval aper-

ture plan, and obtain a swing joint for the cover, which shall so work as that the cover may be not only readily swung aside without being lifted off or falling when swung aside, but may, when closed, and then only, be removed; and that the improvement consists chiefly in substituting a circular aperture in the rim or top plate, and a round projection on the under side of the cover, in place of the oval aperture and oval projection. This new invention is clearly applicable to the stove covered by the patents embraced in the assignment and the supplemental agreement. It improves the method of hinging a cover to the top of the stove, so as to enable it to be swung aside on a horizontal plane, without falling off. It is an improvement on the rivet method in re-issue 1,823. The rivet method was a permanent fastening. The oval projection and oval aperture method was an improvement which got rid of a permanent fastening, but was yet defective. The round hole and round projection method is a still further improvement. All three of the methods allow the cover to be swung aside in a horizontal plane, and to be supported in pre-determined positions. The re-issue of 1870, in the particulars just referred to, is to the same effect.

The bill complains only that the defendants have made and sold stoves containing the new improvement, and prays an account only in respect to such stoves, and a decree establishing the plaintiff's exclusive right, for New York and Connecticut only, to make and sell stoves embodying the new invention. It does not extend the plaintiff's claim to covers for any vessels but stoves. As regards such stoves as are covered by the patents embraced in the assignment and the supplemental agreement, it seems quite clear that the plaintiff has the exclusive right, as against the defendants, to employ in such stoves the improvement claimed in the re-issue of 1870, and that the bill is well founded in that respect. Whether the plaintiff would have the exclusive or any right to employ such improvement in other vessels than such stoves, is not a material question in this case. Even though the plaintiff, in respect to such re-issue, be a mere licensee in

regard to such stoves, and not an assignee, or a grantee of the entire exclusive right under the patent for a specified territory, yet, as such licensee, he can maintain this bill against Littlefield and all persons who claim under him, as was directly determined by the Supreme Court in the former suit.

As the parties to the suit are all of them citizens of the State of New York, the bill is not maintainable, so far as it asks for a decree that Littlefield execute further transfers to the plaintiff. But, as the demurrer is to the whole bill, and as the bill is maintainable in all other respects, the demurrer must be overruled, with costs to the plaintiff, and with leave to the defendants to answer, on payment of such costs, to be taxed, within twenty days after service of a copy of the order to be entered on this decision.

The plaintiff also asks for a preliminary injunction to restrain the defendants from infringing the plaintiff's exclusive rights under the re-issue of 1870. Such injunction is granted, so far as regards the employment of the invention claimed in the re-issue of 1870 in such stoves as are covered by the patents embraced in the assignment and the supplemental agreement, as determined by this Court and the Supreme Court in the previous litigations between the parties, and by this Court in this decision.

Hamilton Harris, for the plaintiff.

Edward F. Bullard, for the defendants.

ORSON BREED

vs.

THE PROVIDENCE WASHINGTON INSURANCE COMPANY.

Clauses in an open uniform canal cargo policy of insurance construed, in such manner as, the insurance being to the amount of $8,000 on goods worth $20,000, and the loss being $9,378 01, the liability of the insurer was held to be only for two-fifths of the loss, and not for the $8,000.

(Before BENEDICT, J., Eastern District of New York, November 10th, 1879.)

BENEDICT, J. This is an action upon a policy of insurance, tried by consent before the Court, without a jury. The policy is styled an open uniform canal cargo policy. By its provisions the defendants agreed with the plaintiff to insure him for such amounts, upon such goods, during such voyages or trips, as should, with the approval of the assurers, be endorsed on the policy, or in a book kept for that purpose, against the perils of the seas, canals, rivers and fires, and all other perils and losses that might happen to the goods on the voyage designated. In accordance with the terms of the policy, endorsements were thereafter made and approved, in a book kept for that purpose, so as to effect insurance to the amount of $8,000, upon goods worth $20,000, shipped upon the canal boat Pallas, for a voyage described. During that voyage, a loss amounting to the sum of $9,378 01 was suffered by the insured, whereupon he brings this action upon his policy, to recover the sum of $8,000. The underwriters deny their liability for so great an amount, and contend that the amount of their liability is limited to two-fifths of the loss suffered. The determination of the controversy requires a construction of the policy, and, more particularly, a determination of the effect to be given to the 9th, 10th and 15th of the 21 clauses into which the policy is divided. The 9th clause is as follows: "Immediate notice

of the occurrence of all losses shall be given to the said assurers by the insured; and, within thirty days from the time the same may happen, the said insured shall deliver to the said assurers as particular an account thereof as the nature of the case will admit, stating the causes, if known, the extent thereof, and the nature of the interest in the property, also, what other insurance or insurances, if any, there was on said property at the time of said loss; which statement shall be in writing, signed by the assured, and verified by his and their oath; and so much of said statement as relates to the cause, nature and extent of said loss or damage shall be verified, also, by the oath of the master of said boat or vessel, or of some other person or persons having immediate charge thereof at the time the same did happen, otherwise the said assurers will not be liable under this policy; and the amount of loss shall be ascertained by the opening of packages, when necessary, by a competent person, and separating the sound from the damaged portion, the said assurers being liable for the loss on the damaged portion only, which shall be ascertained by appraisement by disinterested persons, or by sale at auction, as the said assurers may prefer." The 10th clause is as follows: "The said loss or damage to be estimated according to the true and actual cash value of the said property at the place of destination, on the day of the disaster, and, on the property not forwarded to its destination, the said loss or damage to be ascertained in the same manner, and the freight from the place of disaster to the place of destination deducted, and the said assurers will pay such proportion of the said loss as the amount thereby insured bears to the sound value of the property so insured. In all cases of loss or damage there shall be deducted, in lieu of average, the sum of seventy-five dollars, on losses on grain and general merchandise, and fifty dollars on flour and other cargoes, excepting salt, on which the average shall be one hundred dollars." The 15th clause is as follows: "And the said assurers do hereby undertake and agree to make good and satisfy unto the said insured all such loss or damage on the said goods, merchandise or country produce,

so laden as aforesaid, not exceeding in amount the sum insured thereon, as shall happen or arise from any of the aforesaid causes or casualties, not excepted, to be paid within sixty days after notice and proof of the loss and interest therein shall have been made by the insured."

The plaintiff claims that clause 10 is intended to apply to cases where insurance is effected in other companies, and to no other cases, and has no effect in a case like this, where there was but a single policy; and he contends that the 15th clause determines the extent of the defendants' liability in this instance, and that, by virtue thereof, they are liable for the whole $8,000, the amount of the loss having exceeded that sum. On the part of the defendants the contention is, that the 10th clause of the policy must be considered in all cases, for the purpose of ascertaining the extent of the underwriters' liability, and has, in this instance, the effect to limit the defendants' liability to such a portion of the loss as the sum insured by the policy, viz., $8,000, bears to the sound value of the property insured, viz., $20,000. Upon this question, my opinion is in favor of the defendants' construction of the policy. I am unable to find anything in the policy that will warrant confining the effect of the 10th clause to cases where other insurance shall have been effected. The clause contains no language from which an intention so to limit its effect can be inferred. On the contrary, the language is general, and the subject-matter such as to indicate that it was intended thereby to declare the extent of the underwriters' liability in all cases of loss. The plaintiff would make the clause read: "In case of other insurances, the said assurers will pay such proportion of the loss as the amount insured by all policies bears to the sound value of the property insured." But, there is no language that limits the provisions to the case of other insurances, and the word "thereby" cannot be supposed to be used to signify "by all policies." As here used, the word "thereby" is given a natural significance, by considering it to be equivalent to "in that way," viz., by means of endorsements made on the policy or in the book, with the approval

of the underwriters, according to the method prescribed in the commencement of the policy. So understood, the language of the 10th clause is given a natural effect, and the 10th and 15th clauses are in harmony, for the words "such loss," used in the 15th clause, refer back to the language of the 10th clause, for the extent of the liability, and the sixty days' limit, contained in the 15th clause, indicates the object of that clause. The provision of the 10th clause, if read as the plaintiff contends, would be an absurd provision, for it would permit the insured, by taking out other policies, to increase the amount of liability under the policy, without paying any increased premiums, inasmuch as, according to the plaintiff's reading, the greater the amount of all the policies the greater the liability created by this clause. It is, indeed, true, that such a result would conflict with other subsequent clauses in the policy, but the clause, by itself, if understood as the plaintiff contends, would produce that result, and it cannot be supposed to have been the intention to insert an absurd provision, of such a character, in the policy, whether cured by other provisions or not.

The amount of premium furnishes no support to the plaintiff's contention. It was entirely possible, under the policy, that underwriters should be liable for the whole $8,000, as, for instance, in case the sound value of the property insured had been $8,000; and it was within the plaintiff's control to limit the shipment to that amount. So, also, the liability would be $8,000, if the value of the shipment were $20,000, in case the loss had been total.

My conclusion, therefore, is, that the terms of the policy do not permit the constructions for which the plaintiff contends, and that the effect of the provisions in the policy is to make the owner co-insurer with the underwriters, and to limit the liability of the underwriters, in this case, to two-fifths of the loss. In accordance with this conclusion, there will be judgment for the plaintiff in the sum of $1,746 25, that being the two-fifths of the loss, less certain deductions that both

sides agree are proper to be made. Let there be judgment accordingly.

Birdseye, Cloyd & Bayliss, for the plaintiff.

W. W. Hoppin, Jr., for the defendant.

THE AMERICAN COTTON TIE SUPPLY COMPANY

vs.

NATHANIEL L. MCCREADY AND OTHERS. IN EQUITY.

Cotton ties made in infringement of patents owned by the plaintiff were being shipped from New York to ports in the southern part of the United States, by steamers belonging to a corporation of which the defendants were the managing officers, for persons whose names they refused to disclose to the plaintiff, the ties being shipped to be sold at such ports for use: *Held*, that such carrying of such ties by said steamers was an infringement of the patents, and that such officers would be restrained by an injunction from doing so.

Under § 4,921 of the Revised Statutes, the Court has power to enjoin the infringement of a patent, independently of the award of any other relief thereon.

(Before BLATCHFORD, J., Southern District of New York, November 11th, 1879.)

BLATCHFORD, J. This bill is founded on two patents. One of them, No. 23,291, was granted to George Brodie, May 22d, 1859, for 14 years from March 22d, 1859, for "improvements in metallic bands for baling," and was re-issued to him April 27th, 1869, as re-issue No. 3,405, and was extended for seven years from March 22d, 1873, and was re-issued March 25th, 1873, as re-issue No. 5,333. The other patent, No. 31,252, was granted to James J. McComb, January 29th, 1861, for 14 years from that day, for an "improve-

ment in iron ties for cotton bales," and was extended for seven years from January 29th, 1875. The plaintiff, a Louisiana corporation, is the owner of the patents. The validity of the patents and the right of the plaintiff to be protected by preliminary injunctions against infringements are not in question in this suit.

The charge of infringement made in the bill is, that the defendants, without license, have entered upon, and are now engaged in infringing upon, the rights of the plaintiff, by aiding and abetting various other persons, not licensees of the plaintiff, in making, selling and using iron cotton ties which embody the said patented inventions. The defendant McCready is the President of the Old Dominion Steamship Company, a Delaware corporation, the defendant Stanford is the secretary and general freight agent of the said corporation, and the third defendant is the assistant general freight agent of the said corporation. The bill alleges, that the defendants, as officers and agents of the said corporation, have been for some time past and now are actively engaged, without the license or authority of the plaintiff, and against the plaintiff's protest, in transporting cotton ties, embodying the said inventions, from the port of New York to various points in the South, and particularly to Norfolk, Petersburg and Richmond, well knowing that such ties are intended for sale and use in the cotton districts and in the cotton ports of the South; that the plaintiff has already suffered damage from such acts of the defendants; and that the defendants have been duly notified of the plaintiff's rights in the premises, and requested to desist from such acts, but refuse to do so, except as they shall be restrained therefrom by the order of this Court. The bill prays that the defendants may account for profits and damages, and may be enjoined from making, using or vending the said inventions and from aiding others in so doing.

The bill is accompanied by an affidavit made by Frederic Cook, an agent of the plaintiff, on the 13th of October, 1879, setting forth that the said corporation has been engaged,

without the license or authority of the plaintiff, in transporting from the city of New York to Norfolk and other places in the State of Virginia, iron cotton ties embodying the inventions covered by the 3d, 4th and 5th claims of the Brodie patent, and the claim of the McComb patent; that, within the past two weeks, he has seen upon the pier of said corporation, various lots of said ties which he carefully examined and is sure were not of the manufacture of the plaintiff, but were unlicensed and infringing ties; that he has been unable to learn from the officers of said corporation who the actual shippers of the said infringing ties have been, although he has caused proper enquiry to that end to be made, the officers of the corporation declining to furnish the information, on the ground that the rules of the corporation forbid it; that he believes that other persons than those who have been restrained in suits brought by the plaintiff, in this Court, against Bullard & Wheeler and John S. Long, V. Pugsley and G. P. Chapman, Earle & Perkins and Moses & Cohen, are making such shipments by the said line; that, on the 10th of October, 1879, there was received at the New York office of the plaintiff, a letter from its Norfolk agent, C. Phillips, enclosing a copy of a part of the manifest of the Old Dominion, one of the steamships of the said corporation, which lately arrived from New York at Norfolk, and which showed the shipment on that vessel of six lots of cotton ties consigned to different parties, none of whom are agents of the plaintiff; that such ties were described in said letter as arrow ties; that the writer of the letter went on to state that the large quantity of such ties brought into his territory from New York was seriously affecting his trade, and that, unless the further introduction of such ties could be prevented, his sales would not be one-half of what they would otherwise be; that a letter of similar import was written within a few days, and received from the Petersburg agents of the plaintiff, in which complaint is made of the large number of competing ties brought into the Petersburg market from New York; that the counsel for the plaintiff has caused the attention of the

officers of the said steamship company to be called to the injury that is thus being inflicted upon the plaintiff, and has served upon said company and one or more of the defendants herein a copy of the restraining orders and injunctions which have been issued in the above-named suits, but that, while the officers of said company acknowledge their obligation to refrain from transporting ties for the special parties defendant in said suits, they do not feel that they are at liberty to decline taking similar freights from other persons; that the counsel for the plaintiff has caused to be represented to the officers of said company the difficulty which the plaintiff now finds in protecting itself against shipments of infringing ties by unknown parties, and that it may, therefore, become necessary to apply to this Court, for an order restraining the said company generally from acting as carriers for parties who may offer such ties for shipment from the port of New York, and that the officers of said company have signified not only their willingness to yield a ready obedience to any such order, if obtained, but a disposition to abstain from any attempt to embarrass the plaintiff in securing such order; that he greatly fears that unless the said company be so restrained forthwith and before a motion for an injunction can be heard in the due course of practice, infringers will succeed in removing their ties to points in the south and outside of the jurisdiction of the Court; that, should they succeed in this, it will necessarily result in irreparable damage to the plaintiff; and that this is the most critical period of the cotton tie season, and a few thousand bundles of infringing ties thrown into the market at this juncture will almost inevitably unsettle prices and greatly disturb the trade, and thus inflict an injury upon the owners of the patents for which there is no adequate remedy.

On the bill and such affidavit an order was made by this Court, on the 13th of October, 1879, ordering that from and after the service of the writ of subpœna in this cause, and a notice of motion for an injunction *pendente lite*, to be heard on October 24th, 1879, with copies of the papers on which

said motion is to be made, "the said defendants, and each of them, their agents, servants, attorneys, workmen and employees, and each of them, be and stand in all respects restrained and prohibited from receiving at the wharves or docks of the said Old Dominion Steamship Company, or from placing on board said company's steamships, or from shipping or transporting from any point or points within the jurisdiction of this Court, under any pretext whatever, any cotton ties containing the features of invention, or any of them, which form the subject of the third, fourth and fifth claims of the said patent No. 5,333, or the claim of the said patent No. 31,252, and particularly ties composed of a flat band of iron and an open-slotted link or buckle, having a single central opening for receiving the band, unless such ties be offered for shipment or transportation by the said American Cotton Tie Supply Company, or its duly authorized agents, and that they and each of them do stand so restrained and prohibited until the hearing of such motion, and until the same shall be by the Court determined and decided."

The motion has been heard. It is opposed on the part of the defendants, by an answer to the bill and by affidavits. The defendant McCready, in an affidavit, says, that he is president of the Old Dominion Steamship Company, a corporation created under and by virtue of the laws of Delaware, and engaged in the business, as common carrier, of carrying and transporting freight and passengers between the ports of New York, Norfolk and Richmond, and having its general office in the city of New York; that said company owns many large steamships, by which it carries on its said business, which sail from the port of New York six times a week, laden with large cargoes of all kinds of merchandise; that said company receives upon its wharf, at pier 43, North river, from a very large number of persons, all kinds and descriptions of freight, in all quantities; that he is not acquainted with any of the details of such transportation, so far as the names of shippers and the different kinds of merchandise are concerned, his duties being confined to the general management of the business;

that it would not be practicable for him to inform himself each day as to such details; that he has no knowledge whatever as to the claim of the plaintiff herein to the patents specified in the bill, nor to the articles claimed to be manufactured in accordance therewith; that it would be impossible for him, as president of said company, to inform himself, each day, or at any time, whether the articles received by the said company for shipment, are shipped by persons licensed by the plaintiff, or whether the articles have been properly purchased by the shippers from the plaintiff, or whether the articles themselves are infringements of the plaintiff's manufacture, or different from the same; that, with regard to the shipments heretofore made, he has been entirely ignorant in the respects above set forth, except so far as he has been informed by persons acting for the plaintiff, that the articles were infringements; that the business of said company is very large, and it would be impossible, in the proper conduct of the same, for the said company to inform itself of all the facts with regard to the articles shipped, to ascertain whether or not they were infringements of the plaintiff's manufacture; that it would necessitate the employment of experts to examine each and every one of the articles, out of many tons thereof, to determine whether or not they were infringements; that it would be necessary to employ persons to make enquiries as to the shippers of the articles, to learn, if possible, whether they had the right to ship the same; that all of this would seriously impede and delay the business of the said company, to its great and irreparable injury; that he has in no way infringed upon the rights of the plaintiff; that he has not aided or abetted any persons, whether licensees of the plaintiff or otherwise, in making, selling or using the articles claimed by the plaintiff; that he has no knowledge, nor any means of ascertaining, whether or not the said company is shipping or transporting cotton ties embodying the plaintiff's patented invention, shipped by persons without authority or license; and that neither he nor the other officers of the said company would hesitate to obey any proper order of this Court, but the said

company and its officers do most earnestly oppose the making of any order which would inflict any serious injury upon said company, as the order prayed for herein inevitably would.

The defendants Stanford and Guillauden, in a joint affidavit, state that Stanford is secretary and general freight agent of the Old Dominion Steamship Company, and that Guillauden is assistant general freight agent of said company; that they have read the affidavit of the defendant McCready, and the same is true in every respect; that the defendants are entirely ignorant of the matters in the bill and affidavit of the plaintiff set forth, with relation to the letters patent and the plaintiff's rights and acts thereunder, as alleged in said bill and affidavit, nor have they any means of informing themselves as to such matters; that they deny any individual connection with, or relation to, the acts charged against them in said bill and affidavit, and allege, that their only connection, directly or indirectly, with such matters is as officers and agents of the Old Dominion Steamship Company; that said company acts, in relation to the transportation of the articles alleged to be infringements of the plaintiff's invention, only as a common carrier for others, and that it has no other interest or connection with said articles; that the deponents are employed entirely in the office of said company; that they have never seen any of said articles; and that they have no power or authority to refuse to transport the same.

The defendant Stanford, in a separate affidavit, states that he is secretary and general freight agent of the Old Dominion Steamship Company; that, since the restraining order in this suit was issued, cotton ties have been offered to said company for shipment; that, by reason of said order, and the inability of the officers and agents of said Company to ascertain and determine as to whether or not the said ties were infringements of the plaintiff's alleged inventions, or whether or not the persons offering the same were rightfully authorized to ship them, the said company was compelled to refuse to receive or transport the same; that the said ties were sub-

sequently offered to another company, a competitor of the Old Dominion Steamship Company, which received and transported the same; that, by reason of being placed in such a position, the said company is sustaining and will continue to sustain very serious injury, not only with regard to the freight on said ties, but with regard to other freight; that such injury will amount to upwards of one thousand dollars a month directly, in addition to its liability to action by the parties offering said ties; and that the competitors of said company are thus greatly benefitted at its expense and to its great injury.

It is contended for the defendants, that the steamship company, as it acts solely in the capacity of common carrier of these ties, does not come within the meaning of the statute, as an infringer of the patents; that it has nothing to do with the rights of the plaintiff or the invasion of those rights by others; that it does not use, or aid others in using, the ties, because such use cannot be had until after transportation and delivery; that the company, by transporting the ties, does not sell them to others to be used, or aid in selling them to others to be used; that, as a common carrier, the company is bound to receive and carry all goods offered by any person; that it would be against public policy to restrain the company; that it would impede its business and inflict injury on the whole community; that the suit is improperly brought against the defendants and should be brought against the company; that the defendants are only officers of the company, with distinct duties, and have no control over the goods and no power to refuse to receive them; that the company ought not to be compelled, at its own expense, to protect the plaintiff's business; and that it owes no duty to the plaintiff, to answer for the diligence which the plaintiff ought to use in protection of its own interests.

It is entirely clear that the owners of infringing and unlicensed cotton ties, who are causing them to be transported by the vessels of the Old Dominion Steamship Company, are sending them for sale and use, and are employing said com-

pany and its officers as agents and servants in promoting and effecting such sale and use. It would seem, on principle, that there ought to be no difficulty in restraining by injunction all persons, whether officers of a corporation or not, who are aiding in the promotion of the infringing sale and use, whether such persons would be liable for profits or damages or not. It has been so held by this Court. (*Goodyear* v. *Phelps*, 3 *Blatchf. C. C. R.*, 91; *Poppenhusen* v. *Falke*, 4 *Id.*, 493.)

In *Hunt* v. *Maniere*, (*L. J., new series, vol.* 34, *part* 1, *Chy.*, 142,) a wharfinger received notice that certain wine, deposited at his wharf was marked with a fraudulent imitation of a trade-mark, and that the owner of the trade-mark was about to apply to the Court of Chancery for an injunction to prevent the wine from going on the market. After the injunction had been granted, but before the wharfinger had notice that it had been granted, he refused to deliver the goods to their owner. It was held by the Master of the Rolls, and, on appeal, by the Lords Justices, that he was justified, in equity, in such refusal, and that the owner of the goods would be restrained from suing him at law for a wrongful conversion of the goods. The Master of the Rolls observed, that the plaintiff acted rightly; and that, being in the possession of goods which he knew to be a fraudulent and spurious imitation of the manufacture or growth of other persons, and being informed that an injunction would be obtained, and being notified not to deliver the goods, he would have acted culpably if he had parted with the goods.

In *Upmann* v. *Elkan*, (*Law. Rep., 7 Chy. App.*, 130,) affirming the decision of the Master of the Rolls, (*Law Rep.*, 12 *Eq. Cas.*, 140,) a firm of forwarding agents in London received from correspondents abroad several boxes of cigars bearing forged brands, which were to be delivered to several persons in England. On application by the makers whose brand had been forged, the agents gave information as to the consignors, and offered either to send back the cigars, or to erase the brands. On a bill for an injunction, filed by the makers whose brands were forged, it

was held that the fact that the agents were merely carriers was no defence to the suit, but that, as they had given sufficient information and had offered to erase the brands, they were not to pay costs. The defendants were forwarding agents, to whom the goods had been consigned to pay the duty on them and forward them to persons named. They were to be paid for so doing, but their profit did not arise from the sale of the goods. The Master of the Rolls said: "It does not, in my opinion, make any difference whether the goods are sent to a person who does not deal in the article consigned, and whose duty is simply to distribute the goods to other persons, or whether the goods are sent to him as consignee, for his own purposes. In either case they are sent to the dock to be at his disposal, and without his signature the goods cannot be disposed of. It will not do for him to say, as he does in this case, 'I know nothing about the goods sent. I do not know whether they have any, or, if any, what brand on them, or whose it is.' It is his duty to know this, and, if he receives notice that they bear a fraudulent imitation of another man's brand, he ought to ascertain this as speedily as possible after such notice, and to take the proper and necessary steps to prevent their being disposed of in that state. It may be, that, without notice, and when he sees the trade-mark, he does not know that it belongs to another. If so, he may deal with them innocently. But, as soon as he is informed of the fact, he should act at once, so as not to be, in any event, either from wilful or from accidental ignorance, made a party to the fraud committed by another; and, when he ascertains the fact, he should at once inform his correspondent abroad. If it be argued, that this imposes upon him serious inconvenience, and a duty which, by taking the order for goods, he never undertook, this may be admitted to be true; but it is only what would be the case in the event of the importation of prohibited articles, and it arises from the circumstance that he has not taken sufficient care to ascertain what sort of persons the correspondents are for whom he consents to act as agent." Lord Hatherley, on the ap-

peal, said: "It has been argued, that the plaintiffs were not entitled to an injunction against the defendants, who had been guilty of no offence, being merely carriers receiving goods, which, though fraudulently marked, were not for their own use, nor to be sold by them for their own benefit, but were received merely for the purpose of transmitting them to the persons to whom they were consigned. I cannot conceive a doctrine more dangerous or mischievous, or more fatal to the authority of the Court with respect to trade-marks. If that argument prevailed, any persons, being abroad, as was the case in this instance, and minded to commit frauds upon an English trade-mark, could easily do so by sending their different consignments together to persons in the position of the defendants, who appear to be respectable agents and warehousemen, thereby committing an injury in a manner most convenient for themselves, and very mischievous to the person entitled to the benefit of the trade-marks."

In *Orr* v. *Diaper*, (*Law Rep.*, 4 *Chy. Div.*, 92,) it was held that a bill would lie against ship owners who had shipped goods bearing counterfeits of the plaintiff's trade-marks, for a discovery of the names of the consignors from whom the goods had been received.

The doctrine of these cases in regard to trade-marks is entirely applicable to the case of the infringement of a patent. As the defendants have refused to disclose the names of the infringing shippers of ties, the plaintiff is without remedy by injunction, in respect of the infringing ties which the defendant's company transports in its vessels, unless it can obtain an injunction in this suit. It clearly ought to have such a remedy.

No authority is cited by the defendants in which it is held that an injunction will not lie in a case like the present. The cases cited for the defendants are cases where it has been held that workmen and employees will not be held liable for profits and damages, in a suit for the infringement of a patent. Under § 4,921 of the Revised Statutes, the authority of this Court, in a case arising under the patent laws, of which it has

jurisdiction, to grant an injunction, according to the course and principles of Courts of equity, to prevent the violation of any right secured by a patent, is entirely independent of the award of any other relief in the same suit.

The officers of the steamship company must have the same power to refuse to accept infringing cotton ties that they have to accept them. The defendant McCready does not disclaim such power to refuse. The cases of *Lightner* v. *Kimball*, (1 *Lowell*, 211,) and *Heaton* v. *Quintard*, (7 *Blatchf. C. C. R.*, 73,) are distinguishable from the present case.

As to the suggestion of hardship to the defendants and to their company, there can be no difficulty in so framing the order of injunction, that, with the coöperation of the agents of the plaintiff, there will be but little practical difficulty in securing obedience to the injunction without serious practical inconvenience to the defendants. The defendants' company will be deprived of no more carrying trade in respect to infringing ties, than they would be deprived of if the shippers of such ties were enjoined, and it must be presumed that they would be enjoined, if their names were known. The defendants' company could have caused such names to have been disclosed, on enquiry, but it did not. The allegation that the information was asked and refused is not denied.

The injunction asked for is granted.

S. A. Duncan, for the plaintiff.

F. D. Sturges, for the defendants.

THE AMERICAN DIAMOND ROCK BORING COMPANY

vs.

CHARLES SHELDON AND OTHERS. IN EQUITY.

Letters patent for an invention were granted in England, dated September 3d, 1862. The specification was filed in the Great Seal Patent Office there, March 3d, 1863. Letters patent for the same invention were granted by the United States, July 14th, 1863, for 17 years. The date of the application for the United States patent was not shown: *Held*,

(1.) That the date of the filing of the specification in England must be taken as the date of the patenting in England, for the purposes of § 6 of the Act of March 3d, 1839, (5 *U. S. Stat at Large*, 353;)

(2.) That the invention was, therefore, not patented in England more than six months before the United States patent was applied for, and so the Act of 1839 did not apply, and the United States patent was valid for 17 years from July 14th, 1863.

The burden of proof is upon a party who claims that a patent should be limited in duration, to show the facts which would limit it.

(Before WHEELER, J., Vermont, November 12th, 1879.)

WHEELER, J. This cause has been further heard upon a motion of the plaintiff for an injunction, which is opposed on the ground that the patent has expired. The patent was granted July 14th, 1863, for seventeen years, and would expire, according to its own terms, July 14th, 1880. English letters patent for the same invention were granted, dated September 3d, 1862, pursuant to which the specification was filed in the Great Seal Patent Office, March 3d, 1863.

The Act of July 4th, 1836, § 7, (5 *U. S. Stat. at Large*, 119,) provided for issuing patents if the inventions had not been patented or described in any printed publication in this or any foreign country, but, (§ 8,) that nothing in that Act should deprive an inventor of the right to a patent by reason of his having previously taken out letters patent in a foreign country, and the same having been published, at any time

within six months next preceding the filing of his specification. The Act of March 3d, 1839, § 6, (5 *U. S. Stat. at Large*, 354,) provided that no person should be debarred from receiving a patent for an invention by reason of the same having been patented in a foreign country *more* than six months prior to his application, but that, in all cases, every such patent should be limited to the term of fourteen years from the date or publication of such foreign letters patent. Patents were, at that time, granted for fourteen years, and might be extended seven years more. By the Act of March 2d, 1861, § 16, (12 *U. S. Stat. at Large*, 249,) all patents thereafter granted were to remain in force seventeen years, without extension. In *Weston* v. *White*, (13 *Blatchf. C. C. R.*, 364,) it was held, that the effect of the Act of 1861 was to change the term of fourteen years to seventeen, as well in respect to patents limited by prior foreign patents, as in respect to others. The defendants claim, that, under these statutes and that holding, this patent is limited to seventeen years from the date of the English patent, which would expire September 3d, 1879, or, at least, to seventeen years from the filing the full specification of that patent, which would expire March 3d, 1880. The plaintiff insists that it is not limited by that patent at all. The Act of 1839, by its express terms, applies only to patents for inventions patented in some foreign country more than six months prior to the application for a patent in this country. The date of the application in this country does not appear, but it must have been earlier than the date of the patent, or fully as early. Assuming that it was co-eval with the patent, then the question arises whether the invention was *patented* in England more than six months before that. The English patent was dated more than six months before, but the full specification was not filed until within six months before. English patents are granted upon condition that a full specification shall be filed at some time within six months from the date. (*Agnew on Pat.*, 322; Woodbury, J., in *Hogg* v. *Emerson*, 6 *How.*, 479.) As said by Grose, J., in *Hornblower* v. *Boulton*, (8 *D. & E.*, 105,) the

English patent was nothing without the specification, and the patentee could gain no advantage by it. The question is, was it *patented* there before the specification was filed. In *Howe* v. *Morton*, (1 *Fish. Pat. Cas.*, 586,) it was held, in an elaborate opinion, that an invention was not patented abroad until there was a full and perfected patent. And, in *Smith* v. *Goodyear Dental Vulcanite Co.*, (3 *Otto*, 486,) the question seems to be settled, or treated as settled before, in the same way. Mr. Justice Strong said, page 498: "Of the English patent of Charles Goodyear it is enough to say, that, though the provisional specification was filed March 14th, 1855, the completed specification was not until the 11th of September following. It was, therefore, on the last mentioned date that the invention was patented."

So, this patent does not depend at all upon the Act of 1839. It was grantable under the provisions of the Act of 1836, without resorting to the Act of 1839, and does not come within the latter Act. By the terms of the two Acts, inventions patented abroad more than six months before were limited to fourteen years from the date or publication of the foreign patent, while those patented abroad within six months before were not affected at all by the foreign patent. This patent is one of the latter class, and, so far as now appears, is good for the term of seventeen years from its date, under the Act of 1861. In *Weston* v. *White*, the foreign patent was several years before the application in this country.

This case, as it now stands upon this question, is open to the further remark, that the Act of 1839 applied only to patents for inventions patented in a foreign country more than six months prior to the application for the patent here. As the date of the application does not appear apart from the date of the patent, it does not appear that the date of, or the application for, the English patent was more than six months, or any other space of time, prior to the application here, unless the date of the patent is to be taken as the date of the application, upon this question. Upon a question of priority of invention, the presumption, in the absence of proof, would

be, that the application was of the same date as the patent; but there the burden of proof would be upon the party claiming a prior application describing the invention, to show it. Here, the burden rests upon the party claiming that the patent should be limited, to show the facts which would limit it. This would include showing the application, and that the invention was patented abroad more than six months prior to it. These essential facts, necessary to limit this patent, are lacking, so far as the English patent is concerned; and, as that is the only foreign patent shown by the record, for this invention, they are lacking, so far as this question, as now presented, is concerned. These considerations obviate all necessity for considering the question as to whether the term of the patent would begin to run from the date of the English patent, or from the time of the filing the full specification under it, which would arise, if this patent came within the Act of 1839, and was supposed to arise, until the connection and application of that Act were particularly noticed.

This objection is overruled, but the injunction is withheld to await the decision on a motion made by the defendants in respect to the French patent.

Charles F. Blake, for the plaintiff.

E. J. Phelps and *W. G. Veazey*, for the defendants.

In the Matter of the Petition of Frederick Pentlarge and William Beeston.

R. having sued F., in equity, for the infringement of a patent, F., in writing, admitted R's right, and agreed on the damages to be paid, and to consent to a decree therefor and for a perpetual injunction. Such consent was given and the decree was entered, the damages were paid, and the injunction was issued. Many terms of Court having elapsed since the entry of the decree, F.

In re The Petition of Frederick Pentlarge and William Beeston.

applied for leave to file a supplemental bill, to set aside the decree, on the ground that the agreement was entered into under a mistake of fact: *Held,*

(1.) That the application was really to file a bill of review and was too late, under Rule 88, in Equity;

(2.) That, the decree having been entered by consent, a bill of review to set it aside could not be entertained;

(3.) That the agreement operated as an estoppel.

(Before BENEDICT, J., Eastern District of New York, November 14th, 1879.)

BENEDICT, J. The petitioners, being parties defendant to an action brought against them by Rafael Pentlarge, to recover damages for the infringement of a certain patent, entered into a written agreement, under seal, with the plaintiff, wherein they expressly admitted the validity of the plaintiff's patent, and his exclusive right to the invention described therein, and agreed upon the amount of damages to be paid for their infringement, and to consent to a decree upholding the patent, and adjudging the sum of $2,000 to be due as damages, and awarding a perpetual injunction against future infringement by them. In accordance with this agreement, a consent to the decree described therein was given, and, upon it, such a decree was duly entered. The damages awarded by the decree were thereafter paid, and the perpetual injunction awarded by the decree was duly issued. The defendants now, many terms of Court having elapsed since the entering of the decree, apply, by petition, for leave to file a supplemental bill, for the purpose of procuring the decree so entered by consent to be set aside, upon the ground that the agreement above-mentioned was entered into under a mistake of fact. To such an application there are several fatal objections. In the first place, the application is, in substance, for leave to file a bill of review. It is, therefore, governed by the 88th Equity Rule, and comes too late. In the second place, a bill of review, for the purpose of setting aside a decree entered by consent, without fraud, will not be entertained. "A decree taken by consent cannot be set aside by a bill of review, or a bill in the nature of review." (2 *Daniell's Ch. Pr.*, *4th Am. ed.*, 1575; *French* v. *Shotwell*, 5 *Johns. Ch. R.*, 555.)

In the third place, so long as the agreement made between the parties, prior to the entry of the decree, stands, the admissions of the plaintiff's right to the patent sued on, and to his exclusive right to the invention described therein, made by the petitioners, and set forth in the agreement, under their hands and seals, must operate by way of estoppel, to prevent any different determination as to the plaintiff's right to the invention described in his patent, from that contained in the decree sought to be set aside. Either of these considerations is sufficient to compel a denial of the application. It is, therefore, denied.

Tracy, Brodhead & Allen, for the petitioners.

CLINTON G. COLGATE

vs.

THE INTERNATIONAL OCEAN TELEGRAPH COMPANY. IN EQUITY.

The defendant had, under an Act of the Legislature of Florida and an Act of the Congress of the United States, the exclusive right to lay and maintain a submarine telegraph cable between Florida and Cuba. In operating such cable it used an invention covered by letters patent owned by the plaintiff, granted after said Acts were passed: *Held*, that, although the plaintiff could not use the invention for telegraphic purposes between Florida and Cuba, he could enjoin the defendant from using such invention for such purposes between such *termini*.

(Before BLATCHFORD, J., Southern District of New York, November 15th, 1879.)

BLATCHFORD, J. The motion for a preliminary injunction in this case is opposed, on special grounds not involving the construction or validity of the plaintiff's patent, or the question of infringement.

The defendant is a corporation created under the laws of the State of New York, prior to January 2d, 1866. On that day an Act was passed by the Legislature of the State of Florida, granting to said corporation "the sole and exclusive right and privilege," for 21 years from the date of the Act, "of landing a submarine telegraphic cable or cables on the shore, sea coast, islands, keys, reefs or sand banks lying within the limits and jurisdiction of the State of Florida, and of connecting, by means of said submarine telegraphic cable or cables, the shore and sea coast of the State aforesaid with the island of Cuba." The same Act gave to the corporation power to connect the terminus of such submarine cable or cables, on the shore, by a land line, with the most convenient land telegraphic line, and, for that purpose, power to erect, maintain and operate telegraphic lines through the State of Florida, and across the islands, keys, sand banks and reefs belonging to said State, and over which said State has control and jurisdiction.

On the 5th of May, 1866, an Act was passed by the Congress of the United States, (14 *U. S. Stat. at Large*, 44,) granting to said corporation the sole privilege, for a period of 14 years from that day, "to lay, construct, land, maintain and operate, telegraphic or magnetic lines or cables, in and over the waters, reefs, islands, shores and lands, over which the United States have jurisdiction, from the shores of the State of Florida, in the said United States, to the island of Cuba and the Bahamas, either or both, and other West India Islands."

The corporation has, also, concessions from the Government of Spain in regard to the maintenance, in Cuba, of a submarine cable landed there.

The bill alleges, that the defendant, "at the city of New York and elsewhere, has, (particularly in the State of Florida, and the waters thereof, where said defendant uses and operates a telegraph cable extending to the island of Cuba, and also on the lines of telegraph connecting said cable with New York city and other points,) within the said Southern District of

New York and elsewhere," without license, ever since the date of the plaintiff's patent, made, used and sold the patented invention in insulating submarine cables or telegraphic wires, used in connection with the telegraphic lines of the defendant, and in insulating wires and other conductors of electricity, used in connection with electric or galvanic batteries and telegraphic instruments.

The defendant has been using, for telegraphic communication between Florida and Cuba, cables containing wires insulated by gutta percha, within the claim of the plaintiff's patent, and is now using such cables. The defendant contends, that, because of the exclusive grants to it from the State of Florida and the Congress of the United States, which were made before May 21st, 1867, the date of the issuing of the plaintiff's patent, the plaintiff has no right to use or operate his patented invention for telegraphic purposes between the shores of Florida and the island of Cuba, and, therefore, cannot enjoin the defendant from using such invention for such purposes between such *termini*. The proposition on the part of the defendant is, that, by the grants to it of the exclusive right, for a defined period of time, to lay telegraphic submarine cables, and maintain thereby telegraphic communication, between the State of Florida and the island of Cuba, it acquired the right to use without molestation all subsequently patented inventions in the construction of such cables, because the patentees of such inventions cannot lay such cables. In another form, it is contended, that, as the plaintiff has no right to use his patented invention in the place where the defendant is using it, he can recover no profits or damages for its use in that place, and, therefore, has no right in that place which can be protected by injunction.

The grants to the defendant are grants to lay a cable, not to lay a cable of a particular construction, nor to lay any cable the use of which would violate a patent either existing or subsequently granted. Neither the Government nor an agent of the Government, nor a private individual, whether claiming to act under the authority of the Govern-

ment or otherwise, can use a patented improvement without the license of the patentee. (*United States* v. *Burns*, 12 *Wall.*, 246; *Cammeyer* v. *Newton*, 4 *Otto*, 225, 235.) The power to prevent, by injunction, the violation of a right secured by a patent, is conferred by § 4,921 of the Revised Statutes, irrespective of any right, in the given suit, to recover profits or damages. The right of the plaintiff to use his patented invention where the defendant is using it, is exclusive as against the defendant, although the right of the defendant to lay and maintain a submarine telegraphic cable between Florida and Cuba may be exclusive as against the plaintiff. Such right of the plaintiff is a right secured by the patent. The distinction referred to is one which exists in all cases, under every patent. A defendant has an exclusive right, as against a patentee, to erect in his own house such structures as he pleases. The patentee cannot, against the will of the defendant or without his assent, erect in the house of the defendant any structure. Yet this does not give to the defendant the right to erect in his house a structure embodying the patented invention, or give him immunity from being restrained by injunction, at the suit of the patentee, from continuing the use of the patented invention in such structure.

The same order will be made in this case which was made in the case against The Western Union Telegraph Company.

Frederic H. Betts, for the plaintiff.

Clarence A. Seward, for the defendant.

THE UNITED STATES, PLAINTIFFS IN ERROR

vs.

FRANK PHELPS AND HOWARD PHELPS, DEFENDANTS IN ERROR.

One entry was made at the custom house of fruit imported in a vessel, which fruit belonged to several owners, and was embraced in several invoices. The duties were estimated at $4,648 and deposited and the goods were delivered. Afterwards a damage allowance for loss by decay on the voyage was applied for. The report showed that the damage sustained by various lots of the fruit was more than 25 per cent. of the quantities in such lots, but that the damage on all the fruit imported by the vessel was less than 25 per cent. of the whole quantity. The collector, by allowing the damage on the lots which were damaged more than 25 per cent., liquidated the duties at $270 40 less than the amount deposited, and refunded the $270 40. Afterwards the collector reliquidated the duties at $4,648, refusing to allow any damage, because it did not exceed 25 per cent. of all the fruit covered by the entry. The United States having sued, in the District Court, to recover the $270 40, that Court directed a verdict for the defendants. On a writ of error: *Held*,

(1.) That, under § 2,931 of the Revised Statutes, the first liquidation was not conclusive as to the United States;

(2.) That the United States were entitled to recover according to the last liquidation;

(3.) That the defendant could not be allowed to give evidence to show that the decision of the collector in the last liquidation was erroneous;

(4.) That the District Court ought to have directed a verdict for the United States.

(Before BLATCHFORD, J., Southern District of New York, November 24th, 1879.)

BLATCHFORD, J. This suit was brought in the District Court by the United States against the defendants in error, to recover $270 40 in gold coin, with interest from March 6th, 1878. The complaint alleges that the defendants, on the 6th of March, 1878, imported into the port of New York certain fruit, subject to duties, and entered it at said port; that, thereupon, the collector of said port decided that the amount of duties to be paid thereon was $4,648 in gold coin; and that the defendants have paid thereon $4,377 60 and no more.

The answer sets up, that the defendants paid, on entry, $4,648 in gold coin, as duties; that the defendants made a claim for an allowance of duties for damage to the fruit on the voyage; that the fruit was appraised and damage allowed; that the collector adjusted the duties and decided that the amount of duties was $4,377 60 in gold coin, and no more, and refunded to the defendants $270 40; and that the $4,377 60 was paid to and received by the United States in full settlement and payment of all the duties on said fruit.

The bill of exceptions sets forth, that, on the trial, the following facts were proved: On the 6th of March, 1878, the defendants imported into the port of New York, from foreign ports, by the steamship Olaf, 4,008 boxes and 2,227 cases of oranges. The oranges were shipped from Messina, Palermo and Valencia, and consigned by the several owners in those respective ports to the defendants at New York city, a separate invoice having been made for each separate lot or shipment by the several owners thereof, containing the date of shipment, the place from which shipped, the description and value of the goods so shipped, and the name of the owner or owners. There were in all eleven invoices of this character, upon which only one entry was made at the custom house. On the same day the duties upon the goods were estimated by the collector to be $4,648, which sum was then and there deposited with the collector, by the defendants, to secure the payment of the duties when finally ascertained, and the goods were delivered to the defendants, the consignees named in the entry. On the 12th of March, 1878, the defendants made an application for damage allowance for loss by decay of said fruit during the voyage. On the 26th of March, 1878, the report of the appraisers as to the amount of damage sustained by the said fruit on the voyage was made. Such report showed that the damage sustained by the various lots of the fruit was more than 25 *per centum* of the quantities contained in said several lots, but that the damage on all of the fruit imported by the Olaf was less than 25 *per centum* of the whole quantity imported. On this report, the collector, on

the first of April, 1878, by allowing the damage on the various lots which had sustained more than 25 *per centum* of damage, liquidated the duties on the said goods, and fixed the same at the sum of $4,394. This amount of money was applied by the collector to the payment of the duties, and the sum of $254 (being the difference between $4,394 and $4,648) was refunded by him to the defendants on the 29th of April, 1878. On the 10th of May, 1878, the defendants called the attention of the collector to an error in this liquidation, which was corrected and the duties were reliquidated at the sum of $4,377 60 and the further sum of $16 40 was refunded to the defendants. On the 6th of July, 1878, the defendants filed with the collector a protest, addressed to him, in which they said: "We do hereby protest against the present system of liquidating entries for damage on boxes and cases of green fruit, and particularly in the case of our entry per steamship Olaf, made March 6th, 1878, and liquidated about April 25th, and reliquidated on June 26th, both times incorrectly, so far as the method of adding boxes and cases together indiscriminately, as by so doing we have, in the last instance particularly, been credited with $16 40 instead of $61 60, as would appear if the cases were either considered separately or figured upon at their relative value. We, therefore, look to you to have the entry liquidated in such a way that we can have a correct return and have the proper amount due us returned." Thereafter, on July 19th, 1878, an order was made by the collector that the entry should be amended, and the proper amount of duty fixed. This amendment was thereupon made, and, on the 20th of July, 1878, the duties were fixed by the collector at the sum of $4,648, the amount originally deposited with the collector. On this liquidation the collector refused to allow any damage, because the amount of damage did not exceed 25 *per centum* of the whole quantity of fruit imported and covered by the entry. There was only one appraisal of the goods, and the different ascertainments or liquidations were all based upon the appraisers'

report of the damage sustained by the fruit on the voyage. The plaintiffs sued for $270 40 and $11 48 interest.

On the foregoing facts, the counsel for the defendants asked the Court to direct a verdict for the defendants. The counsel for the plaintiffs asked the Court to direct a verdict for the plaintiffs, for $281 88, on the grounds, (1.) That the last liquidation by the collector was final and conclusive in this action brought by the United States for duties; (2.) That, if such liquidation was not final and conclusive, the $270 40 was due from the defendants as duties on the goods imported. The Court denied the motion of the plaintiffs, and directed the jury to find a verdict for the defendants. To such refusal and direction the counsel for the plaintiffs duly excepted. The jury thereupon, under the direction of the Court, rendered a verdict in favor of the defendants. On this verdict a judgment was entered dismissing the complaint on the merits of the action, as against the plaintiffs.

It is contended, for the United States, that the Court should have directed the jury to find a verdict for the plaintiffs for the full amount claimed, because the $270 40 was proved to be a part of the ascertained or liquidated duties on the goods imported by the defendants; that the fact that the duties had been twice previously liquidated did not deprive the collector of power to make the last liquidation; and that it was within his authority, on the same facts, to change his interpretation of the law, and correct the mistake he had made.

It is well settled, that the duties due upon all goods imported constitute a personal debt due to the United States from the importer; that the consignee is, for this purpose, treated as the owner and importer; that such debt is independent of any lien on the goods and of any bond given for the duties; and that the right of the Government to the duties accrues when the goods have arrived at the proper port of entry. (*Meredith* v. *The United States*, 13 *Peters*, 486.) By section 2,931 of the Revised Statutes the decision of the collector, in liquidating duties, as to the amount of

duties on imported goods, is made final and conclusive against all persons interested in such goods, unless notice in writing of dissatisfaction with such decision is given to the collector, by the importer, within 10 days after the liquidation, and unless within 30 days after the liquidation there is an appeal by the importer from the liquidation to the Secretary of the Treasury. Such liquidation is not made final and conclusive as against the United States. There is nothing in the section which forbids a reliquidation or a new decision by the collector, even after the payment of all the duties fixed by a prior liquidation, or even after the refunding of money deposited beyond the amount of duties so fixed; or which forbids a new decision by the collector as to the law on the same facts, or a new decision as to facts, based on additional or new or different facts. This view is confirmed by the enactment of section 21 of the Act of June 22d, 1874, (18 *U. S. Stat. at Large*, 190,) which is as follows: "Whenever any goods, wares and merchandise shall have been entered and passed free of duty, and whenever duties upon any imported goods, wares and merchandise shall have been liquidated and paid, and such goods, wares and merchandise shall have been delivered to the owner, importer, agent or consignee, such entry and passage free of duty and such settlement of duties shall, after the expiration of one year from the time of entry, in the absence of fraud and in the absence of protest by the owner, importer, agent or consignee, be final and conclusive upon all parties." This provision was in force when the transactions in this case took place. It applies to the United States. The expression "all parties," includes the United States. By section 2,931 of the Revised Statutes, there was no limitation imposed on the power of the collector to reliquidate, when such reliquidation was in the interest of the Government. But, by section 21 of the Act of 1874, a limitation is imposed on such power, so that, after the entry of goods, and after the liquidation and payment of duties on them, and after the delivery of the goods to the importer, such settlement of duties, if there be no fraud and no protest by the importer, is, after

one year from the entry, final and conclusive even as respects the Government. In the present case, the suit was brought before the one year expired. The collector, therefore, had power to make the reliquidation of July 20th, 1878; and there is nothing in the provisions of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 469,) which affects such power. The complaint counts on such reliquidation, as made on the importation and entry of goods subject to duty.

The reliquidation at $4,648 being lawful, such reliquidation stands for the purposes of this suit as if it was the only liquidation. On a liquidation, the United States is entitled to recover, in a suit against the importer or consignee, under section 2,931 of the Revised Statutes, formerly section 14 of the Act of June 30th, 1864, (13 *U. S. Stat. at Large*, 214,) the amount liquidated, as duties, and evidence in such suit, on the part of the defendant, to show that the decision of the collector was wrong, cannot be received. The only remedy of the importer is in a suit to recover back the duties, after paying them, in a case where such a suit is allowed by the statute. This was the ruling in *United States* v. *Cousinery*, (7 *Benedict*, 251,) in the District Court for this District, following the decision of the Supreme Court in *Westray* v. *The United States*, (18 *Wallace*, 322.) Such ruling was approved by Chief Justice Waite, in *Watt* v. *The United States*, (15 *Blatchf. C. C. R.*, 29,) and must be held to be the law, until it is reversed.

For these reasons, it was error in the Court below to refuse to direct a verdict for the plaintiffs, and error to direct a verdict for the defendants. The first ground urged by the counsel for the plaintiffs, as a ground for directing a verdict for the plaintiffs, was a sound one, namely, that the last liquidation by the collector was final and conclusive against the defendants in this suit; and it is unnecessary to consider the question as to whether the collector was wrong in refusing to allow any damage, on the last liquidation.

The judgment is reversed, with costs to abide the event,

and a direction to the Court below to enter an order granting a new trial.

J. Dana Jones, (*Assistant District Attorney*,) for the plaintiffs in error.

A. J. Heath, for the defendants in error.

MAX ROSENTHAL

vs.

THE MASTIN BANK AND OTHERS. IN EQUITY.

A bank in Missouri, having money on deposit in a bank in New York, to the amount of over $2,000, drew a draft on the latter on August 1st, for the sum of $1,998, to the order of R., for which R. paid the former $2,000. On the 3d of August, the Missouri bank assigned to C. all its property, in trust for its creditors, by an assignment valid by the laws of Missouri, and the New York bank was notified of such assignment on the same day. On the 5th of August the draft was presented by R. to the New York bank. Payment of it was refused. R., on the 5th of August, attached the money held by the New York bank, by judicial process, in a suit against the Missouri bank, on the draft, and afterwards recovered a judgment therein. He then brought this suit against the two banks and C., to have the $1,998 paid to him. On a demurrer to the bill: *Held*, that the right of C. to the money was superior to that of R.

The draft was not accepted by the drawee, nor charged by it against the drawer, nor did the draft operate as an assignment of the funds of the drawer in the hands of the drawee.

(Before BLATCHFORD, J., Southern District of New York, November 25th, 1879.)

BLATCHFORD, J. This is a suit in equity brought by the plaintiff, a citizen of New York, against the Mastin Bank, a Missouri corporation, and Kersey Coates, a citizen of Missouri, and the Metropolitan National Bank, a banking corpor-

ation established under an Act of Congress and doing business in the city of New York. The suit was brought in the Supreme Court of New York, and was removed into this Court by the plaintiff.

The facts of the case are these: On the 1st of August, 1878, the plaintiff, at Kansas City, Missouri, paid to the Mastin Bank, which was located there, the sum of $2,000, in exchange for which said bank delivered to him a draft dated at Kansas City, August 1st, 1878, and signed by its cashier, addressed to the Metropolitan National Bank, New York, and containing this direction: "Pay to the order of Max Rosenthal nineteen hundred and ninety-eight dollars." At that time the Metropolitan National Bank had in its hands the sum of $1,998 belonging to the Mastin Bank. Said draft was presented to the Metropolitan National Bank on the 5th of August, 1878, by the plaintiff, and payment of it was demanded, but said bank refused to pay it, or to pay the $1,998, and the draft was protested and notice of such presentment, refusal and protest was given to the Mastin Bank. The Metropolitan National Bank then had, and ever since has had, and now has, the said sum of $1,998 in its possession. After such demand and refusal the plaintiff commenced a suit in the Supreme Court of New York for the city and county of New York, against the Mastin Bank, in which suit moneys belonging to the Mastin Bank in the hands of the Metropolitan National Bank were attached, and thereupon the latter bank gave to the sheriff a certificate, dated August 5th, 1878, which said: "We hold twenty-three hundred dollars from funds to the credit of the Mastin Bank, Kansas City, Mo., in matter of attachment of Max Rosenthal, plaintiff, for nineteen hundred and ninety-eight dollars." On the 17th of October, 1878, the plaintiff recovered judgment in said suit for $2,133 15. On the next day the sheriff, in behalf of the plaintiff, demanded the amount of said judgment from the Metropolitan National Bank, but said bank refused to pay it, stating that the money was claimed by the defendant Coates, as assignee of the Mastin Bank by virtue of an assignment

made August 3d, 1878, at Kansas City, by the Mastin Bank to said Coates. Coates claims said $1,998 by virtue of such assignment. The assignment is dated August 3d, 1878, and assigns to said Coates "all of the lands, tenements, goods, chattels, effects and credits of the said the Mastin Bank, of every kind and nature, wheresoever situate, to have and to hold the same, unto him, the said Kersey Coates, and his heirs, successors and assigns, in trust for the use and benefit of all the creditors of the said the Mastin Bank, in proportion to their respective claims, as by the law in case of voluntary assignments made and provided." By a paper at the foot of said assignment, dated the same day and signed by said Coates, he accepted said trust. The assignment and acceptance were recorded on the same day. The Metropolitan National Bank was notified of said assignment on the 5th of August, 1878, by a telegram. The bill claims, that, by the delivery of the draft to the plaintiff the Mastin Bank transferred to him $1,998 out of its moneys which were then in the hands of the Metropolitan National Bank, and that he is the owner of the said $1,998. By a stipulation, all of the defendants waive the right of a trial at law, and the plaintiff agrees that the sheriff will not bring any action against the Metropolitan National Bank by reason of any of the matters in issue in this suit. The prayer of the bill is, that, the said sum of $1,998 may be adjudged to be the property of the plaintiff, and may be paid by the Metropolitan National Bank to the plaintiff, free from any claims or liens thereon of the defendant Coates, or any of the other defendants. The Mastin Bank and Coates have put in a joint and several general demurrer to the bill for want of equity, and the Metropolitan National Bank has also demurred generally to the bill for want of equity.

The question presented for decision is, whether the Metropolitan National Bank ought to pay the $1,998 which it owes, as a debtor, to the plaintiff. It is contended, for the plaintiff, that he could have sued the drawee, on the draft, before its acceptance, and even before presenting it to the drawee, and that the assignment to the defendant Coates, after the draw-

ing of the draft and before it was presented to the drawee, did not carry to Coates the title to the $1,998, or affect the right of the plaintiff thereto; that Coates took the property of the assignor, under the assignment, subject to all the equities existing against it in favor of the plaintiff; that Coates succeeded only to the rights of the assignor; and that the drawing of the draft operated as an assignment to the plaintiff of $1,998 then in the hands of the drawee.

It was decided by the Supreme Court of the United States, in *Bank of the Republic* v. *Millard*, (10 *Wallace*, 152,) that the holder of a check drawn on a bank cannot sue the bank for refusing payment of it, in the absence of proof that it was accepted by the bank, or was charged against the drawer. In that case the Court say: "It is no longer an open question in this Court, since the decision in the cases of *The Marine Bank* v. *The Fulton Bank*, (2 *Wallace*, 252,) and of *Thompson* v. *Riggs*, (5 *Id.*, 663,) that the relation of banker and customer, in their pecuniary dealings, is that of debtor and creditor. It is an important part of the business of banking to receive deposits, but, when they are received, unless there are stipulations to the contrary, they belong to the bank, become part of its general funds, and can be loaned by it as other moneys. The banker is accountable for the deposits which he receives, as a debtor, and he agrees to discharge these debts by honoring the checks which the depositors shall, from time to time, draw on him. The contract between the parties is purely a legal one, and has nothing of the nature of a trust in it. This subject was fully discussed by Lords Cottenham, Brougham, Lyndhurst and Campbell, in the House of Lords, in the case of *Foley* v. *Hill*, (2 *Clark & Finnelly*, 28,) and they all concurred in the opinion, that the relation between a banker and a customer who pays money into the bank, or to whose credit money is placed there, is the ordinary relation of debtor and creditor, and does not partake of a fiduciary character, and the great weight of American authority is to the same effect. As checks on bankers are in constant use, and have been adopted by the commercial world generally, as

a substitute for other modes of payment, it is important, for the security of all parties concerned, that there should be no mistake about the status which the holder of a check sustains towards the bank on which it is drawn. It is very clear that he can sue the drawer, if payment is refused, but can he, also, in such a state of case, sue the bank? It is conceded, that the depositor can bring assumpsit for the breach of the contract to honor his checks, and, if the holder has a similar right, then the anomaly is presented, of a right of action upon one promise, for the same thing, existing in two distinct persons, at the same time. On principle, there can be no foundation for an action on the part of the holder, unless there is a privity of contract between him and the bank. How can there be such a privity when the bank owes no duty, and is under no obligation to the holder? The holder takes the check on the credit of the drawer, in the belief that he has funds to meet it, but in no sense can the bank be said to be connected with the transaction. If it were true, that there was a privity of contract between the bank and the holder when the check was given, the bank would be obliged to pay the check, although the drawer, before it was presented, had countermanded it, and although other checks, drawn after it was issued, but before payment of it was demanded, had exhausted the funds of the depositor. If such a result should follow the giving of checks, it is easy to see that bankers would be compelled to abandon altogether the business of keeping deposit accounts for their customers. If, then, the bank did not contract with the holder of the check to pay it, at the time it was given, how can it be said that it owes any duty to the holder until the check is presented and accepted? The right of the depositor, as was said by an eminent judge, (Gardiner, J., in *Chapman* v. *White*, 2 *Selden*, 417,) is a chose in action, and his check does not transfer the debt, or give a lien upon it, to a third person, without the assent of the depositary. This is a well-established principle of law, and is sustained by the English and American decisions. (*Chapman* v. *White*, 2 *Selden*, 412; *Butterworth* v.

Peck, 5 *Bosworth*, 341; *Ballard* v. *Randall*, 1 *Gray*, 605; *Harker* v. *Anderson*, 21 *Wendell*, 373; *Dykers* v. *Leather Mfg. Co.*, 11 *Paige*, 616; *National Bank* v. *Eliot Bank*, 5 *American Law Register*, 711; *Parsons on Bills and Notes*, *ed. of* 1863, *pp.* 59 *to* 61, *and notes; Parke, Baron, in argument, in Bellamy* v. *Majoribanks*, 8 *Eng. Law and Eq.*, 522, 523; *Wharton* v. *Walker*, 5 *Barn. & Cress.*, 163; *Warwick* v. *Rogers*, 5 *Mann. & Gr.*, 374; *Byles on Bills, chapter Check on a Banker; Grant on Banking, London edition*, 1856, 96.) The few cases which assert a contrary doctrine it would serve no useful purpose to review." The decision in the case cited is for this Court the law of this case. So far, then, as this suit is a suit on the draft against the drawee, to recover the amount of the draft, it cannot be maintained, for, the draft was not accepted by the drawee, nor was it charged by the drawee against the drawer. The draft was a draft or check in the ordinary form, not describing any particular fund, or using any words of transfer of the whole or any part of any amount standing to the credit of the drawer, but containing only the usual request. Under the settled law of New York, where the draft was payable, this was not an assignment of the funds of the drawer in the hands of the drawee. (*Atty.-Gen.* v. *Continental Life Ins. Co.*, 71 *N. Y.*, 325, 330, 331.) Before the draft was accepted the drawer could withdraw the deposit or countermand the draft.

In this case, before the draft was presented to the drawee, the drawer assigned to the defendant Coates the entire debt due to it from the drawee, being a sum larger than the amount of the draft, as would appear from the certificate given to the sheriff by the drawee, and including the $1,998 which the plaintiff claims to recover from the drawee in this suit. The validity of this assignment, as a lawful instrument under the laws of Missouri, is not attacked or impeached by any pleading or evidence in this case. The assignment is one of "all of the lands, tenements, goods, chattels, effects and credits" of the Mastin Bank, "wheresoever situate," "in trust for the use and benefit of all the creditors of the said

the Mastin Bank, in proportion to their respective claims, as by the law, in case of voluntary assignments, made and provided." The debt from the Metropolitan National Bank to the Mastin Bank was a debt due from a bank located in this State, and was property in this State belonging to the Mastin Bank. The assignment from the latter bank to Coates, being a voluntary conveyance, valid by the laws of Missouri, as must be assumed, operated to transfer to the assignee the debt due to the assignor from the Metropolitan National Bank, and, as such assignment was prior in time to the attachment of the plaintiff, the latter cannot hold the debt attached, as against the claim of the defendant Coates under the assignment. It does not appear that the assignment to Coates is invalid under any statute or other law of this State. (*Ockerman* v. *Cross*, 54 *N. Y.*, 29.)

There is nothing in the terms of the certificate given by the Metropolitan National Bank to the sheriff which gives to the plaintiff any greater rights than he otherwise would have had. The attachment was against money due as a debt to the Mastin Bank, and the certificate merely set apart so much money to answer the plaintiff's claim, if established. Nor is it material that Coates did not receive payment of the debt from the Metropolitan National Bank before the attachment was levied. There is nothing which shows that the attachment was levied, or that the draft was even presented, before the drawee was notified of the assignment.

The demurrers are allowed, with costs to the defendants, to be taxed, with leave to the plaintiff to move, on notice, on payment of such costs, within 20 days after service of a copy of the order to be entered on this decision, to amend the bill.

John Henry Hull and *Joseph I. Stein*, for the plaintiff.

Holmes & Adams, for the Mastin Bank and Coates.

Peabody, Baker & Peabody, for the Metropolitan National Bank.

GEORGE C. GREGORY, PLAINTIFF IN ERROR

vs.

THE UNITED STATES, DEFENDANTS IN ERROR.

Under that part of § 3,281 of the Revised Statutes which forfeits personal property owned by a person who has permitted or suffered his premises to be used for purposes of ingress or egress to or from an illicit distillery, it is necessary, in order to such forfeiture, that such person should have known that the ingress or egress over his premises was to or from a distillery.

(Before BLATCHFORD, J., Southern District of New York, November 28th, 1879.)

BLATCHFORD, J. The plaintiff in error (the claimant below) was the owner of the lot of land and buildings No. 419 East 48th street, in the city of New York. On that lot, in front and adjoining No. 421, was a dwelling house. On the west part of the lot 419 was a covered drive-way leading from a rear building to the street in front. The rear building covered the rear part of the lot 419 and extended eastward over the rear part of lot 421, which latter lot belonged to a Savings Bank. In this rear building there was no partition, the ground floor being one large room. An illicit still, in use as part of a distillery, was found and seized in the rear building in the part of it which was on the lot 419, and mash tubs were found and seized in the rear building on the continuation of the partition line between the front buildings on the lots 419 and 421. Between the front building on the lot 421 and the rear building was an open yard. Between the front part of the covered drive-way on the lot 419 and the rear building was a covered one story shed. Between the rear of the dwelling house on the lot 419 and the rear building were stalls. In these stalls were found and seized a horse, a truck and a lot of harness, belonging to the claimant. He used the covered drive-

way for ingress and egress between the stalls and the street. His business was that of a builder. An agent for the bank had, at its request, found a tenant for the rear building, at the rent of $40 a month. The claimant, in consideration of his receiving one-half of such rent, consented to the tenancy, and that the tenant should use such covered drive-way for ingress and egress between the street or front and such rear building. The claimant was informed that the rear building was to be used as a vinegar factory. The tenant set up the illicit distillery in the rear building, and used such covered drive-way for ingress and egress thereafter, between the street in front and such illicit distillery. The question tried in the Court below was as to the forfeiture of the horse, truck and harness. The claimant was called as a witness on his own behalf, and, in the course of his direct examination, he was asked this question: "Did you know that this building was being used as a still?" This question was objected to by the counsel for the United States, as immaterial under sections 3,281 and 3,242 of the Revised Statutes of the United States. The objection was sustained by the Court, and the counsel for the claimant excepted to the ruling. At the close of the evidence the counsel for the United States moved that a verdict be directed for the United States. Thereupon the counsel for the claimant asked leave to go to the jury on the case generally, and as to whether the claimant permitted the drive-way to be used for the purpose of ingress or egress to or from a distillery. The Court denied such request, and the counsel for the claimant excepted to such refusal. The Court thereupon granted the motion of the counsel for the United States, under section 3,281 of the Revised Statutes, and the counsel for the claimant excepted to such decision. Thereupon, the Court directed a verdict for the United States, condemning said horse, truck and harness, and the counsel for the claimant excepted. The jury found such verdict and a decree of condemnation was entered thereon.

Section 3,281 of the Revised Statutes is in these words: "Every person who carries on the business of a distiller with-

out having given bond as required by law, or who engages in or carries on the business of a distiller with intent to defraud the United States of the tax on the spirits distilled by him, or of any part thereof, shall, for every such offence, be fined not less than one thousand dollars nor more than five thousand dollars and imprisoned not less than six months nor more than two years. And all distilled spirits or wines, and all stills or other apparatus fit or intended to be used for the distillation or rectification of spirits, or for the compounding of liquors, owned by such person, wherever found, and all distilled spirits or wines and personal property found in the distillery or in any building, room, yard, or inclosure connected therewith, and used with or constituting a part of the premises, and all the right, title and interest of such person in the lot or tract of land on which such distillery is situated, and all the right, title and interest therein of every person who knowingly has suffered or permitted the business of a distiller to be there carried on, or has connived at the same; and all personal property owned by or in possession of any person who has permitted or suffered any building, yard or inclosure, or any part thereof, to be used for the purposes of ingress or egress to or from such distillery, which shall be found in any such building, yard or inclosure, and all the right, title and interest of every person in any premises used for ingress and egress to or from such distillery, who has knowingly suffered or permitted such premises to be used for such ingress or egress, shall be forfeited to the United States."

The claimant has brought a writ of error. It is contended for the claimant, that, as soon as the distillery was established, his license was at an end; that his knowledge as to the use to which the building was put was material; that he granted a right of way to a vinegar factory and not to a distillery; and that he never permitted or suffered the drive-way to be used for purposes of ingress or egress to or from the distillery.

For the United States it is contended, that the provisions of section 3,281, with regard to forfeiture of personalty and realty, are carefully distinguished; that the word "know-

ingly" is inserted wherever realty is referred to, and omitted wherever personalty is referred to; that the words used relative to personalty found on premises used for ingress and egress, and those used relative to realty used for ingress and egress, are the same, except as to the word "knowingly;" that such difference was intentional, and must, if possible, be made effective; that it cannot be made effective except by the ruling made in the Court below; that it is not contended for the United States that the words "permit" and "suffer" do not imply knowledge, but it is contended that it is sufficient knowledge if the claimant knew that the illicit distiller was obtaining ingress and egress to and from the building where his illicit work was carried on, and allowed him to do so; that, under such circumstances, he permitted such distiller to use the inclosure for ingress and egress to and from the distillery, even though he had no knowledge that there was a distillery there; that the position of the claimant is, that the words "suffer" and "permit" necessarily and of themselves import knowledge, and that the word "knowingly" cannot add to such meaning, nor can its absence take away from such meaning; that such position makes the peculiarity of the use of the word "knowingly" unmeaning and ineffectual; that it is enough that the claimant permitted ingress and egress to and from the building in the rear, and that there was in that building an illicit still; that the purpose of the permission is not material, where personalty is concerned; and that such purpose becomes material only when a question arises as to the forfeiture of realty.

Section 3,281 contains various provisions for forfeiture. It forfeits (1) spirits and distilling apparatus owned by the illicit distiller, wherever found; (2) all spirits and personal property found on the premises of the illicit distillery; (3) the interest of the illicit distiller in the distillery premises; (4) the interest in the distillery premises of every person who knowingly has suffered or permitted the business of a distiller to be there carried on or has connived at the same; (5) all personal property found in any building, yard or inclosure,

owned or possessed by any person who has permitted or suffered such building, yard or inclosure to be used for purposes of ingress or egress to or from the illicit distillery; (6) the interest in any premises used for ingress or egress to or from the illicit distillery, of every person who has knowingly suffered or permitted such premises to be used for such ingress or egress. Knowledge of the use of the place as a distillery, at least, whether in an unlawful manner or not, seems to be clearly predicated in all these cases except the fifth. The illicit distiller knows of his own fraud, it is presumed, and so his spirits and apparatus are forfeited, wherever found. The owner of all spirits and personal property found on the premises of the illicit distillery, is held to forfeit it, on the view, that, being on the premises, it is presumed to be used in the illicit business or to be its product, and that its owner is bound to know that it is in a distillery. The interest of the illicit distiller in the distillery premises is forfeited, because he is presumed to know of the fraud. The interest in such premises of every person who knowingly has suffered or permitted the business of a distiller to be there carried on, or has connived at the same, is forfeited, because, knowing that the place was used for a distillery and permitting it to be so used, he is made responsible for its use in a fraudulent manner. The interest in any premises held for ingress or egress to or from the illicit distillery, of every person who has knowingly suffered or permitted such premises to be used for such ingress or egress, is forfeited, because, knowing that the place was used for a distillery and permitting his premises to be used for ingress and egress to and from such distillery, he is made responsible for its use in a fraudulent manner. In every one of these five cases there is to be knowledge that there is a distillery. Yet it is claimed by the United States, that, under the fifth clause of the section, it is not necessary that the owner of the personal property should know that the ingress and egress over his premises is to and from a distillery. This difference is predicated on the absence of the word "knowingly" in the fifth clause, when it is found in the fourth and

sixth clauses; and it is claimed to be enough that the owner of the personal property knows of the abstract ingress and egress and allows it, even though he does not know that it is ingress and egress to and from a distillery. Under this view the same duty would have been cast on the claimant if he had not owned the rear building. In either case it is claimed that, having given a right of way to a building which he was told was to be used as a vinegar factory, he was bound to see that it was not used as an illicit distillery.

In the ordinary use of language, when it is said that a person permits or suffers premises to be used for egress and ingress to and from a distillery, the meaning is, that he knows that the ingress and egress are to and from a distillery, that there is a distillery, and, that, knowing there is a distillery, he permits the ingress and egress, and intends that the ingress and egress shall be to and from the distillery. The permission, sufferance, allowance, authority and license are predicated quite as much on knowledge that there is a distillery as on knowledge that there are ingress and egress. The distinction in this case is sought to be founded on the absence of the word "knowingly." But, it would be more in harmony with the purview of the whole section, and with the natural meaning of the words "suffer" and "permit," to hold that the word "knowingly," where it occurs, can have no reasonable meaning as adding to the force of the words "suffer" and "permit," and should be rejected there as surplusage. The word "knowingly," where it is used, is used to qualify the word "suffered" and the word "permitted." The words are "knowingly has suffered or permitted" and "has knowingly suffered or permitted." The word "*permit*" is defined thus: "To grant permission, liberty or leave; to allow; to suffer; to tolerate; to empower; to license; to authorize." The word "*suffer*" is defined thus: "To allow; to admit; to permit." The word "*admit*" is defined thus: "To permit; to suffer; to tolerate." The word "*allow*" is defined thus: "To suffer; to tolerate." The word "*tolerate*" is defined thus: "To allow so as not to hinder; to permit as something

not wholly approved; to suffer; to endure; to admit." Every definition of "suffer" and "permit" includes knowledge of what is to be done under the sufferance and permission, and intention that what is done is what is to be done. When it is said that a person suffers or permits a yard to be used for purposes of ingress and egress to and from a distillery, his sufferance or permission must be applied to the whole subject-matter, and he does not suffer or permit the ingress and egress to and from the distillery, unless he is conscious that there is a distillery as well as ingress and egress. It is not said that he does any more, when it is said that he knowingly suffers or permits a yard to be used for purposes of ingress and egress to and from a distillery.

There is nothing in the decision in the case of *The United States* v. *The Distillery at Spring Valley*, (11 *Blatchf. C. C. R.*, 255,) which is inconsistent with the foregoing views. The decision there, so far as it was on the 44th section of the Act of July 20th, 1868, (15 *U. S. Stat. at Large*, 142,) now section 3,281 of the Revised Statutes, was, that that section, in providing for the forfeiture of the interest in the land on which a distillery is situated, of every person who knowingly has suffered or permitted the business of a distiller to be there carried on, or who has connived at the same, does not require that he should have knowingly suffered or permitted it to be fraudulently carried on or that he should have connived at such fraud. Indeed, the Court, (at page 267,) when citing the provisions of said section 44 which form clauses five and six thereof, as above set forth, couples them together and remarks that they provide for "the knowing permission or sufferance of the use for, or in aid of, the business of distilling."

On the whole, I am of opinion that the question asked of the claimant and excluded was improperly excluded; that it was a question for the jury whether the claimant knowingly or consciously suffered or permitted the drive-way to be used for the purpose of ingress or egress to or from a distillery, knowing or being conscious that there was a distillery in the

rear building; and that it was error to direct a verdict for the United States.

The judgment below is reversed, with a direction to the Court below to enter an order granting a new trial.

Louis F. Post, for the plaintiff in error.

Edward B. Hill, (*Assistant District Attorney*,) for the defendants in error.

EDWARD PENROSE *vs.* THOMAS B. PENROSE.

An injunction will not be granted to restrain a defendant from proceeding in the State Court in a cause which the plaintiff claims has been removed into this Court, although the jurisdiction of this Court over the cause is clear, and the State Court has refused to make an order for the removal of the cause, and the defendant has noticed the cause for trial in the State Court.

Such injunction is not required to uphold the jurisdiction of this Court over the cause.

(Before BENEDICT, J., Eastern District of New York, November 29th, 1879.)

BENEDICT, J. This is a motion for an injunction to restrain the defendant from taking further proceedings in this cause in the State Court, where, as it appears, the defendant has noticed the cause for trial at the November term. The facts stated in the affidavit read in opposition to this motion afford no ground upon which to deny the jurisdiction of this Court. No defect in the proceeding taken to remove the cause has been called to my attention, nor do the facts stated in regard to what has occurred in the cause afford any ground upon which to deny that jurisdiction of this Court over the cause is complete. It appears, from the moving papers, that the State Court has denied the application of the defendant for an order directing the removal of the cause, but no copy

of the opinion of the Judge assigning his reasons for refusing the order of removal has been furnished me. I am, therefore, without information as to any fact upon which to determine that the cause has not been removed to this Court. It is well settled, that no order of the State Court directing the removal is necessary, and, as before stated, no defect in the proceedings taken to effect the removal has been pointed out. I cannot, therefore, deny this motion upon the ground of want of jurisdiction over the cause. I must, however, deny it upon the ground that the injunction asked for is not required to uphold the jurisdiction of this Court over the cause. The practice in cases like this has been settled for this Court, in the case of *Fisk* v. *The Union Pacific R. R. Co.*, (6 *Blatchf. C. C. R.*, 362,) where an application similar to the present was denied. Upon the authority of that case the present motion must be denied.

Henry C. Place, for the plaintiff.

Peckham & Tyler, for the defendant.

EBENEZER BLACKMAN AND OTHERS

vs.

JOSEPH H. HIBBLER AND OTHERS. IN EQUITY.

The re-issued letters patent No. 7,417, granted to Ebenezer Blackman, December 5th, 1876, for improvements in lamps for burning coal oil, on the surrender of original letters patent No. 123,825, granted to said Blackman February 6th, 1862, are invalid, as respects claims 1, 2, 4 and 5.

The claims of the re-issue are not for the same invention described in the original patent.

The specification of the original patent describes the invention as the use, only in combination, of a glass chimney base and a mica chimney top, and does not

suggest the use of the base as a separate device. Therefore, all claims, in the re-issue, to the use of the base by itself, are invalid.

Claims 1, 2, 4 and 5 of the re-issue are void for want of novelty.

(Before BENEDICT, J., Eastern District of New York, December 5th, 1879.)

BENEDICT, J. This is a suit in equity brought to obtain an injunction, and to recover damages, for an alleged infringement by the defendants of a patent re-issued to Ebenezer Blackman, December 5th, 1876, known as re-issue No. 7,417. The invention is stated in this re-issue to be "a glass base for coal oil burners, so constructed as to fit on a lamp or burner, in a manner similar to ordinary glass chimneys, and having a laterally projecting flange or rim, to support a chimney or reflector; also, in the combination of said base with a coal oil burner; and, also, the combination of said base with a burner and a chimney or reflector, as hereinafter more fully explained." Accompanying this description are drawings showing the base of a lamp chimney from various points of view. The inventor disclaims a chimney base incapable of transmitting light through it, and without such a tubular body as is required to support it on a coal oil lamp and to direct the current of air to the flame. Of the six claims in this re-issue, only the 1st, 2d, 4th and 5th need be mentioned here, those being the claims alleged to have been infringed by the defendants. The first claim is as follows: "A glass base for coal oil burners, constructed with a tubular body to fit around the cone or burner, and having a laterally projecting flange, substantially as and for the purpose set forth." The second claim is as follows: "A glass base having the contraction, I, and the laterally projecting flange *h*, substantially as described." The fourth claim is as follows: "A transparent base for a coal oil lamp chimney, having a tubular body of suitable form and length to fit and support it on the lamp, and having a laterally projecting flange, *h*, substantially as described." The fifth claim is as follows: "The combination of a transparent base, having a tubular body, B, of suitable form and length to adapt it to be used on a coal oil lamp, and

a laterally projecting flange, *h*, with a chimney, substantially as described." In regard to these claims it is to be observed, that the first, second and fourth are each for a contrivance variously styled a "glass base for coal oil burners," a "glass base" and a "transparent base for a coal oil lamp chimney," but more properly styled a chimney base, capable of use only when forming a part of a lamp chimney. The fifth claim is for a combination consisting of two elements—one, a chimney base, as described, the other, a chimney top of any form.

The first question presented is, whether these claims are for the same invention described in the original patent; for, if not, they are void and afford no cause of action to the plaintiffs. An examination of the terms of the original patent, therefore, becomes necessary. The original patent was issued to Ebenezer Blackman, February 6th, 1862, and is known as original patent No. 123,325. The specification of that patent gives, first, a description of what is styled the "chimney proper," elsewhere styled by the inventor "the body of the chimney," and by his counsel, on this argument, the "top piece," but what would be accurately styled a "chimney top." This chimney proper, top piece or chimney top is described as constructed of two sheets of mica whose vertical edges are united by a metal strip, and then bent so as to form a tube, and having at the bottom projections, whereby, as the patent states, "to fasten the mica chimney (top) securely to the glass base." Next follows a description of the chimney base, "that is to say, its upper portion is made of a suitable size and form to fit the chimney (top) and its lower portion to fit the lamp, and between the upper and lower portion it is contracted by an external groove, the upper portion flaring or inclined outward." Then follows this significant statement: "In use, the chimney and base are intended to remain united, the whole being put on or taken off together." Two claims follow: "First. A lamp chimney, consisting of sheets of mica united by means of the double and indented or perforated metal strips, *b*, and provided with means for attaching it to the base, B, substantially as de-

scribed. Second. A glass base, B, having the contraction, I, and the flaring top, *h*, constructed and arranged to operate substantially as set forth." It will be observed, from this statement in regard to the original patent, that the thing described in the original specification is a contrivance adapted to produce a draft of air around the flame of a lamp; in other words, a lamp chimney. This contrivance is described by describing first its top and then its base, accompanying the description of the two parts with the statement, that these parts are to remain united, and so form a compound unit, which is the subject of the patent. The subject-matter of the original patent is the contrivance, as a whole, described as, and being in fact, a lamp chimney; or a combination, the elements of which are the glass chimney base and the mica chimney top therein described. Were it not for the express statement in the original specification to which allusion has been made, and to which the second claim makes special reference, it might, perhaps, be, that the chimney base described could be considered a separate device, or a distinct sub-combination of devices, and so capable of being the subject of a separate claim. But, the specific statement of the patent, that, in use, the base and top are to remain united, the whole being put on or taken off together, forbids the conclusion that the inventor ever conceived the idea of his chimney base as a separate and distinct device. In his mind, the chimney base had no existence except as firmly attached to his mica top, and forming an inseparable part of a mica top lamp chimney. The statement in the specification, therefore, compels a determination that the language used was not intended to suggest, and cannot be held substantially to indicate, that the chimney base is a severable part of the contrivance invented. If to the original specification had been attached a claim for the chimney base, as a distinct invention, capable of use by itself, such a claim obviously would have presented a direct conflict with the statement of the specification, that, in use, the base was to remain united with the mica top. This case, therefore, is not within the rule permitting an inventor to select from the ele-

ments of a combination, or from the parts of a machine, described in his specification, a severable and distinct device or sub-combination, capable of use by itself, and substantially indicated in his description, and, by means of a surrender and re-issue, secure an exclusive right to such single device; because, this inventor, in his original specification, has been careful to state that the chimney base he describes is not to be used except as united to his mica chimney top, and as an inseparable part of his mica top chimney. I, therefore, understand the subject-matter of the original patent to be either the mica top lamp chimney therein described, or a combination whose elements are the devices employed in the chimney described for the purposes designated. This understanding is not at variance with the claims of the original patent, for, in legal effect, the statement of the specification already alluded to is part of each claim. So far as the second claim is concerned, an intention to have it considered a part of the claim is manifest, for, the claim states, not only that the base is to be constructed as described, but, also, "arranged to operate substantially as set forth," that is to say, always firmly united to the mica top. This understanding of the subject-matter of the original patent is fatal to the validity of the re-issue on which this suit is brought, so far as the claims here involved are concerned. For, these claims cover neither a lamp chimney such as described in the original patent, nor a combination whose elements are the transparent base and the mica chimney top there described. The 1st, 2d and 4th claims, respectively, are for a chimney base by itself—a thing not to be found in the original, as a distinct severable device; while the 5th claim is for a combination, the elements of which are not to be found substantially suggested or indicated in the original specification.

No adjudged case has been cited, nor am I aware of any case that furnishes authority, to support this re-issue. In *Herring* v. *Nelson*, (14 *Blatchf. C. C. R.*, 293,) the re-issue was upheld for the reason, as assigned, that "all that has been added is the new claim, which embodies in words that which

the specifications and drawings could not fail to disclose to any intelligent examination." Here, the possibility of an examination of the specification disclosing a chimney base as a distinct article or combination is forbidden by the specific statement, that, in use, the base is to remain united with the mica top. The case of *Gill* v. *Wells*, (22 *Wall.*, 1,) is directly in point, upon the fifth claim, which is for a combination whose elements are a chimney base, as described, and any form of chimney top. In the original, if there be any combination described, it is the chimney base combined with the mica chimney top described. The re-issue has, therefore, to say the least, dropped one element from the combination, and put in its place another, not its equivalent, thereby greatly enlarging the scope of the invention.

As sustaining the construction I have placed upon the original patent, reference may be made to the difference between the original specification and the specification of the re-issue. In the original the patentee states, that he has invented "certain improvements in lamp chimneys." In the re-issue the statement is, that he has invented "certain new and useful improvements in bases or supports for lamp chimneys." In the original the invention is said to consist in "a novel construction of a mica lamp chimney and its combination with a glass base." In the re-issue the statement is, that the invention consists of "a glass base for coal oil burners, constructed with a tubular body to fit around the cone or burner, and having a laterally projecting flange, substantially as and for the purpose set forth." The original, describing advantages of the invention, says: "As the air passes the contracted throat, I, and enters the upper portion, it spreads out laterally, and, in connection with the burning oil, produces a very broad, brilliant, and steady flame," thus showing that the two parts were intended to operate as a whole, not otherwise. No such advantage could be secured by the base alone, and, naturally enough, such an advantage is not alluded to in the specification of the re-issue. The re-issue also wholly omits the statement, that, "in use, the chimney and base are

intended to remain united, the whole being put on or taken off together," and inserts this statement, not to be found in the original: "While I have shown a peculiarly constructed chimney as adapted for use in connection with my base, it is obvious other kinds or styles may be used, if preferred." These alterations are suggestive, and go to confirm me in the conclusion that the subject-matter of the re-issue is different from the subject-matter in the original.

It may, also, properly be noticed, that, in a communication to the Patent Office by the attorneys of the patentee, in regard to this original patent, it is stated, that "the first claim is for his improved mode of securing the mica sheets which constitute the body of the chimney, and the second for his specially constructed glass base, to be used in combination therewith."

It has been contended, in behalf of the plaintiffs, that a chimney top of any description is the equivalent of the mica top piece described in the original patent, and that the subject-matter of the original and of the fifth claim of the re-issue are, therefore, the same. But, evidently, such a mica top piece as the original patent describes has qualities and characteristic features not possessed by all chimney top pieces. It may be that the results accomplished by the use of the top piece of a lamp chimney are, in most respects, the same, whatever be the form of the top piece or the material of which it is constructed. But, the result is not in all respects the same, nor would the statement, that a mica top piece would be of use when firmly attached to the chimney base, necessarily or naturally suggest the use of any form of top piece not so attached, to accomplish the same result; and it has not been shown that any form of top piece was known, at the date of the original patent, as a proper substitute for the mica top piece described in that patent.

These reasons appear to me to require the determination, that the re-issue sued on covers inventions not described in the original patent, and is, therefore, void. But, if not, then the re-issue, so far as the first, second, fourth and fifth claims

are concerned, must fail for want of novelty in the invention. The re-issue, in the claims under consideration, covers a transparent chimney base, whose characteristic features are these: (1) a tubular body, for surrounding the cone of a lamp burner and directing the current of air to the flame; (2) a contraction, groove, or indentation in the upper part of such tubular body, for directing the current of air inwards upon the flame; (3) a flange extending laterally from said groove; and (4) a surrounding rim. This invention is plainly anticipated by the invention described in a patent issued to Arnold and Blackman, February 11th, 1868, as well as by the invention described in the patent of Russell and Clifford, of December 24th, 1867. In each of these prior patents is described a lamp chimney base, made of glass, having a tubular body to place over the burner of a lamp, with a contraction or groove at the upper part, and a laterally projecting flange supporting the chimney top, and these features accomplish the same result that the same features accomplish in the plaintiffs' patent, and in the same way. The only distinction between the prior inventions referred to, and the plaintiffs' invention, is, that, in these prior inventions, the chimney base and chimney top were formed in one piece, while in the plaintiffs' invention the chimney base is by itself. But, no invention was required to conceive the idea that a lamp chimney could be cut in two; nor was the idea of constructing a lamp chimney in two parts new. In Millar's patent of July 21st, 1863, the lamp chimney was constructed in two parts. So, also, it must be said, that no invention was required to conceive the idea of a surrounding rim upon the upper part of the base, for the purpose of maintaining in position the separate top piece. The use of such a rim to accomplish the same result is common.

Not only are the characteristic features of the plaintiffs' chimney base old, but the combination of the tubular body groove and laterally projecting portion above is old. No change in the mode of operation or the result was effected by cutting off the top piece. In use, there must still be a top-piece performing the same functions, in connection with the

plaintiffs' base, as the top piece does in the prior invention referred to. The mode of operation and the result are, in both cases, the same. Neither do the plaintiffs gain anything from the surrounding rim, which has formed the sole ground for claiming a difference between the invention in the patent sued on and the invention of Arnold and Blackman. No true combination results from the addition of the surrounding rim, for, there is no co-action between the rim and the tubular body. The only function of the rim is to prevent the top piece from slipping. The application of the surrounding rim for the purpose of preventing the top piece from slipping required no invention, and makes a case of juxtaposition, not a new combination.

It thus appears, that, whether the invention claimed in the re-issue be the same as that described in the original or not, it must fail for want of novelty.

The result is, that the bill must be dismissed, with costs.

Erastus New, for the plaintiffs.

C. H. Watson, for the defendants.

JACOB B. BENNETT AND OTHERS

vs.

ANSELM HOEFNER. IN EQUITY.

Where the defendant in a suit in equity has appeared by a solicitor, notice of application for a decree, after an order *pro confesso*, must be given to such solicitor.

(Before WALLACE, J., Northern District of New York, December 9th, 1879.)

WALLACE, J. The motion of the defendant to set aside the decree entered at the June term of this Court must be granted, because no notice of an application for such decree was given to the defendant. The order *pro confesso* was properly entered, but, notwithstanding that, the defendant was entitled to notice of application for the decree. Equity Rule 18 provides, that, after the order *pro confesso*, the cause shall proceed *ex parte;* but this does not mean without notice to a party who has appeared in the cause. Such party is entitled to notice, and has the right to be heard as to the form of the decree, and upon such other questions as can be presented upon the complainant's pleadings and proofs. This is the uniform construction given to the Rule throughout this Circuit. If this notice had been given in this cause, under Rule 19 the defendant could not now be permitted to answer. As it is, the decree must be set aside.

Under the circumstances, the defendant's default is excusable. An order will be entered allowing the answer filed June 14th, 1879, to stand as the answer in the cause.

James S. Gibbs, for the plaintiffs.

Osgoodby, Titus & Moot, for the defendant.

JULIUS WEHL, AS ASSIGNEE OF THE ESTATE OF GABRIEL NETTER AND ALBERT NETTER

vs.

GUSTAVUS H. WALD, AS ASSIGNEE IN BANKRUPTCY OF GABRIEL NETTER AND ALBERT NETTER AND NETTER & CO.

W., a citizen of New York, brought a suit in a State Court of New York against S., a citizen of New York, to recover money alleged to have been due by S. to N., a voluntary assignor to W. By an order of the State Court, G., a citizen of Ohio, who claimed the money as assignee in bankruptcy of N., was

made defendant in the suit in the place of S., S. having paid the money into Court. W. then filed an amended complaint in the suit, in the State Court, treating G. as the sole defendant, and asking judgment against him. G. answered the amended complaint. G. then removed the case into this Court, without giving notice to the plaintiff of the application for the removal. The petition for removal set forth that "the controversy is between W., as assignee of the estate of N., who was at the commencement of this action, and now is, a citizen of the State of New York, and G., as assignee in bankruptcy of N., who is, and was at the commencement of this action, a citizen of the State of Ohio." On a motion by the plaintiff to remand the cause: *Held*,

(1.) That the petition alleged the personal citizenship of the parties, and was not defective;

(2.) That no notice of the application for the removal was necessary, and the State Court could, in practice, require it or dispense with it;

(3.) That it is not necessary, under §§ 2 and 8 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470,) in order to the removal of a suit, that it should appear that the parties were citizens of different States when the suit was commenced;

(4.) That the suit, as between W. and G., must be regarded as having been commenced when G. was substituted for S., as a defendant.

(Before BLATCHFORD, J., Southern District of New York, December 10th, 1879.)

BLATCHFORD, J. The plaintiff, in September, 1878, brought a suit in the Superior Court of the city of New York, against Mayer Sternberger and Simon Sternberger, to recover from them $4,785 08, gold, with interest thereon from September 9th, 1878, which sum the complaint alleged they had received on or about September 2d, 1878, from the New Orleans National Banking Association, to the use of the plaintiff, the plaintiff being assignee of Gabriel Netter and Albert Netter, by a voluntary assignment for the benefit of creditors, made December 26th, 1877. On the application of the defendants, the Sternbergers, the Superior Court made an order, on the 25th of January, 1879, on notice to the plaintiff and to the present defendant, ordering that, on the deposit by the Sternbergers with the United States Trust Company, to the credit of the action, of $4,785 08 and interest from September 2d, 1878, being in all $4,916 25, after deducting $10 costs, within five days after the entry of such order, the present defendant be substituted as defendant in the action in the place of the Sternbergers, and that the Sternbergers there-

upon be discharged from liability to either the plaintiff or the present defendant. The order also gave leave to the plaintiff to file an amended complaint in place of the original complaint. On the 19th of March, 1879, the Superior Court, on notice to all parties, modified its former order, so as to direct the deposit by the Sternbergers of $4,785 08 without interest, less $10 costs, and ordered that a deposit of said amount in accordance with the terms of the original order, by the Sternbergers, should be a full compliance therewith, and gave to the plaintiff time, after service of the new order and deposit of the money, to serve an amended complaint. The Sternbergers made the deposit on the 22d of March, 1879.

In April, 1879, the plaintiff put in an amended complaint. It sets forth the fact of the assignment to the plaintiff, the payment of the $4,785 08, gold, to the Sternbergers for the use of the plaintiff, as such assignee, the bringing of the suit in the State Court, the two orders of that Court, the fact that the Sternbergers had, on the 22d of March, 1879, deposited with the United States Trust Company said sum of $4,785 08, less $10 costs, and then demands judgment against Gustavus H. Wald, as assignee in bankruptcy of Gabriel Netter and Albert Netter and Netter & Co., that he is entitled to said sum of $4,775 08 and interest thereon from March 22d, 1879. The defendant, in May, 1879, put in an answer, in the State Court, to said amended complaint.

Thereafter, the defendant presented a petition to the State Court for the removal of the suit into this Court. The petition sets forth, that the controversy in the suit "is between citizens of different States, that is to say, between the above-named plaintiff, Julius Wehl, as assignee of the estate of Gabriel Netter and Albert Netter, who was at the commencement of this action, and now is, a citizen of the State of New York, and the above-named defendant, Gustavus H. Wald, as assignee in bankruptcy of Gabriel Netter, Albert Netter and Netter & Co., who is, and was at the commencement of this action, a citizen of the State of Ohio." The defendant gave the proper bond, and, on the 14th of June, 1879,

the State Court, without notice to the plaintiff, made an order declaring that "it is made to appear to the satisfaction of this Court, that the above-entitled action is a suit of a civil nature, at law, now pending in this Court, and that the controversy therein is between citizens of different States, that is to say, between the above-named plaintiff, who is a citizen of the State of New York, and the above-named defendant, who is a citizen of the State of Ohio, and that the matter in dispute exceeds the sum or value of five hundred dollars, exclusive of costs, and that this Court doth accept said petition and bond."

The ground upon which the State Court proceeded, in making the order for a change of the party defendant, was, that the present defendant had made a demand upon the Sternbergers for the same indebtedness claimed by the plaintiff; and that the Sternbergers were not in collusion with the present defendant, and were indifferent to the claims of either party, and had no interest in the subject-matter of the controversy, but held the money for the use of the Netters, or their proper legal representatives, and were ready and willing to deposit it in Court to abide the event of the action.

The plaintiff now moves that this cause be remanded to the State Court. At the time of the commencement of the suit, and at the time the petition for removal was presented, the plaintiff and the Sternbergers were citizens of the State of New York.

The plaintiff contends, that the petition for removal is defective, in that it does not allege the citizenship of the plaintiff and defendant, but only alleges that the plaintiff, as assignee, was and is a citizen of New York, and that the defendant, as assignee, was and is a citizen of Ohio. The case of *Amory* v. *Amory*, (5 *Otto*, 186,) is cited. There, the averment in the petition was, "that said plaintiffs, as such executors, are citizens of the State of New York." The Court held that the petition was defective, in not stating the personal citizenship of the plaintiffs. It is contended that, in the present case the personal citizenship of the parties is

not stated. I think this is not so. The allegation is not that the plaintiff, "as assignee," was and is a citizen, and that the defendant, "as assignee," was and is a citizen, but is, that the controversy is between "the above-named plaintiff, Julius Wehl, as assignee of the estate of Gabriel Netter and Albert Netter, who was at the commencement of this action, and now is, a citizen of the State of New York, and the above-named defendant, Gustavus H. Wald, as assignee in bankruptcy of Gabriel Netter, Albert Netter and Netter & Co., who is, and was at the commencement of this action, a citizen of the State of Ohio." This is an allegation of the personal citizenship of the parties.

It is contended, for the plaintiff, that the removal proceedings were invalid because no notice of the application for removal was given to the plaintiff. The Act of Congress does not require notice. If, as matter of discretion, a State Court can or does require notice in any case of removal, such notice was dispensed with in this case by the State Court; and, the matter being one of practice, it is for the State Court to regulate its own practice, and this Court will not review such a question.

It is also urged, for the plaintiff, that the cause is not removable, under the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470,) because the present defendant was not a party to the suit when it was commenced, and because the original defendants, the Sternbergers, were, when the suit was commenced and when the removal proceedings were instituted, citizens of the same State with the plaintiff. I had occasion to consider sections 2 and 3 of that Act, in deciding a motion to remand in the case of *McLean* v. *The St. Paul and Chicago Railway Co.*, in this Court, (16 *Blatchf. C. C. R.*, 309,) and held, that, under those sections, it was not necessary, in order to a removal, that it should appear that the parties were citizens of different States when the suit was commenced. In that case the petition for removal set forth that the plaintiff "is a citizen of the State of New York" and that "the defendant is a citizen of the State of Minnesota." In accord-

ance with that decision, this case was removable although the original parties to the suit were not citizens of different States.

But there is a further ground on which the case was removable. The plaintiff put in, in the State Court, an amended complaint, treating the present defendant as the sole defendant in the cause, and as having been substituted as defendant, by the order of the State Court, in the place of the Sternbergers. In such amended complaint the plaintiff demands judgment against the present defendant. The suit must be considered as having been commenced against the present defendant when he was brought in as a defendant. For the purposes of a removal by the present defendant, the suit did not exist so long as the Sternbergers were defendants. The petition for removal shows that the present defendant and the plaintiff were citizens of different States when the present defendant became a defendant. The petition being entitled in a suit between the plaintiff and the present defendant, the expression, twice, in the petition, "the commencement of this action," must be held to mean the time when the action first became an action between the plaintiff and the present defendant. In this view, even if the right of removal in this case depends upon the facts existing as to diversity of citizenship at the commencement of the action sought to be removed, the case was removable. (See *Healy* v. *Prevost*, 6 *Weekly Notes*, 579 and 8 *Reporter*, 103.)

The motion to remand the cause is denied.

A. J. Dittenhoefer, for the plaintiff.

Anderson & Howland, for the defendant.

WILLIAM A. HARDING

vs.

CHARLES P. CROSBY. IN EQUITY.

An assignee in bankruptcy brought a suit in equity against the voluntary assignee of the bankrupt, to set aside a conveyance made by the bankrupt, within three months before the filing of the petition in bankruptcy, to the defendant, in trust for the benefit of all the creditors of the assignor, without any preferences: *Held*, that, as the direct effect of the conveyance, if upheld, would be to keep the property away from the operation of the bankruptcy law and from distribution by the Courts and officers of the United States, and to give it and its administration to a trustee selected by the debtor, the plaintiff was entitled, under § 5,129 of the Revised Statutes, as amended by the Act of June 22d, 1874, (18 *U. S. Stat. at Large*, 390,) to the relief asked. The bankrupt is not a necessary party to such suit.

(Before WHEELER, J., Southern District of New York, December 10th, 1879.)

WHEELER, J. This cause has been heard on bill, answer, replication, proofs and argument. The bill is brought by the orator, as assignee in bankruptcy, to set aside a conveyance by the bankrupts of all their property to the defendant, in trust for the benefit of all their creditors, without any preferences, made within three months of the filing of the petition. The answer admits the conveyance but denies that it was made with a view to prevent their property from coming to their assignee in bankruptcy, or to prevent it from being distributed under the bankruptcy laws of the United States, or to hinder their operation. The answer is traversed. The principal question, is, whether such a conveyance is within the provisions of section 5,129 of the Revised Statutes of the United States, as amended by the Act of June 22d, 1874, (18 *U. S. Stat. at Large*, 390.) That section does not require that the assignment be fraudulent, to be avoided. If it did, this conveyance was out of the usual and ordinary course of

business of the bankrupts, which would be *prima facie* evidence of fraud, according to the provisions of section 5,130. It is only necessary that it be made with a view to prevent the property from being distributed under the bankruptcy laws. The insolvency and contemplation of it being admitted, the direct effect of the conveyance, if upheld, would be to keep the property away from the operation of those laws, and from distribution by the Courts and officers of the United States, and to give it and its administration to a trustee selected by the debtors. They must be deemed to have intended these direct consequences of their act, and to have committed the act in view of the consequences. These considerations bring this case within the statute. Although, when the bankrupt law of 1867 first came to be construed, there were some decisions by eminent judges to the contrary of this, they have not been followed, and the current of the decisions has almost, if not quite, uniformly since then been in accordance with this. It would serve no useful purpose to name these cases here.

There is, also, an objection because the bankrupts are not made parties to this bill. It is argued that they are necessary parties to a bill to enforce an assignment in trust, because there may be an excess, after payment of debts, in the hands of the trustee, belonging to the debtor, and that the same is true here, and that they are or may be interested to have the assignment upheld. Here, however, all the property of the bankrupts, subject to the exemptions, is vested in the assignee in bankruptcy, and there could not be any excess, after administration of the trust, belonging to the bankrupts personally. Hence, there is no occasion for joining the bankrupts.

Let there be a decree setting aside the conveyance, and for delivery of the property, and for an account, according to the prayer of the bill.

William B. Hornblower, for the plaintiff.

Charles P. Crosby, for the defendant.

AARON H. ALLEN

vs.

THE MAYOR, ALDERMEN AND COMMONALTY OF THE CITY OF NEW YORK AND THE BOARD OF EDUCATION OF THE CITY OF NEW YORK. IN EQUITY.

Seats embodying a patented invention were bought by the Board of Education of the city of New York for the use of the schools of the city, and were used in such schools, such Board being a corporation created by the State, having exclusive charge of such schools: *Held*, that the city, in its corporate capacity, was liable, in a suit in equity, for the infringement of the patent.

The Board of Education is a proper party to the suit and is also liable for the infringement.

(Before WHEELER, J., Southern District of New York, December 18th, 1879.)

THIS was a suit in equity on re-issued letters patent, granted to the plaintiff for "improvements in seats for public buildings."

Andrew J. Todd, for the plaintiff.

Frederic H. Betts, for the defendants.

WHEELER, J., (after sustaining the validity of the patent:) The proof in respect to infringement is to the effect, that seats embodying this invention were bought by the Board of Education of the city of New York for the use of the schools of the city, and have been in use in those schools under the direction of the Board of Education, and the Department of Public Instruction which has superseded the Board of Education. It is argued, that, upon this proof, the city is not liable in this suit, for two reasons—one is, because these instrumentalities having charge of the schools are corporations themselves, over which the city has no control; the other is,

that the use is under sovereign authority, delegated by the State of New York in its sovereign capacity, for which the city or the Board of Education, or the Department of Public Instruction, can no more be held liable to suit than the State itself. It is understood that the Board of Education was, and that the Department of Public Instruction is, a corporation under the laws of the State, recognized and treated as such by the Courts of the State, and having exclusive charge and control of the schools of the city, without whose action the city cannot be made liable for anything connected with the schools, and for whose contracts the city cannot be held liable otherwise than through proceedings against them. (*Ham* v. *The Mayor*, 70 *N. Y.*, 459; *Dannat* v. *The Mayor*, 6 *Hun*, 88.) But still, the schools are the schools of the city, the Board of Education or Department of Public Instruction takes charge of them for the city, they are paid for with the money of the city, and whatever is saved in providing for them is to the advantage of the city. The corporation which that Department or Board constitutes is within that of the city, and is an instrumentality through which the educational interests of the city are cared for, the same as if done by officers having the same powers, except that the officers could have only a personal and official period of existence, while that of the corporation is, under the law, theoretically perpetual. One principal ground of a suit in equity for the infringement of a patent is, to compel an account of the gains or profits accrued to those proceeded against, by means of the infringement. Obviously, the proper party to proceed against is the one that has received the profits or to whom the gains have accrued. If any party has saved or made anything by this infringement it is the city, and the city seems clearly to be a proper party to account for these savings or profits. The Board and Department are proper parties, also, for they have been directly engaged in the infringement. It is argued, that the city, as such, could not stop the infringement nor control it, and, therefore, could not be guilty of any tort by which to acquire profits to account for. Probably, the city could not,

independently of this Board or Department, stop the infringement; but that is on account of the mode in which the law requires the educational matters of the city to be attended to, and not because the city has any just right to advantages which the wrongful acts of its Board or Department may acquire. Officers might be able to do the same, but, if so, the city would not be shielded.

That the acts constituting the infringement were committed in the exercise of authority derived from the State, cannot shield the defendants from liability. The grant of the exclusive right to this invention came from the sovereign power of the General Government, and the right is a species of property secured to the inventor by law. It is not subservient to public uses without just compensation ascertained and furnished, upon being taken in a regular and lawful mode, any more than other property of any kind is. It has not been taken by any regular proceeding, but only by mere wrong doing, which could, of itself, furnish no legal right. (*Cammeyer* v. *Newton*, 4 *Otto*, 225, 234.)

Let a decree be entered, that the patent is valid and that the defendants have infringed, and for an account, according to the prayer of the bill.

JOHN O. FOX

vs.

FREDERICK A. BLOSSOM. IN EQUITY.

By the law of Connecticut, the right of a mortgagee of land to foreclose the mortgage or to sue to recover possession of the land, is barred, if the mortgagor has been permitted to remain in possession of the land for 15 years at least, without paying any part of the debt or recognizing the mortgage.

A second mortgagee of the same land, out of possession, can bring a suit in equity against the first mortgagee, out of possession, and the mortgagor in

possession, to have the first mortgage cancelled, on the ground of the bar of such statute.

(Before SHIPMAN, J., Connecticut, December 18th, 1879.)

SHIPMAN, J. This is a bill in equity, by a mortgagee out of possession, against a prior mortgagee and the mortgagor in possession, praying that the prior mortgage may be decreed to be cancelled, upon the ground that, more than fifteen years prior to the date of the bill, the mortgagor paid the notes secured by said mortgage, and that, for more than fifteen years, the mortgagee has had no equitable interest in the land conveyed by said deed, and that, during all said term, the mortgagor has been in full and exclusive possession of said land, adversely to said prior mortgagee, and paying no interest upon said mortgage notes. The bill was served October 30th, 1877. Said prior mortgagee has brought a cross-bill, praying for a foreclosure of his mortgage.

On or about June 6th, 1854, Orange D. Day executed and delivered to Frederick A. Blossom a mortgage of that date upon land in Killingly, in this State, correctly described in said bill, to secure five promissory notes of $1,000 each, payable respectively in four, six, twelve, eighteen and twenty-four months from said date, with interest payable semi-annually. Said mortgage was duly recorded on July 14th, 1854, in the town records of Killingly. No interest or principal has been paid upon said notes. In June, 1855, Day acknowledged an indebtedness to Blossom upon said notes. There was testimony contradicted by Day, that, in 1858, he also acknowledged an indebtedness to Blossom, but, since 1855, Day has never admitted or acknowledged an existing liability to Blossom, and has never done any act recognizing the continued existence of the mortgage, or by which an acknowledgement of an existing liability could be inferred. In December, 1868, Blossom brought against Day a petition for the foreclosure of said mortgage, returnable before the Supreme Court for Windham County, alleging the execution of the mortgage, and the delivery and non-payment of the notes.

To this petition Day filed an answer, admitting the execution and delivery of said notes and mortgage on June 6th, 1854, and that before that date he owed Blossom $4,000, but averring that said notes were executed in pursuance of an usurious agreement in regard to the forbearance of said debt, and that said notes and mortgage were void, and denying all other allegations of said petition. The petition was withdrawn during the August Term, 1870. Blossom was then in Europe, where he had been detained by sickness. Ever since 1854, Day has been in the exclusive, uninterrupted use and occupation of said land, and, since 1858, at least, has occupied said land adversely to any rights of Blossom, and has held the same not recognizing any title, equitable or otherwise, existing in said Blossom. The mortgage deed to Blossom excepts from the covenant against incumbrances "a life lease to my" (the mortgagor's) "mother." There never was a lease to his mother, but he had executed a mortgage to William S. Day, upon condition that the mortgagor should provide or pay for his mother's (Amy Day's) support during her life. The consideration of said Blossom notes was a good consideration, and they were not usurious. Prior to June 6th, 1854, said Blossom, Day, and one E. G. Reynolds were partners in the city of New York, under the name of O. D. Day, but the remaining allegations of the answer to the cross-bill of Blossom, in regard to the purpose for which the notes were given, and the cancellation or payment thereof by set-off or otherwise, are not affirmatively found to be true. The testimony is contradictory and untrustworthy.

Said Day, on August 27th, 1877, was justly indebted to John O. Fox, the plaintiff, in the sum of $3,000, which indebtedness was evidenced by his promissory note, dated August 11th, 1877, payable to said Fox three years from said date, with interest semi-annually, and, to secure the payment of said note, mortgaged, on said August 27th, 1877, the lands described in the bill and the same lands mortgaged to Blossom. Said mortgage was duly recorded. Fox did not examine the records, but was informed by Day and believed, that the property was free from incumbrances, except the mort-

gage to William S. Day for the support of Amy Day. Nothing has been paid upon said note, either as interest or principal. Day is insolvent and there is no probability that he ever will pay the note.

By the law of Connecticut, the mortgagee's right of foreclosure, in a suit at law for the recovery of possession, is barred, if the mortgagor has been "permitted to remain in possession of the premises for a period of fifteen years, at least, without payment during that time of any portion of the debt, or the performance of any act recognizing the continued existence of the mortgage." But, an acknowledgment of the existence of the debt by the mortgagor during his ownership, and within fifteen years from the time of bringing the bill for foreclosure, is sufficient to remove the bar, for, such recognition of the debt, as a subsisting debt, is a recognition of the mortgage as a security, and prevents "the time that had elapsed from being counted or considered as any part of the fifteen years' uninterrupted possession, necessary in order to bar the mortgagee's right to bring ejectment or to foreclose the mortgage." (*Hough* v. *Bailey*, 32 *Conn.*, 288; *Jarvis* v. *Woodruff*, 22 *Conn.*, 548; *Haskell* v. *Bailey*, 22 *Conn.*, 569; *Hughes* v. *Edwards*, 9 *Wheat.*, 489.)

It is useless to say that Day's answer in the Superior Court foreclosure suit was an acknowledgment of the debt, for he expressly denied that it was an existing debt, and denied non-payment of the notes, and averred that the mortgage and notes were void.

The defendant Blossom insists, as matter of law, that the plaintiff has no right to a decree, because he is out of possession, and is a mortgagee whose debt may be paid at maturity. When the mortgagee ascertains that there is an apparent but fictitious incumbrance upon the mortgaged land, and that the safety of his mortgage is important to the safety of his debt, he has the same right to have his lien protected by a Court of equity and relieved from prior nominal incumbrances which have been paid or otherwise satisfied or extinguished, which the owner has to have his title relieved from a cloud. The suit is not prematurely brought because the principal of the

debt is not due. (*Lounsbury* v. *Purdy*, 18 *N. Y.*, 515.) The principle upon which Courts of equity act in the cancellation of invalid deeds or other invalid instruments does not depend upon the particular interest or title which is to be protected. It is sufficient if the plaintiff has some interest in or title to the land which is clouded with an invalid lien, and that his interest or title is endangered thereby. (*Chipman* v. *Hartford*, 21 *Conn.*, 488; *Ward* v. *Chamberlain*, 2 *Black*, 430.) The principle is familiar and is as clearly stated as anywhere in *Martin* v. *Graves*, (5 *Allen*, 601.) "Whenever a deed or other instrument exists, which may be vexatiously or injuriously used against a party after the evidence to impeach or invalidate it is lost, or which may throw a cloud or suspicion over his title or interest, and he cannot immediately protect or maintain his right by any course of proceedings at law, a Court of equity will afford relief by directing the instrument to be delivered up and cancelled, or by making any other decree which justice and the rights of the parties may require."

The fact that the plaintiff is out of possession does not deprive him of the right to the benefit of a bill *quia timet*. (*Martin* v. *Graves*, 5 *Allen*, 601; *Chipman* v. *Hartford*, 21 *Conn.*, 488; *Lounsbury* v. *Purdy*, 18 *N. Y.*, 515.) There are, probably, instances where a claimant out of possession should not obtain the aid of a Court of equity, by a bill *quia timet*, to establish his right to a legal title and to the possession, against a defendant in possession with an apparently valid legal title; but, the case of a mortgagee who claims that another mortgage of record is *functus officio*, and has been extinguished, both parties being out of possession, is not of such a character.

Let there be a decree that the mortgage to Blossom constitutes no lien upon the lands named therein, and that said lands are freed from said nominal incumbrance, and that the cross-bill is dismissed.

Thomas E. Graves, for the plaintiff.

Edward Goodman and *John J. Hill*, for the defendant.

The United States *vs.* Frank Bennett.

An indictment under §§ 5,431 and 5,434 of the Revised Statutes, in setting out counterfeit notes, did not exhibit any imprint of the seal of the Treasury, while the notes put in evidence on the trial exhibited such imprint: *Held*, that there was no such variance as to make it improper to admit the notes in evidence.

The notes were circulating notes of a national banking association, but the indictment, while setting them out at length, called them "national bank currency notes": *Held*, not a variance.

At the close of the evidence for the prosecution the defendant requested that one M. be called as a witness for the Government. He was not then called. Afterwards, and after the defendant had testified in his own behalf, M. was produced in rebuttal: *Held*, no error.

The circulating notes of a national banking association are valid contracts without having the imprint of the seal of the Treasury on them.

The indictment is not bad for not giving a fac-simile of the seal to which it refers, or for not setting out the numbers on the notes.

The indictment properly charges in different counts different offences, under §§ 5,431 and 5,434, for which different punishments are prescribed by those sections, the offences charged being of the same class of crimes, such joinder being permitted by § 1,024.

Whether the offences were "properly joined," under § 1,024, was a question to be determined on a motion to quash or to compel an election.

Where the defendant is convicted of the several offences charged in said indictment, he is, in effect, convicted on separate indictment, and may be separately punished for each offence proved.

(Before Blatchford, Benedict and Choate, JJ., December 22d, 1879.)

Benedict, J. The prisoner was tried upon an indictment containing six counts. The first five counts are framed under § 5,431 of the Revised Statutes of the United States, and the sixth under § 5,434. Having been convicted he now moves for a new trial and in arrest of judgment.

The main question presented on the motion for a new trial is raised by an exception to the admission in evidence of the counterfeit notes offered to prove the several charges in the indictment, on the ground of variance; first, because each note exhibits what purports to be the imprint of the seal of

the Treasury, while the notes set forth in the indictment exhibit no such imprint. It is contended, that the provision in § 5,172, authorizing the issue of circulating notes by a banking association, which declares that the notes shall "express upon their face that they are secured by United States bonds deposited with the Treasurer of the United States, by the written or engraved signature of the Treasurer and Register, and by the imprint of the seal of the Treasury," renders the imprint of the seal a part of the contract, necessary to its validity, and, therefore, necessary to be set out, and proved as laid. But, it is evident, from the language of the statute, just cited, that the imprint of the seal of the Treasury is simply intended to be evidence in regard to the security of the contract and forms no part of the contract itself. An indictment of this character is sufficient if it sets forth so much of the note as contains the evidence of the contract, and so much is set forth in this instance. To that extent the notes admitted in evidence correspond exactly with the notes in the indictment, and prove the substance of the charge, although they exhibit, in addition, what purports to be the imprint of the seal of the Treasury.

It is next contended, that there is a fatal variance because the notes admitted in evidence are circulating notes of a banking association, while the notes set forth in the indictment are styled therein national bank currency notes. Here, the argument is, that § 5,413, which provides that the phrase, "obligation or other security of the United States," shall be held to mean (among other things) "national bank currency," has been modified by the use, in § 5,434, of the words, "any obligation or other security of the United States, or circulating note of any banking association organized or acting under the laws thereof," and that a distinction must now be drawn between the circulating notes issued by a banking association and national bank currency. Section 5,431 is claimed to be no longer applicable to such circulating notes, and it is urged that the notes admitted in evidence do not correspond with the description given in the indictment. Upon this question

our opinion is, that there was no intention to create a distinction between national bank currency and the circulating notes issued by a banking association, by the language employed in § 5,434, and that § 5,413 is not modified by § 5,434. The words "or circulating note, &c.," in § 5,434, were inserted through excess of caution, no doubt. If there had been the intention to modify § 5,413, and thereby to change the scope of § 5,415 and § 5,431, it may be presumed that such an intention would have been plainly expressed, and not left to follow from a doubtful implication. The notes were, therefore, correctly designated as national bank currency notes, that being the designation of such notes in § 5,413. Besides, the notes are set out at length in the indictment, and show, on their face, that they are circulating notes of a banking association organized under the laws of the United States. The designation of their legal character, given in the indictment, becomes, then, immaterial. (*Regina* v. *Williams*, 2 *Den. C. C.*, 61; *United States* v. *Trout*, 4 *Biss.*, 105.)

Several other points of variance were made at the trial, viz.: that the numbers—the figure 5, in the corner—the words, "printed by the bureau of engraving and printing, Treasury Department"—the words, "Act approved June 30"—the words, "New York," and "U. S.," over the seal—and the word "Excelsior"—which appear on the notes admitted in evidence, do not appear on the notes set forth in the indictment. But, these differences have not been relied on here and are immaterial. (*Comm.* v. *Stevens*, 1 *Mass.*, 203; *Comm.* v. *Bailey*, 1 *Mass.*, 62.)

The only remaining question presented by the motion for a new trial, and calling for attention, arose as follows: At the close of the evidence for the prosecution, a request was made in behalf of the defendant, that the Court instruct the District Attorney to call as a witness in behalf of the Government, one McGuire. The request was refused, and McGuire was not then called. Subsequently, and when the evidence for the defence had been given, the District Attorney offered McGuire as a witness, to give evidence in rebuttal. Objec-

tion was taken to the witness' being allowed to testify, which was overruled, and the witness then gave evidence in rebuttal. To these rulings exception was taken.

The only ground upon which the request for the instruction to the District Attorney, and the subsequent objection to the witness McGuire, were placed is, that injustice would be done, to permit this witness to be informed of the testimony of the prisoner, and then to go upon the stand and contradict him. The case shows, that, when the instruction to the District Attorney was prayed, evidence had been given that McGuire was the person who communicated the fact of the possession of these notes by the prisoner; and that he had said that the prisoner had given him a five dollar counterfeit note on the day of his arrest. Whether this evidence had been drawn out by the defendant or the prosecution does not appear in the case; but, the absence of any objection from the defendant shows, that, if not called out by the defence, no point was made in regard to its admission. Whether it was in the power of the District Attorney to produce McGuire while the case was with the prosecution does not appear.

The ruling objected to seems to relate simply to the order of proof, but, without intending to admit that a ruling of that character is subject to review, we may say, that we are unable to see, from the case, that any injustice was done to the defendant by the course pursued. Whether the evidence of McGuire was necessary to make out a case for the prosecution belonged to the District Attorney to determine for himself. If McGuire was the bad person supposed by the defence, the District Attorney was justified in avoiding, if possible, presenting him to the jury as a witness to establish the case for the Government. What the defendant would testify to could not be foreseen, and, when the defendant's testimony compelled the production of evidence in rebuttal, the right of the prosecution to present such evidence by the testimony of any witness able to testify to the facts, is not open to question.

There remain to be considered the points made in sup-

port of the motion in arrest of judgment. It is said, that the notes set forth in the indictment are not valid contracts, owing to the absence of the seal, and, therefore, not the subject of forgery. To this, there is one sufficient answer, that, as already stated, the seal of the Treasury forms no part of the contract.

Again, it is contended the indictment is bad because it avers that the forged note purported to bear the imprint of the seal of the Treasury, but omits to give a copy of the seal. It is said, that, while it would, perhaps, be unnecessary to say anything about the devices, yet when they are described a fac-simile or copy must be given. But, if, as has been seen, it was unnecessary, in setting forth the note, to set forth the seal, stating that the note purported to have a seal cannot affect the validity of the indictment.

It is further contended, that the indictment is insufficient, because, by omitting the numbers on the bills, it renders the record unavailable as a bar to a subsequent prosecution for the same offence. The case does not show that the numbers upon any one of the notes admitted in evidence would identify the note. On the contrary, several of the notes exhibit the same numbers. Nor is it necessary that the indictment be so particular that the record will, upon its face, and without extrinsic evidence, identify the subject-matter of the charge. The subject-matter of a former trial is always a matter of evidence and may be proved like any other fact. The books show many cases where such a particularity of description as is here contended for has been held unnecessary.

Lastly, it is contended that judgment must be arrested because the indictment charges different offences, for which different punishments are prescribed by statute; and Tweed's case (*The People* v. *Liscomb*, 60 *N. Y.*, 559) is cited in support of the objection. An examination of the doctrine declared in that case would be out of place here, because this is a prosecution instituted under a statute of the United States, which permits the joinder of separate and distinct offences in one indictment, in separate counts. No doubt is entertained

that section 1,024 of the Revised Statutes permits the joinder in a single indictment, in separate counts, of offences created by section 5,431 and an offence created by section 5,434, notwithstanding the fact that the punishment prescribed by section 5,431 is a fine of not more than $5,000, and imprisonment at hard labor not more than 15 years, and the punishment prescribed by section 5,434 is imprisonment at hard labor not more than 10 years, or a fine of not more than $5,000, or both. It would seem, from the case, that, in this instance, the several charges are for the same transaction, or for transactions connected together. They appear to have occurred at the same time and were proved by the same witnesses. But, if not, the offences are similar in character, the challenges are the same, and the punishments alike in kind, differing only in degree, and they are, therefore, of "the same class of crimes" within the meaning of section 1,024. Whether the joinder was calculated to embarrass the prisoner, and, therefore, the offences not "properly joined," within the meaning of the statute, was a question to be determined by the Judge in his discretion, on a motion to quash or to compel an election. (*Comm.* v. *Birdsall*, 69 *Penn.*, 482.)

No difficulty in regard to the judgment to be entered arises from the difference between section 5,431 and section 5,434 in respect to the punishment prescribed. The prisoner has been convicted of the several offences charged in the indictment. Each count, charging a separate and distinct offence, is, in legal effect, a separate indictment, and a conviction thereon may be followed by a sentence imposing such punishment as the statute has prescribed for that offence. The statute, in permitting the joinder of different offences in a single indictment, and even the consolidation of two or more indictments, by necessary implication authorizes a separate punishment for each offence proved. Otherwise, a conviction of offences permitted to be joined would be the same, in effect, as an acquittal.

We have now considered all the points in behalf of the prisoner that can be claimed to be worthy of notice, and find

no ground upon which to grant a new trial, or to arrest the judgment. The motions are, therefore, denied.

Sutherland Tenney, (*Assistant District Attorney*,) for the United States.

A. J. Dittenhoefer, for the defendant.

SAMUEL MCLEAN

vs.

THE ST. PAUL AND CHICAGO RAILWAY COMPANY.

On March 17th, the State Court in which this suit was pending made an order, on the petition of the defendant, that it be removed into this Court. The defendant ought to have filed the record in this Court by April 7th. It was not filed till April 10th. This Court, on May 24th, made an order remanding the cause. June 2d, on a new petition filed that day by the defendant, which set forth that the suit was then pending in the State Court, that Court made an order that the suit be removed into this Court: *Held*,

(1.) That, as the removal was provided for by §§ 2 and 3 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470, 471,) the petition was in time if filed before or at the term at which the cause "could be first tried, and before the trial thereof;"

(2.) That the publication of the second edition of the Revised Statutes, under the Act of March 2d, 1877, (19 *U. S. Stat. at Large*, 268,) did not re-instate subdivision 1 of § 639 of the Revised Statutes, as applicable to this suit;

(3.) That the proper condition of the bond on removal was that prescribed by § 3 of the Act of 1875;

(4.) That the petition of June 2d was filed before or at the term at which the cause could be first tried;

(5.) That, as the defendant had once removed the cause to this Court and had failed, by neglect, to perfect the removal, and the cause had been remanded for that reason, the right to remove it had been waived and lost;

(6.) That the defendant could not now be allowed to furnish an excuse for not having in time filed the record on the first removal, and that it had acquiesced

in the first remand by averring, in the second petition, that the cause was then pending in the State Court.

(Before BLATCHFORD, J., Southern District of New York, December 22d, 1879.)

BLATCHFORD, J. A petition by the defendant and a bond for the removal of this suit into this Court were filed in the State Court in which the suit was pending, on the 17th of March, 1879, and on that day the State Court made an order that the petition and bond be accepted and filed, "and that this Court will proceed no further in this suit, and it is hereby declared that the said suit is removed to the said Circuit Court of the United States for the Southern District of New York." The defendant ought to have filed a copy of the record in this Court by the 7th of April, but did not until the 10th of April. For that cause, this Court made an order, on the 24th of May, on motion of the plaintiff, remanding the cause of the State Court. (16 *Blatchf. C. C. R.*, 309.) On the 2d of June, 1879, the defendant filed in the State Court a petition and bond for the removal of the cause into this Court, and the State Court made an order, on that day, that said petition and bond be accepted, and "that this Court will proceed no further in this suit, the said suit being removed to the said Circuit Court of the United States for the Southern District of New York." A copy of the record in the suit having been filed in this Court in due time by the defendant, and the defendant having appeared in the suit in this Court, the plaintiff now moves, on various grounds, to remand the cause to the State Court.

It is contended, that, under subdivision one of section 639 of the Revised Statutes of the United States, the petition for removal in this case should have been filed in the State Court at the time the appearance of the defendant was entered in the State Court. This is on the idea that such subdivision was in force, as respects this suit. But, as the removal of this case is provided for by sections 2 and 3 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470, 471,) those sections supersede, and take the place of, in regard to this suit, such

subdivision. Under the Act of 1875 the petition was in time if filed before or at the term at which the cause "could be first tried, and before the trial thereof." It is suggested, for the plaintiff, that the second edition of the Revised Statutes, printed and promulgated in 1878, is a re-enactment of the Revised Statutes in 1878, and that subdivision one of section 639, found in it, displaces the Act of 1875. This is an error. The Revised Statutes were enacted June 22d, 1874. The new or second edition authorized by the Act of March 2d, 1877, (19 *U. S. Stat. at Large*, 268,) is the Revised Statutes as enacted June 22d, 1874, with all amendments made between December 1st, 1873, and March 4th, 1877. By section 5,601 of the Revised Statutes, all Acts passed after December 1st, 1873, are left in force as if passed after June 22d, 1874. The publication of the second edition of the Revised Statutes does not affect any statute passed subsequently to December 1st, 1873. It does not affect the Act of March 3d, 1875, nor re-instate subdivision one of section 639, as applicable to this suit.

It is urged, that the bond in this case is not the proper bond, because its condition was not that provided for by section 639 of the Revised Statutes, but that provided for by section 3 of the Act of 1875. As the suit is one mentioned in section 2 of that Act, the proper condition of the bond was that prescribed by section 3 of that Act.

It is further urged, that the petition filed June 2d, 1879, was not filed before or at the term at which the cause "could be first tried" in the State Court, although filed before the trial of the cause in that Court. Issue was joined in the suit, by the answer of the defendant in the State Court, February 27th, 1879. The order of removal made by the State Court March 17th, 1879, states that the petition for removal that day filed is filed "before the term at which this cause could be first tried in this Court." This is an adjudication of that fact by the State Court. Even if such an adjudication would be reviewed by this Court, it is apparent, that the cause could not have been tried before the March Term, 1879, of the State

Court, and at that term the petition was filed. It is plain, from sections 977 and 980 of the Code of New York, that the cause could not have been noticed for trial, or put on the calendar of the State Court, for the March Term, or regularly brought to trial at that term, except by consent. The term at which the cause "could be first tried" is the term at which, under the legislation of the State and the rules of practice pursuant thereto, the cause is first triable, that is, subject to be tried on its merits. (*Dillon on Removal of Causes*, 2d ed., *p.* 57; *Ames* v. *Colorado Central R. R. Co.*, 4 *Dillon*, 260; *Fulton* v. *Golden*, 20 *Albany Law Journal*, 229.) On the 17th of March, 1879, the State Court declared, by the order of that date, that it would proceed no further in the suit and that the suit was removed to this Court. This was equivalent to saying it would not try the cause. This state of things continued until this Court, by its order of May 24th, remanded the cause to the State Court. Then, under the State legislature and practice, the term at which the cause could be first tried was the June Term, and at or before that term the new petition for removal was filed. So far therefore, as the question of time is concerned, the new petition was filed in time, under the Act of 1875.

It is further urged that, the defendant having once removed the cause to this Court, and having failed to perfect the removal by neglect to file the record in time in this Court, and the cause having been remanded to the State Court for that reason, the right to remove the cause has been lost, because the delay is prejudicial to the plaintiff; and that, if the right to remove is to be allowed in this case, under such circumstances, the same course might be repeated *ad infinitum*. That a defendant may waive his right to remove a cause is plain. (*Hanover Nat. Bank* v. *Smith*, 13 *Blatchf. C. C. R.*, 224.) He ought to be held to have waived it where he has attempted to exercise it once, and has failed, by neglect, to perfect the removal, and where, to allow the subsequent removal, would make effective the delay of the cause, to the presumed prejudice of the plaintiff, for the time elapsed after

the failure to perfect the removal occurred. That is the present case.

The defendant calls attention to the recent decision of the Supreme Court in *Meyer* v. *Construction Co.*, (10 *Otto*, 457,) and claims that, under that decision, this cause ought not to have been remanded before, and, therefore, ought to be retained here now. The Supreme Court, in that case, says, that it does not appear, by the statute, that the Circuit Court is to be deprived of its jurisdiction, if "by accident" the party is delayed until a later day than the first day of the term of the Circuit Court, in filing a copy of the record of the State Court; and that, if the Circuit Court, for good cause shown, accepts the transfer after the day and during the term, its jurisdiction will, as a general rule, be complete and the removal properly effected. The affidavit of the defendant's attorney, furnished to the Court on the first motion to remand, purporting to give an excuse in this case for not filing the copy of the record, on the first removal, on the first day of the April Term, and to make out a case of "accident," contained the following on that subject and nothing more: "and deponent says, that, by inadvertence, during his, deponent's, absence from his office on the 7th April, instant, the record, in said cause, of the said proceeding, in the Court of Common Pleas of the city and county of New York, in the said action, and a copy of the pleadings therein, was not filed in the Court on that day, and that deponent did not discover that the same had not been filed until the 10th instant." This affidavit does not make out a case of accident. Facts are not stated from which the Court can see that there was an inadvertence or an accident. The conclusion of inadvertence is sworn to. The certified copy of the petition for removal, bond, and order of removal, filed in this Court on the 10th of April, was certified by the clerk of the State Court on the 18th of March. No reason is shown why it was not filed here before the 7th of April, as it might have been. This Court did not accept the transfer, but remanded the cause. It did so on what then appeared, and still appears, to be a proper ground. This Court could not now vacate the

order of May 24th, remanding the cause, on the furnishing now, by the defendant, of an affidavit showing what would have been held to be a satisfactory excuse for not having filed the first record in time, or a case of "accident." The defendant had his day in Court, at that time, and the matter became *res adjudicata*, not to be re-opened because of any facts then existing and which might have been then shown. Moreover, the defendant has acquiesced in the former remand, and waived all right to claim that the cause is in this Court under the first removal, by averring, in its second petition for removal, that the suit "is now," May 28th, 1879, (that being the day the petition was sworn to by the president of the defendant corporation,) "pending in the Court of Common Pleas for the city and county of New York," and praying for its removal from that Court to this Court.

The motion to remand the cause to the State Court is granted, with costs.

D. M. Porter, for the plaintiff.

C. W. Bangs, for the defendant.

GEORGE H. WOOSTER

vs.

MARCUS MARKS AND OTHERS. IN EQUITY.

A man worked for the defendant by the piece, in the defendant's manufactory, and there used, in the defendant's business, folding guides, his own property, which infringed the plaintiff's patent: *Held*, in a suit in equity, that the defendant had infringed the patent.

(Before WHEELER, J., Southern District of New York, December 22d, 1879.)

WHEELER, J. Folding guides, for which the orator has a patent, have been used in the defendants' manufactory. The only question in this case is, whether they have been so used there as that the defendants are themselves liable for the infringement. They were procured and used by a man, whom one of the defendants, in his testimony, calls "our man," and who worked for them there and was paid for his labor by the piece, furnishing his own tools of this sort. They knew of this use of the guides, but not that they were patented, and stopped the use when they were informed of that fact. Under these circumstances, he was using the guides for them, in their business. The mode of payment made it none the less so; and they, at least, participated in the tort which constituted the infringement. An action at law would lie for this participation, and this bill in equity, which rests upon the same foundation, although, in some respects, for different relief, will lie also. The question is not at all as to the extent of infringement, but only as to the fact of infringement at all. Upon the evidence as to that, although it was fairly debatable, it is found that the defendants have infringed to some extent.

Let a decree be entered for an injunction and an account, according to the prayer of the bill, with costs.

Frederic H. Betts, for the plaintiff.

William A. Coursen, for the defendants.

THOMAS SIMS *vs.* ELIAS SIMS.

Subdivision 3 of § 639 of the Revised Statutes, in regard to the removal of causes, is not repealed by the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 471.)

Where a suit has been tried in the State Court and a judgment had for the plaintiff, and such judgment has been reversed, on appeal, and a new trial or

dered, and proceedings, by the defendant, to remove the cause into this Court, are taken before the new trial is had, the application for removal is made before "the trial or final hearing of the suit," and in time, under said subdivision 3.

(Before BLATCHFORD, J., Northern District of New York, December 23d, 1879.)

BLATCHFORD, J. The petition for removal in this suit makes out a case falling strictly within the provisions of subdivision 3 of section 639 of the Revised Statutes of the United States, and the affidavit required by that subdivision was filed. The petition and affidavit were filed before "the trial or final hearing of the suit." The proper bond was given. The State Court accepted and approved the bond and made an order of removal.

This suit is an action at law, sounding in damages, for breach of a contract. It was tried in the State Court, and the plaintiff had a money judgment, in April, 1875. That judgment was reversed by the Court of Appeals of New York and a new trial was ordered. The remittitur or mandate from the Court of Appeals was filed in the Supreme Court, where the suit was pending, and an order was entered by that Court, December 30th, 1878, ordering a new trial. The proceedings for removal were taken before any new trial was had. The petition for removal alleges that the cause "is now at issue and pending for trial" in the State Court. This, in connection with the other allegations in the petition, as to the history of the case, is a substantial allegation that the new trial has not been had. Under these circumstances, the application for removal was made in time, under said subdivision 3. (See the authorities collected in *Dillon on Removal of Causes*, 2d *ed.*, *p.* 54, *n.* 82.)

The petition for removal refers to the Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 558,) now subdivision 3 of section 639 of the Revised Statutes, and to the Revised Statutes, as being provisions of law under which the removal is sought. It only remains, therefore, to consider whether subdivision 3 of section 639 is still in force, not repealed by the Act of

March 3d, 1875, (18 *U. S. Stat. at Large*, 471.) I do not deem it necessary to go into a full discussion of the question, as that was done by the late Judge Ballard, in *Cooke* v. *Ford*, (4 *Central Law Journal*, 560.) He came to the conclusion that that subdivision is not repealed by the Act of 1875. No binding or satisfactory decision to the contrary is cited, and I concur in that conclusion. This is the view of Judge Dillon, (*Removal of Causes*, 2*d ed.*, *pp.* 28, 29,) and he there states that it has been so decided "in the 8th Circuit, by Mr. Justice Miller, and generally in the Courts of that Circuit, and, so far as we are advised, by the Circuit Courts elsewhere."

I have considered the other points urged as grounds for remanding the cause, and do not deem it necessary to comment on them particularly. They are overruled.

The motion to remand is denied.

James C. Strong, for the plaintiff.

A. G. Rice, for the defendant.

THE CHICAGO, ST. LOUIS AND NEW ORLEANS RAILROAD COMPANY

vs.

HENRY S. MCCOMB AND THE SOUTHERN RAILROAD ASSOCIATION. IN EQUITY.

In determining, under the first clause of § 2 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470,) whether a suit is one in which there is a controversy between citizens of different States, the condition of the controversy when the petition for removal is filed is what is to be considered, and not its condition at a subsequent time. There must be a controversy between citizens of different States when the petition is filed, and all the parties on one side of such controversy must unite in the petition for removal, and they

must all then be of different State citizenship from any of the parties on the other side of such controversy.

A corporation defendant, which is not a real or actual or necessary party, but is a merely formal party, to the controversy in the suit, as such controversy stands when the petition for removal is filed, is to be considered as not a party.

The controversy is to be judged of, in part, by the pleadings, if any, which had been put in, in the State Court, before the filing of the petition for removal.

In a suit by a corporation of one State against a citizen of another State, it is sufficient, in a petition for removal by the defendant, under the first clause of said § 2, to state, that the defendant *is* a citizen of such other State, and it is not necessary to state that he was such citizen when the suit was commenced.

Nothing had transpired, in pleading or evidence, since the case came into this Court, to show that said formal defendant ought now to be held to be an actual, real and necessary defendant; and a motion to remand the cause was denied.

(Before BLATCHFORD, J., Southern District of New York, December 31st, 1879.)

BLATCHFORD, J. The defendants in this suit filed in the State Court in which the suit was brought a petition for its removal into this Court. The petition was that of both of the defendants. It set forth, "that the plaintiff is, as alleged in the complaint, a corporation, existing under the laws of the States of Louisiana, Mississippi, Tennessee and Kentucky; that the said Henry S. McComb is a citizen of the State of Delaware, and that the defendant, the Southern Railroad Association, is a corporation existing under the laws of the States of Mississippi and Tennessee; that the said action was commenced against the defendant Henry S. McComb alone, by the service of a copy of the summons and complaint therein upon the said Henry S. McComb on the 28th day of May, 1878, and that said defendant has not yet appeared in said action; that no service of process in said action has yet been made upon the defendant, the Southern Railroad Association; that the matter in dispute in this action exceeds, exclusive of costs, five hundred dollars; that it relates to certain railroad bonds amounting to over $475,000 in par value; and that a controversy has arisen in this action between citizens of different States, and the defendants desire to remove the said action from this Court to the Circuit Court of the United States for the Southern District of New York, in which Dis-

trict the said suit is pending; wherefore, the petitioners pray that the said suit may be removed from this Court to the said Circuit Court of the United States for the Southern District of New York, and that this Court will proceed no further in this action." The petition is dated and verified June 1st, 1878. A proper bond accompanied it. On the 6th of June, 1878, the State Court made an order in the cause, reading as follows: "The defendants in this action having, pursuant to the third section of the Act of the Congress of the United States, approved March 3d, 1875, made and filed in this suit, in this Court, their petition for the removal of this suit into the Circuit Court of the United States for the Southern District of New York, and having made and filed therewith a bond, with good and sufficient surety, for the defendants' entering in such Circuit Court, on the first day of its next session, a copy of the record in this suit, and for paying all costs that may be awarded by the said Court if said Court shall hold that this suit was wrongfully or improperly removed thereto, and also for there appearing and entering special bail in such suit, if special bail was originally requisite therein, now, on motion of C. W. Bangs, attorney for the said defendants, for this purpose, it is ordered that the said petition and bond be accepted, and it is hereby declared that this Court will proceed no further in this suit, and this cause is hereby declared to be removed to said Circuit Court of the United States for the Southern District of New York."

This suit, if removed, is removed under the first clause of the 2d section of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470.) The petition for removal is framed under that clause. That clause, so far as it applies to this suit, provides, "that any suit of a civil nature, at law or in equity, * * * hereafter brought in any State Court, where the matter in dispute exceeds, exclusive of costs, the sum or value of five hundred dollars, * * * in which there shall be a controversy between citizens of different States, * * * either party may remove said suit into the Circuit Court of the United States for the proper District."

A motion is now made by the plaintiff to remand this cause to the State Court, on the following grounds, stated in the notice of motion: "*First*, that the said cause is not properly removable into this Court under any of the laws of the United States providing for and regulating the removal of causes from the State Courts into the Courts of the United States; *Second*, that it does not appear, from the petition for the removal of the cause, or otherwise, that the said defendant McComb was, at the time of the commencement of said suit in the said Superior Court of the city of New York, a citizen of the State of Delaware, or a citizen of a State other than the States of which the plaintiff is a citizen; *Third*, that it does appear, from the papers and pleadings heretofore filed in this suit, that the said defendant, the Southern Railroad Association, is a necessary adverse party defendant to the case made and stated in the plaintiff's bill, and it also appears that said defendant is a citizen of the same State or States with the complainant."

On the 4th of November, 1878, the plaintiff filed a bill of complaint in this Court, which avers the bringing of this action in the State Court, and "that, thereafter, the said Henry S. McComb, according to the provisions of the statutes of the United States in such case made and provided, removed the said action into this Court." McComb put in an answer, in this Court, to said bill, in which those averments are admitted. The Southern Railroad Association and McComb, "as the alleged president, or as otherwise an officer of the Southern Railroad Association" put in an answer and disclaimer, in this Court, to said bill, in which it is averred, "that neither the said the Southern Railroad Association, nor the said Henry S. McComb, as the president, or as otherwise an officer, of the said the Southern Railroad Association, had, at the time of the commencement of this suit, or at any time since, or now has, in its or his possession, or under his or its control, nor has he or it, at any time since the commencement of this suit, claimed, nor does he or it claim, any right, or title to, or interest in, any of the first or second mortgage

bonds of the Mississippi Central Railroad Company, touching which any discovery or relief is sought by the said bill, and they, as such officer and corporation as aforesaid, severally disclaim having any right, title or interest, in, to or upon any of the first or second mortgage bonds or things in action in respect to which this suit appears by the said bill to be brought."

In determining, under section 2 of the Act of 1875, whether a suit is within the description of one "in which there shall be a controversy between citizens of different States," so that "either party may remove said suit" into a Federal Court, it is plain, that the condition of the controversy at the time the petition for removal is filed in the State Court is the condition of the controversy which must be taken into consideration, and not the condition of the controversy at a time subsequent to the filing of such petition, if there be a difference between the condition of the controversy at the one time and its condition at the other time. There must be, in the suit, a controversy between citizens of different States, at the time the petition for removal is filed, and all the parties on one side of such controversy must unite in the petition for removal, and, when they so unite, they must all of them be, at that time, of different State citizenship from any of the parties on the other side of such controversy. This is understood to be the view of the Supreme Court, so far as it is expressed in the recent decision of that Court in *Meyer* v. *Construction Co.*, (10 *Otto*, 457.)

In the present case, the petition for removal states, that the plaintiff is a corporation of Mississippi and Tennessee, and that the defendant, the Southern Railroad Association, is a corporation of Mississippi and Tennessee. Therefore, if the Southern Railroad association was, when the petition for removal was filed, a real and actual and necessary, and not a merely formal, party to the controversy in the suit, as such controversy stood at that time, this suit could not be removed into this Court by virtue of the petition which was filed under the first clause of said 2d section, because there was

not, at that time, the necessary diversity of citizenship between the plaintiff and the Southern Railroad Association.

That controversy must be judged of, in part, by the pleadings, if any, which had been put in in the State Court, prior to the filing of the petition of removal. In this case, the only pleading in the State Court, when the petition for removal was filed, was a complaint. That complaint relates, in the first place, to $106,000 of first mortgage bonds, alleged to have been illegally re-issued. Of those, it is alleged that $79,500 "are now held and claimed by the defendant, Henry S. McComb, as hereinafter stated." It then alleges, that certain second mortgage bonds, which it claims are invalid, are "in the hands of the said McComb," and that "said McComb claims to hold and own the same in his own right or for the Southern Railroad Association, and has demanded of this plaintiff that it should recognize the said bonds as outstanding and valid obligations." Again, in regard to such second mortgage bonds, it alleges, "that the greater portion thereof are now in the possession or under the control of the said Henry S. McComb, and that he claims to hold and own the same either individually or as an officer of, or for the benefit of, the said Southern Railroad Association, or of said associates or corporators therein;" and that "the said Henry S. McComb does not distinctly designate the particular right or title by which he claims the same, but he claims and demands that plaintiff should recognize these bonds and the coupons thereof, as valid and existing bonds and obligations secured under the said second mortgage." It then alleges, that "the said second mortgage bonds held by said McComb, or in his possession and control, as aforesaid, and which * * * he now claims and demands, without right, to hold and enforce against plaintiff and its property," are numbered so and so, "amounting, in all, to $398,300." It then avers, "that the said Henry S. McComb claims to hold as his own, or in behalf of parties he does not disclose, $79,500 of the said amount of $106,000" first mortgage bonds, "and threatens to enforce

the same, as he does the said $398,300 of second mortgage bonds, against this plaintiff." There are no averments in the complaint which vary or control the foregoing. It is plain, from them, that McComb is the real defendant, holding, possessing and controlling the bonds which are attacked. The averments of the complaint are not sufficiently specific as to the Southern Railroad Association, to make it a necessary party, or any other than a formal or nominal party. Then the answer and disclaimer of the Southern Railroad Association, sworn to by McComb, in this Court, January 31st, 1879, may be used, on this motion, as an affidavit, to the effect, that the Southern Railroad Association did not have, at the time this suit was commenced or at the time the petition for removal was filed, any of said bonds in its possession or under its control, and that it did not, when the petition for removal was filed, claim any right or title to or interest in any of said bonds. On this state of facts, it must be held, that the Association was a merely formal party to the suit, at the time the petition for removal was filed, and that the suit and the whole suit was removed into this Court by the proceedings which were had. These views dispose of the first and third grounds specified in the notice of motion.

As to the second ground, the petition for removal states that McComb *is* a citizen of the State of Delaware but does not state that he was such citizen when the suit was commenced. This question has been decided by this Court in *McLean* v. *St. Paul & Chicago Railway Co.*, (16 *Blatchf. C. C. R.*, 309,) in which the same point was taken as to a petition for removal under the Act of 1875, and was overruled.

I do not understand that there is anything which has transpired, in pleading or evidence, since this case came into this Court, which goes to show that the Southern Railroad Association occupies such a different position in regard to the controversy, that it must now be held to be, in this Court, an actual, real and necessary defendant, although it may appear

to have been only a nominal or formal defendant when the petition for removal was filed.

The motion to remand the cause is denied.

John F. Dillon, for the motion.

Francis N. Bangs, opposed.

MARY J. C. MICOU, ADMINISTRATRIX, WITH THE WILL ANNEXED, OF ANN C. SIMS

vs.

C. DE ROSSETT LAMAR, EXECUTOR, &C., OF GAZAWAY B. LAMAR. IN EQUITY.

L., in 1855, was appointed by the Surrogate of Richmond county, New York, guardian of the person and estate of S., an infant 4 years of age. He accepted the trust, and gave a bond, and took possession of money and other property of S. L. was, at the time, a citizen of Georgia, and S. was a citizen of Alabama, temporarily residing in New York. In 1861, the war of the rebellion occurred between the United States and those two States. L. having died, and never having accounted to said Surrogate, S., having become of age, brought this suit, in 1875, against L.'s executor, for an account. He set up, in defence, that L. and S. aided the rebellion, which lasted 4 years; that the property of L. and of S. was liable to confiscation by the United States; that L. could not, during the war, account to said Surrogate; that, by the war, the relation of guardian and ward ceased, in respect to such accounting; that L., at the request of S. and her natural guardians, all citizens of Alabama, withdrew her funds from New York and invested them in securities authorized by the laws of Georgia and Alabama and of the Confederate States; that, in 1867, he accounted with M., who had been appointed the legal guardian of S., by the proper Court in Alabama, where she then resided, and received from him a release; that S., when she became of age, ratified such release; and that the plaintiff is the sole legatee of S. and ratified all the acts of L.: *Held*,

(1.) Notwithstanding the war, S. had, after its termination, a right to call on L. to account;

(2.) It is no defence, that L. made the investments he did to prevent the property of S. from being confiscated;

(3.) Although the appointment of the new guardian in Alabama was proper, and the defendant must be credited with what L. paid to the new guardian, he was still liable to account in this suit, notwithstanding the new guardian had given L. a full discharge, on receiving the said securities in which L. had invested the funds of S., the defendant being credited with anything realized from such securities;

(4.) Ratification by S. is not proved;

(5.) The plaintiff, before the death of S., had no such interest as would make her acts and admissions binding on her when she afterwards became administratrix of S.;

(6.) L. took the risk of the unlawful investments, and must make good what he received, with interest and annual rests.

(Before CHOATE, J., Southern District of New York, January 2d, 1880.)

CHOATE, J. This is a suit brought by the plaintiff's testatrix, Ann C. Sims, in the Supreme Court of the State of New York against the defendant, as executor of Gazaway B. Lamar. The case was removed into this Court by the defendant, and, the plaintiff having died, the suit was revived in the name of the present plaintiff, her administratrix.

The complaint alleges, that, on the 21st day of December, 1855, the defendant's testator, Gazaway B. Lamar, was duly appointed, by the Surrogate of Richmond county, guardian of the said Ann C. Sims, then an infant of about four years of age, and then residing in said county of Richmond; that he accepted said trust and gave bond as required by law; that, on or about January 1st, 1856, he took into his possession all the property of said infant, being more than $5,000, in cash and other property; that he never, during his lifetime, rendered an account of said guardianship to the Surrogate of Richmond county, or to any Court having cognizance thereof, or to the plaintiff; and that the said infant has become of full age, and has demanded an account, which the said guardian and his executor have neglected to give. The prayer of the complaint is for an account and payment of the balance found due.

The answer of the defendant avers, that the said Gazaway

B. Lamar was a citizen of Georgia, and said infant was a citizen of Alabama, having a temporary residence in the city of New York, when the said Lamar was appointed guardian of said infant, as alleged in the complaint; that, in the year 1861, the States of Georgia and Alabama declared themselves to have seceded from the United States, and to constitute members of the so-called Confederate States of America, whereupon, a state of war arose between the United States and the Confederate States, which continued to be flagrant for more than four years after the spring of 1861; that the said Lamar and Ann C. Sims were, in the spring of 1861, citizens and residents of Georgia and Alabama, respectively, and citizens of the Confederate States, and were engaged in aiding and abetting the State of Georgia and the Confederate States in their rebellion against the United States, and so continued till January, 1865; that the United States, by various public Acts, declared all the estate and property of the said Lamar and the said Ann C. Sims to be liable to seizure and confiscation, and they were outlawed and debarred of any access to any Court of the United States, whereby it was impossible for the said Lamar to appear in the Surrogate's Court of Richmond county, to settle and close his accounts there, and to be discharged of his liability as guardian, in consequence whereof the relation of guardian and ward ceased and determined, so far as the same depended upon the order or decree of said Surrogate's Court; that, for the purpose of saving the money and property of said Ann C. Sims from seizure and confiscation by the United States, the said Lamar, at the request of said Ann C. Sims, and of her natural guardians, all citizens of Alabama, withdrew the funds belonging to her from the city of New York, where they were declared to be forfeited and confiscated, and invested the same, for her benefit and account, in such securities as, by the laws of Alabama and Georgia and of the Confederate States, he might lawfully do; that, on the 15th day of March, 1867, at the written request of said Ann C. Sims, and of her natural guardians, one Benjamin H. Micou was appointed her legal guard-

ian, by tho Probate Court of Montgomery county, in the State of Alabama, where she then resided; that said Lamar accounted with, and paid over to, said Micou, as guardian, all the estate with which he was chargeable as guardian, and received from said Micou, as guardian, a full release therefor; and that the said Ann C. Sims ratified and confirmed the same, when she became of age.

A similar suit was brought by Ann C. Sims, as administratrix of Martha W. Sims, her sister, of whom the said Lamar was at the same time appointed guardian. Martha W. Sims died in 1864, at the age of fifteen years, unmarried and intestate, leaving the said Ann C. Sims her next of kin. The complaint in such second suit states a cause of action similar to that stated in the suit of Ann C. Sims. The answer in that case states the same defences, of the dissolution of the relation of guardian and ward by the war, and the withdrawal of the funds to save them from confiscation. It also avers, that all the rights of Martha W. Sims vested, at her death, in Ann C. Sims, and that the settlement with Micou, as guardian, and his release, discharged the said Lamar from all liability as guardian of Martha W. Sims.

After the revival of these suits in the name of the present plaintiff, cross suits were commenced in this Court, by the defendant, against the present plaintiff, setting up the same defences as in his answers to the original complaints, and further averring, that the present plaintiff is the sole legatee under the will of Ann C. Sims, and entitled to receive, in her own right, whatever shall be recovered in these actions; and that the present plaintiff, as one of the natural guardians of said infants, approved and ratified all the acts of said Lamar, as their guardian, and is, therefore, estopped to deny that those acts were in all respects legal and proper. The present plaintiff, in her answers in the cross suits, denies that she was one of the natural guardians of said infants, and denies the approval and ratification of the acts of the guardian.

The four suits have been tried together, upon an agreed statement of facts.

The appointment of the defendant's testator as guardian of the two infants, by the proper Court of the place of their domicile at the time of the appointment, and his receipt, soon afterwards, of moneys belonging to his wards, are admitted. The condition of his bond, which is made a part of the complaint, is, that he "will faithfully, in all things, discharge the duty of a guardian, according to law, and render a true and just account of all moneys and property received by him, and of the application thereof, and of his guardianship, in all respects, to any Court having cognizance thereof, when thereunto required." The letters of guardianship appoint him "the general guardian of the person and estate of said minor, until she shall arrive at the age of fourteen years, and until another guardian shall be appointed," and require him "to safely keep the real and personal estate of said minor, and not to suffer any waste, sale or destruction of the same," &c., "and to deliver the same to her when she becomes of full age, or to such other guardian as may be hereafter appointed, in as good order and condition as when received, and also to render a just and true account," &c., "in any Court having cognizance thereof, when required."

The Court to which the ward resorted for an account and relief was a Court of general equity jurisdiction, and, therefore, a Court having cognizance thereof, and the causes of action alleged in these complaints are fully sustained by these admitted facts, unless the matters alleged in the answer are, if sustained by the evidence, valid defences to the guardian.

(1.) The first ground of defence insisted on is, that, by the war, the relation of guardian and ward was terminated. Hence, it is argued, that, though the former guardian continued to hold, upon some kind of a trust, the assets which he had received as guardian, yet he no longer held them as guardian under and according to the laws of New York; that, the guardian and ward having both acquired new domiciles out of this State, and within the territory of what became, at least pending the war, an alien and a hostile State, this personal domestic relation was thereby wholly broken, and did

not revive when the war ceased, and the guardian was no longer accountable to the Courts of New York, as guardian, even after the close of the war. I can see no ground whatever for this position, so far as concerns the care and safe keeping of the property of the ward in the hands of the guardian, and his liability to account for it after the war was over. Doubtless, during the war, if the guardian had remained here, and his ward had become an alien enemy, his duties as guardian would be modified by that fact. He could not properly or legally remit funds for her support to any person in the hostile territory. But, he would still be under the same obligation as before, as to the safe keeping of the property, and, whenever the ward ceased to be an alien enemy, by the termination of the war, there was no legal obstacle to her calling the guardian to an account for the property so held. Even if the war dissolved the relation, the effect of such dissolution would not be greater than would be that of the termination of the guardianship by the death of the ward, and, if the ward had died before the war began, the guardian must still account to her legal representative. If he ceased to be guardian, he still remained a trustee of the property, upon precisely the same trusts, as to its safe keeping, and under the same liability to account for it, according to the tenor of his appointment and bond, as before. The case of a copartnership between citizens of hostile States being dissolved by war is cited as controlling this case. If it were wholly analogous, which it does not seem to be, I do not perceive that it would touch the present question. By the acceptance of his appointment and his bond, the defendant's testator undertook and agreed to do certain definite things with the funds he received, to keep them invested in a certain way, which the law prescribes, and to account for them when required. It is alleged that he has failed to do so. It, certainly, is no answer for him to say, that, of his own free will, he made himself an alien enemy of the State of New York and of the United States, and thereby discharged himself from the obligation thus assumed under the laws of New York.

Yet, this is what this defence amounts to, so far as it rests on his becoming a resident of Georgia, and, as such, engaging in the war against the United States. So far as this defence rests on the ward's being an alien enemy, her right to call him to account in respect to the funds received by him as guardian, before the war, was suspended, not annulled, by the war. In *Insurance Co.* v. *Davis*, (95 *U. S.*, 425, 430,) the Supreme Court says: "If the agent has property of the principal in his possession or control, good faith and fidelity to his trust will require him to keep it safely during the war, and to restore it faithfully at its close." If this is so of an agent, it must, certainly, be said, with equal force, of a guardian, that good faith and fidelity to his trust will require him to keep his ward's money and its accumulations safely during the war, and to account for it at its close. Nor can the guardian better his position, in this respect, by himself voluntarily going into rebellion, as this guardian went from New York to Georgia, to join in a rebellion, for, he could not, by any act of his own, short of the complete discharge of his duty, relieve himself from his liability.

(2.) The next defence urged is, that the guardian, to prevent the confiscation of the ward's money, withdrew it from its investment in bank stock in New York, and sent it to Montreal, Canada, where it remained invested, by his direction, in the bonds of cities within the rebel States and in Southern railroads. This point is, clearly, untenable. It is not contended that the new investments made were such as a guardian is allowed to make according to the laws of New York, and they were, obviously, extra hazardous. They are not to be justified on the plea that, if the funds had remained here, invested according to law, they would be liable to be confiscated by the United States. It is no part of the duty of a guardian to protect his ward's money against the lawful demands of his own Government. If, under such lawful demands, they are seized, the guardian would no longer be responsible for them. His duty, as a citizen, to interpose no obstruction to the efforts of his own Government in carrying

on war, is his first duty. It is superior to any obligation he owes to his ward. If his ward's money was forfeited to the United States, he had no right nor duty to prevent, by its removal, the superior rights of the Government over it from being asserted. Moreover, the proofs show, that what he did was, under color of protecting his ward's interests, to allow the funds to be loaned to cities and other corporations which were aiding in the rebellion, and, by this very act set up in excuse, he gave aid and comfort to the enemies of his Government. Such an act could not be pleaded in justification, because in itself unlawful, even if the circumstances warranted a removal of the fund to avoid confiscation, which, clearly, they did not.

(3.) Another ground of defence set up is the transfer of what remained of the fund, in 1867, to a new guardian in Alabama, and his alleged release of the defendant's testator. At the time of the appointment of Mr. Micou guardian by the Alabama Court, the infant, Ann C. Sims, was domiciled in that State. The appointment was made upon her written request, and, as it appears by the statutes of Alabama put in evidence, it was, in all respects, in conformity with those statutes, and by a Court of competent jurisdiction. It is objected, on the part of the plaintiff, that a new guardian cannot be appointed till the former guardian is removed or superseded. This may be the rule where both guardians are appointed within the same jurisdiction. There seems, however, no legal objection to there being several guardians in several different States, if the infant has property in different States, which requires the care of a guardian. The defendant's testator was appointed guardian of the person and property of the infants. When they removed from the State of New York, which they did, with the relatives with whom they lived, in the year 1856, his duty and power, as guardian of the person, may have ceased or been suspended, at least until they might return, on the ground that his appointment, under the laws of New York, would give him no power to control their persons beyond the local jurisdiction of those laws; and,

when the infants became, as they did, domiciled in Alabama, I think the power of the State of Alabama to provide, by law, for the appointment of a guardian of their persons, and of such property as they might have within its jurisdiction, cannot be questioned. The fact that there was already a guardian of some of their property in another State or country is not inconsistent with the exercise of this power; and it would, certainly, be most proper, and, in many cases, convenient and for the true interest of the infant, that, in case of a change of domicile, a new guardian should be appointed within the new jurisdiction; and a transfer of funds from a former guardian to the new guardian appointed in the State of the infant's domicile, might, also, be very properly authorized by the Court to which the former guardian is accountable, upon the same principles of equity and comity on which the transfer of funds in the hands of an executor or administrator, to an executor or administrator in another State, may be authorized. (*Parsons* v. *Lyman*, 20 *N. Y.*, 103.) In the present case, the former guardian, Mr. Lamar, requested of the near relatives of the infant the appointment of a new guardian. His reasons were his age and growing infirmities, and his own business cares and perplexities; and the appointment was asked for and made in accordance with this request. The reasons were valid and sufficient, and the circumstances made it proper that the new guardian should be appointed in Alabama; and I cannot doubt that, if the defendant's testator had applied to the Surrogate's Court of Richmond County, for leave to resign his trust and to transfer the ward's estate to the duly appointed guardian in Alabama, his petition would have been granted. What would thus have been approved as just and right, if asked for, can now be justified as done for the benefit of his ward. Therefore, in any accounting to be had, the defendant's testator should be credited with his cash payment to the new guardian, of $808 70. But, beyond this, the transaction referred to as a settlement with and release of the defendant's testator by the new guardian, neither purported to be, nor could, if so

understood and intended by the parties, be a release of the former guardian from his liability to account for the residue of the infant's estate with which he was chargeable. The new trustee merely gave a receipt for sundry securities, mostly worthless, which the defendant's testator turned over to him. They were the remains of the investments which had been made of the ward's property. But, the original investments, being in bank stock, had been not such as the ward was, when of age, bound to accept; and, by the changes of value effected by the war, and by the investments made in consequence of the war and during the war, the result was, that the rest of the fund consisted of bonds of Southern cities and Southern railroads, of little value. It is too plain for argument, it seems to me, that a new guardian has no power to accept a transfer of such properties, as a full discharge of the former guardian's liability to account for and make good the moneys originally received. Such an act would be a gross abuse of his trust, by the new guardian. No Court would authorize or justify it, and, certainly, a guardian has no power, by virtue of his appointment, thus to give away the property and rights of his ward. If the new guardian has actually realized anything from the securities transferred, I see no reason why, in the taking of the account, the defendant's testator should not be credited with it.

(4.) The defence of a ratification by the ward is not made out by the evidence. Such a ratification must be very clearly proved, and it must appear that it was made with full knowledge of all the facts, and a full understanding of the legal rights of the ward, affected thereby. (*Adair* v. *Bremmer*, 74 *N. Y.*, 539, 554.) Neither of these circumstances is shown in this case. It is true, that, Ann C. Sims, in 1867, made a written request for the appointment of a guardian in Alabama, in place of her former guardian. She was then about sixteen years old. She became of age June 1st, 1872, and commenced this suit July 1st, 1875. She was not shown to have meanwhile done any act waiving her claim. It is true, that her uncle and aunt Micou, with whom she lived, had

written letters expressive of their gratitude to the defendant's testator for doing as well by their niece as he had done; but those letters do not bind the ward, and, if they did, they are not shown to have been written with a full knowledge of the ward's rights.

(5.) The additional defence set up in the cross suits is, also, untenable. Mrs. Micou, the present plaintiff, at the time the alleged acts of approval by her were done, did not stand in the relation of a natural guardian to the infants, having any power, as such, over their estate. She was their aunt, and, after the death of Martha W. Sims, she was one of the next of kin of the surviving infant, Ann C. Sims. A guardian upon whom the law throws the real responsibility for the proper and legal investment of his ward's money, cannot relieve himself from that responsibility by pleading the advice, direction or approval of his ward's relatives, however near; and Mrs. Micou, before the death of Ann C. Sims, had no such interest in her estate as would make her admissions and acts binding on her, when afterwards she became the administratrix of Ann C. Sims. Nor is the evidence of ratification and approval satisfactory, even in respect to the present plaintiff, for the reasons above stated.

(6.) Although the defendant's testator acted without any other real purpose, as it seems, than to do what he thought for the best interest of his ward, yet he took the risk of investing the funds in a manner not allowed by law, and he must, therefore, make good the amount received, with interest and annual rests. (*King* v. *Talbot*, 40 *N. Y.*, 76.) The fact that down to the time of the war there had been no depreciation in fact is immaterial. The ward may now elect to reject the investment altogether. The guardian is to be allowed all payments made by him for the support and education of the infants, as the same appear on his accounts rendered, which are admitted to be, in that respect, correct.

(7.) The defendant's testator received for his wards, from time to time, a certain proportionate part of the dividends on stock of the Mechanics' Bank, a Georgia corporation. The

plaintiff insists that the defendant's testator should be charged with the infants' proportionate part of the value of this stock. The evidence is not sufficient to show what interest, if any, the infants had in this stock, or whether the defendant's testator could, by appropriate proceedings in the Courts of Georgia, for ancillary letters of guardianship, or otherwise, have obtained possession, as guardian, of this interest. If he could have done so, it seems that it would have been his duty to do it. (*Schultz* v. *Pulver*, 11 *Wend.*, 361.) But, this question will more properly arise when an account shall have been taken and the facts are all before the Court.

There must be decrees for an account, in the original suits, and dismissing the bills in the cross suits, with costs.

S. P. Nash and *G. C. Holt*, for the plaintiff.

E. N. Dickerson and *C. C. Beaman, Jr.*, for the defendant.

THE EMMA SILVER MINING COMPANY, LIMITED

vs.

THE EMMA SILVER MINING COMPANY, OF NEW YORK, AND OTHERS. IN EQUITY.

The defendants having, with the leave of the Court, filed several pleas, some to the whole bill and some to parts of the bill, and having set forth therein the existence of certain records, being judgments in suits at law, which were pleaded in bar, the Court, on motion of the plaintiff, and before he had replied to the pleas or set them down for argument, made an order referring it to a master to ascertain and report as to the truth of the existence of records in any way corresponding with those set forth in the pleas, and to return copies of the records, unless the defendants should file, with the pleas, copies of the records.

(Before CHOATE, J., Southern District of New York, January 14th, 1880.)

CHOATE, J. In this case, the several defendants have filed, with the leave of the Court, several pleas, some of which are to the whole bill and some of which are to parts of the bill. In these pleas they have set forth the existence of certain records, being judgments in suits at law in this Court and in Courts of Utah. These judgments are pleaded in bar of this suit, or of part or parts of the relief sought by the bill. The complainant now, without replying or setting down the pleas for argument, moves that it be referred to a master to take proof of the truth of the pleas. The purpose designed to be accomplished by the motion, as stated upon the argument, is, that, if the pleas or some of them are set down for argument, the judgments so pleaded may, upon the argument, be before the Court; and a further reason alleged for the motion is, that, from the peculiar averments in the pleas as to the effect of the former judgments, and the inferences of fact and law drawn from them in the pleas, which may be correct inferences from the records, as recited, but which might not be held to be correct inferences from the records themselves, if exhibited at large, the complainant ought not to be compelled to elect whether to reply to the pleas or to set them down for argument, without the production of copies of the records, as parts of the pleas.

It is insisted by the defendants, that there is neither precedent nor authority for granting this motion, and that the practice established by the Equity Rules of the Supreme Court, 33 to 38, is inconsistent with such a practice and allows only one of three courses for the complainant, either to demur, take issue, or set down for argument.

The 90th Rule of the Supreme Court provides, that the practice of this Court "shall be regulated by the present practice of the High Court of Chancery, in England, so far as the same may reasonably be applied, consistently with the local circumstances and local conveniences of the District where the Court is held, not as positive rules, but as furnishing just analogies to regulate the practice." On the question whether the practice of the English Court of Chancery sanc-

tions the reference to a master to ascertain the truth of a plea setting up a former judgment or decree in bar of the suit, I think there is abundant authority in favor of the practice. The defendants claim, that the practice, if any, is limited to pleas of another suit pending, and, perhaps, to pleas of another suit pending in the same Court. But, this is not the result of the cases, nor of the discussion of the matter by the commentators. In *Morgan* v. *Morgan*, (1 *Atk.*, 53,) before Lord Chancellor Hardwicke, in 1738, it is reported as laid down by the Lord Chancellor in that case, as a rule, that, where a defendant pleads a decree of dismission of a former cause, for the same matters, in bar of the plaintiff's demand in his new bill, if the plaintiff does not apply to the Court, that it may be referred to a master to state whether there is such a decree, but sets down the cause upon the new bill for hearing, it is a waiver of his right of application for such reference, and the Court will determine it. This case shows, clearly, that the practice of so referring pleas of a former judgment in bar was then recognized as proper, and as an existing practice. It does not seem to proceed on any mere rule of Court, but it establishes or recognizes the rule of practice as being in itself just and right. The reason of the rule is stated by Lord Redesdale, (*Mitf. Eq. Pl.*, 304,) as follows: "There are some pleas which are pleaded with such circumstances that their truth cannot be disputed; and others, being pleas of matter of fact, the truth of which may be immediately ascertained by mere inquiry, it is usually referred to one of the masters of the Court to make the inquiry." Among the pleas so usually referred, he mentions "pleas of a former decree," citing *Morgan* v. *Morgan*, and "pleas of another suit depending," and says, that they "are generally referred to a master, and, if the master reports the fact true, the bill stands instantly dismissed, unless the Court otherwise orders," but that "the plaintiff may except to the master's report and bring on the matter to be argued before the Court, and, if he conceives the plea to be defective in point of form or otherwise, independent of the mere truth

of the fact pleaded, he may set down the plea to be argued, as in the case of pleas in general." This statement of the practice is adopted, almost without modification, by Mr. Justice Story, (*Story's Eq. Pl.*, § 700;) and with this agree other learned text writers.

The reason for the practice thus given is, that the matter of which reference is to be made is one "the truth of which may be immediately ascertained by mere inquiry." That fact generally is the fact of the existence of a certain record. The cases show, that, in referring the truth of the plea, the questions of the identity of the parties and the identity of the cause of action may also be included in the reference to the master. (*Tarleton* v. *Barnes*, 2 *Keen*, 635; *Wild* v. *Hobson*, 2 *Ves. & B.*, 110.)

It is objected by the defendants, in this case, that to refer to a master the truth of the plea would, in effect, refer to him the trial of the issue that would be raised by a replication to the plea, and would subject the defendants to great hardship, and, indeed, not advance the cause. No doubt, in the absence of fixed rules regulating the matter to be referred, the Court would, in its discretion, limit the reference as circumstances and the nature of the pleas might require, so that it should be, in effect, what it is, indeed, intended to be, only the reference of a matter the truth of which can be immediately ascertained on inquiry. The practice being adopted for facilitating and simplifying the disposition of causes, the Court will not allow it to be used to embarrass and protract the litigation, or, under cover of a reference to a master to ascertain facts capable of being immediately ascertained on inquiry, to lead the parties into a long litigation before a master, upon a reference, which ought to be conducted in the ordinary course of proceeding, upon issue joined by the taking of proofs before an examiner, to be submitted to the Court upon the hearing of the cause.

In the present case, an inspection of the pleas shows, that, while the existence of records such as are alleged in the pleas may be immediately ascertained on inquiry, the further ques-

tions intended to be raised by the pleas, whether they are for the same causes of action, and whether or not the same evidence could have been offered in the two suits, and other matters averred in the pleas, as inferences from the records, are not questions that ought to be referred, upon the principle on which such a reference is allowed. But, as the whole purpose of this motion is to get before the Court the records alleged to be set forth according to their purport in the pleas, the truth of the existence of records answering the description of those set forth can, obviously, be immediately ascertained on inquiry; and, therefore, it falls within the principles of the practice established by the English Court of Chancery, to order such a reference.

Independently of this practice of referring the question of the truth of the averment in a plea, of the existence of a certain record, it would seem to be entirely competent for the Court, upon the suggestion of the plaintiff, or of its own motion, to require a defendant, before the plea is argued, to produce a copy of the record relied on by him, of which only a recital according to the pleader's understanding of it, or his construction of it, is set forth in the plea. Such practice can do the defendant no possible harm, and may greatly facilitate the argument of a cause, and save both parties from useless litigation, and relieve the Court from hearing and determining a merely imaginary or fictitious case. For, making all proper allowance for the plea being entirely honest and truthful, within the apprehension of the pleader, it may well be, that inferences partly of fact and partly of law, drawn from the record as set forth by the pleader in his plea, may be seen by the Court to be incorrect and impossible inferences from the record, if actually produced in full. And yet, upon the recital of the record, as contained in the plea, the Court may be obliged, upon the argument of the plea, to assume the truth of those inferences, because, upon the record, as recited, their correctness is not an impossibility. Counsel, in drawing pleas, may properly draw inferences from records, which, in their judgment, have so much plausibility that they

may be honestly urged upon the Court in argument. The bringing before the Court of the records on which the defendant relies in his plea, therefore, only precludes the defendant from temporarily availing himself of a point which must ultimately be decided against him. The practice of referring the matter to a master does really bring the records themselves before the Court, because, either party may except to the rulings of the master, and, with his report, comes up the testimony taken, including, of course, any records put in evidence; and, therefore, the objection urged by the defendants, that this reference substitutes the judgment of the master for that of the Court, on critical points of the case, has no force. The pleas in this case are, obviously, such that they cannot be properly or intelligently argued, with any hope of reaching a conclusion that will settle, or materially aid in settling, the real controversy between these parties, without having the records relied on by the defendants before the Court, in place of the recital of those records, contained in the pleas. If it be said, that it is the right of the defendants to plead what they will, I think it is a sufficient answer, that it is competent for the Court to require pleadings to be made definite and certain, and so far to control and direct the pleadings, that the trial and argument shall be brought down to the real point in controversy. If there is no precedent for an order requiring copies of the records pleaded to be brought in upon the argument of the pleas, there are analogies enough of the similar exercise of power by Courts of justice, among which may be mentioned the requiring of the profert of a deed pleaded, the directing of a bill of particulars, and the practice of requiring pleadings to be made more definite and certain, on motion. The practice of referring the truth of the plea may account for the want of precedents for such an order. It could not be questioned that it would be a reasonable rule of Court, that, in all cases where a record is pleaded, it should be set forth, in the bill or the plea, *in haec verba* or by copy annexed to the bill or plea, unless, for cause shown, excused by the Court; and I think it is equally

evident, that, where justice and the interest of all the parties require it, and the Court may thereby be relieved from hearing and deciding a merely imaginary case, the same thing may be directed by special order. There is nothing in the statutes or the rules or the principles of practice, to prevent it.

I can see nothing in the Rules of the Supreme Court to interfere with the granting of this motion. It is true, that Rules 33 to 38 imply that the plaintiff will demur, reply or set down for argument. This is but the embodiment in rules, of the ordinary Chancery practice. The reference asked for is merely preliminary to setting down for argument, or replying to, the pleas. It is not inconsistent with the Rules. These Rules do not purport to regulate all the minutiæ of practice, and they expressly adopt the principles of practice of the English Chancery, not inconsistent with these Rules. It cannot be assumed that they were intended to make the practice more difficult and cumbersome, but rather to facilitate and simplify it. Therefore, a practice obtaining in the English Chancery, not expressly or obviously inconsistent with the Rules, and which tends strongly in the direction of abbreviating litigation, and relieving the parties and the Court from unnecessary proceedings, should be deemed as adopted by the 90th Rule. This practice is of that nature.

Cases cited in which it appears that the truth of the plea as to the existence of the record has been tried under plea and replication, in ordinary course, are of no account, for, without question, the plaintiff may take that course, if he chooses.

An order will be entered referring it to a master to ascertain and report as to the truth of the existence of records in any way corresponding with those set forth in the pleas, and directing the master, with his report, to return copies of said alleged records which shall be produced before him by the defendants, unless, within ten days after entry and notice of this order, the defendants shall file with their pleas, and to be taken as parts thereof, copies of the records set forth, or in-

tended to be set forth, therein; and, if such copies are filed, then this motion to be denied; and the plaintiff is to have till the next rule day after the coming in of the master's report, or notice of such filing, to demur to, reply to, or set down for argument, the said pleas.

E. W. Stoughton, for the plaintiff.

J. E. Burrill, for the defendants.

SIMEON HOWES AND OTHERS

vs.

CHARLES MCNEAL. IN EQUITY.

On the question of the novelty of the invention claimed in a patent sued on, the file wrapper and its contents of another patent are not competent evidence to show the date of the making of the invention shown in the latter patent. Such evidence is hearsay and secondary, and the reduction to practice and use of the invention alleged to invalidate the patent sued on must be shown by direct evidence of the construction and use of a structure embodying such invention.

(Before BLATCHFORD, J., Northern District of New York, January 15th, 1880.)

BLATCHFORD, J. In this case, a motion is made by the defendant, that copies of three file wrappers, contents and drawings, in the matter of three several letters patent, may be made a part of the defendant's exhibits and proofs, with the same effect as if they had been put in evidence when said three letters patent were put in evidence, or that the suit be referred back to the examiner, with leave to the defendant to introduce such evidence, or that it be referred back for both parties to introduce further proofs, and that the interlocutory decree made herein be so far opened as that the defendant

have leave to re-argue the case after such new evidence shall have been received, with the same effect as though the same had never been argued.

The object of introducing in evidence such file wrappers is stated to be to show that the inventions described in the several patents were made at dates as early as the oaths to the specifications. That is not the proper way to show the reduction to practice and use of the inventions claimed to be prior, so as to invalidate the plaintiffs' patent. That must be shown by direct evidence of the construction and use of machines. Nothing from the Patent Office can be admitted in evidence of earlier dates than the patents. All such evidence would be hearsay and secondary. A patent is allowed, by statute, to speak, as a public grant. But the preliminary papers are merely the declarations of third persons, not parties to this suit or connected with them in interest or title. The evidence is not competent.

It may be added, that, if the three file wrappers were competent as evidence, no sufficient legal excuse is shown for not having sooner applied for leave to introduce them. The motion is denied.

E. C. Sprague, for the plaintiffs.

W. S. Farwell, for the defendant.

JOHN B. BEATTY, JR. AND ISABEL M. BEATTY, JR.

vs.

LAURA M. HINCKLEY AND CHARLES A. HINCKLEY, HER HUSBAND. IN EQUITY.

G., trustee under the will of J., of property, to receive its profits, and pay the same to B. during his life, with remainder over to the plaintiffs, turned over the property absolutely to B., who lost it. The plaintiffs brought this suit against L., the executrix of G., claiming not only that she had assets belonging to the estate of G., but that G. had conveyed to her, she being then his wife, without consideration, property of his own, more than was a reasonable provision for her in view of his violation of said trust, and probably intending to defeat such liability, which she understood: *Held*, that, in addition to responding for the assets of the estate, she must respond, and in this suit, for the property so conveyed to her.

The whole claim is one against the estate of G., in her hands as executrix, and the bill is not multifarious.

(Before WHEELER, J., Southern District of New York, January 20th, 1880.)

WHEELER, J. The wife-defendant is executrix of the will of George I. Beatty, who was trustee under the will of James Beatty, of lands and stocks, to receive and collect the rents, dividends, and profits thereof, and pay the same to James L. Beatty during his life, with remainder over to the next of kin, who are the orators, and who disposed of the property absolutely, and paid over the avails, to the amount of about $10,000, to the life-tenant, who lost the same, and which has never been paid to the orators. She has assets belonging to the estate of her testator, and it is not contended but that she should account for those and be decreed to pay the amount to the orators, but they are largely deficient. After the loss of the funds by the life-tenant, he discharged the trustee from all further claim in his behalf; and the trustee conveyed to this defendant, then his wife, without any consideration, property of his own to a considerable amount,

and more than was a reasonable provision for her in view of his liability for violating this trust, and probably intending to defeat that liability, which she understood. It is argued in her behalf, that this property so conveyed to her cannot be reached to satisfy this claim, and that, if it can be reached at all, it cannot be in this suit, with the claim against her as executrix.

There is no pretence but that the claim of the orators was a just and lawful one against her testator, in his lifetime, nor but that it is a lawful one against his estate now. It seems to follow, very plainly, that this voluntary conveyance of his property, for the purpose of defeating that claim, was fraudulent and void, as against the holders of the claim. No reference to particular authorities is necessary to establish this. But, it is said, that, if that property can be followed into the hands of the wife-defendant at all, the claim for it is distinct from that against her as executrix, for the property belonging to the estate of which she is executrix, and that joining the two makes the bill bad for multifariousness, which objection was seasonably taken; and *Ward* v. *Duke of Northumberland*, (2 *Anstr.*, 469,) and *Salvidge* v. *Hyde*, (*Jacobs*, 151,) are strongly relied upon in support of the objection. The claims, however, are not distinct. There is really but one claim, and that is in favor of the orators against the estate of the testator, in her hands as executrix. That property is claimed because, as between her and the orators, it is a part of the same estate, to be reached in her hands in the same manner as any other part. If the property had been conveyed to a third party it would have been different. Then, a suit against the other party would have been necessary, and she would be the proper party to bring it, and, if she refused, the orators could proceed against both. (*Hagan* v. *Walker*, 14 *How.*, 29.) The cases mentioned as relied upon are both distinguishable from this in this respect. The orator in each had claims against the testator and against the executor in the lifetime of the testator, each independent of the other. In attempting to enforce both in one suit they were pursuing distinct claims,

and not, as is only attempted here, one claim, against the same person, in the same right.

Let a decree be entered for an account of the amount due the orators, and of the estate of the testator in the hands of the defendant-executrix, and of the value of the personal estate mentioned in the bill as conveyed by the testator to her in his lifetime, and that the amount of the estate of the testator in her hands, and, if necessary, that so conveyed, or so much as is necessary, be paid to the orators in satisfaction of their claim, with costs.

Francis A. Baker, for the plaintiffs.

Michael W. Divine, for the defendants.

ANTONIO QUIROLO

vs.

JOHN ARDITO AND JOHN PAGLUIGHI. IN EQUITY.

Re-issued letters patent No. 6,557, granted to Antonio Quirolo, July 27th, 1875, for an improvement in stereoscopes, consisting of a combination of legs with the standard for the stereoscope to stand upon, are void, on their face, for want of novelty, within common knowledge.

Such a stand having been in use before for other things, there was no invention in putting a stereoscope upon it.

(Before WHEELER, J., Southern District of New York, January 20th, 1880.)

WHEELER, J. This suit is brought for relief against an infringement of re-issued letters patent No. 6,557, dated July 27th, 1875, granted to the orator, for an improvement in stereoscopes, consisting of a combination of legs with the standard for the stereoscope to stand upon. The answer de-

nies the novelty of the invention. It is not very clear, upon the evidence, whether stereoscopes were made to stand upon legs before they were so made by the orator; but, whether they had been or not, such stands had long been in use for surveyor's compasses, theodolites, cameras, telescopes, and other mathematical and optical instruments, as is well and generally known. Stereoscopes had been placed upon stands for a long time. This part of the patented invention does not relate to the stereoscopes themselves at all, but only to the mode of mounting them. There could be no invention in putting a stereoscope upon one kind of well-known stand instead of another. It was merely putting the old stand to a new use. So, whether the invention was known or used or described in the exact manner, or by the persons, set up in the answer or not, the patent, in this respect, which is the only one in controversy, is void, on its face, for want of novelty, within common knowledge, which is sufficient for dismissing the bill, without regard to the answer. (*Brown* v. *Piper*, 91 *U. S.*, 37; *Terhune* v. *Phillips*, 99 *U. S.*, 592.)

Let a decree be entered dismissing the bill of complaint, with costs.

L. W. Frost, for the plaintiff.

Edward N. Dickerson, Jr., for the defendants.

LUTHER GILBERT

vs.

JOHN T. LYNCH AND OTHERS. IN EQUITY.

A. and U. were partners. L. had a partnership debt against them. A. transferred his interest in the partnership assets to U., and U. became his debtor therefor. U. became insolvent and assigned his property to M., for the benefit of his creditors. Afterwards, U. was adjudged a bankrupt and M. became his assignee in bankruptcy, and, as such, recovered the property. L. assigned his debt against U. to Q., and Q. and A. proved their claims against U., in bankruptcy. M., as assignee, had in his hands a dividend on the claim of A. Q. claimed to have attached such dividend by an execution on a judgment in a State Court against A. G. afterwards proceeded in the same manner with a debt of his against A. individually. G. then brought this suit to restrain the application of such dividend to the debt to Q. and to have it applied on the debt to G.: *Held*,

(1.) The dividend was not attachable on process from a State Court, and no Court but the Bankruptcy Court could order it to be paid to any one but A.;

(2.) If the dividend was attachable, this Court could not, by injunction, restrain the proceedings;

(3.) The jurisdiction given to the Circuit Court in bankruptcy matters does not warrant this suit;

(4.) The bill shows no ground for equitable relief;

(5.) If it did, A. should be a party to the suit.

(Before WHEELER, J., Southern District of New York, January 20th, 1880.)

WHEELER, J. One Alden J. Adams and the defendant Union Adams were partners, and the defendant Lynch had a partnership debt against them. The interest of Alden J. Adams in the partnership assets was transferred to Union Adams, for which the latter became indebted to the former in the sum of six thousand dollars. Union Adams became insolvent, and assigned his property to the defendant Wootton, for the benefit of his creditors. Afterwards he was adjudged a bankrupt, and the defendant Mitchell became his assignee in bankruptcy, and, as such, recovered the property. Lynch assigned his debt against Union Adams to the defendant Quinby, and both the latter and Alden J. Adams proved their

claims against the estate of Union Adams, in bankruptcy. Quinby has received a dividend upon his claim, and Union Adams has received a discharge. A dividend to Alden J. Adams upon his claim has been ordered and is still in the hands of the assignee. Quinby commenced suit in his own name, under the laws of New York, in a Court of New York, against Alden J. Adams, recovered judgment therein, took out execution on the judgment, and placed it in the hands of the defendant Carpenter, who is sheriff of Westchester county, and of the defendant Conner, sheriff of New York county, who have claimed to attach thereon the dividend of Alden J. Adams in the hands of Mitchell, assignee. The orator has proceeded in the same manner with his debt against Alden J. Adams, but the attachment in his case is subsequent to Quinby's. He claims that he is an individual creditor of Alden J. Adams, and that, as such, he is entitled to have his debt satisfied out of the individual property of the debtor, in preference to Quinby, who is a partnership creditor, and has brought this bill to have the application of the dividend to Quinby's debt restrained, and the application of it to his debt decreed.

The defendant Quinby insists that the dividend represents Alden J. Adams's share in the partnership assets, as to which the orator is not entitled to any priority; that he is entitled to precedence because of the priority of his attachment; and that the fund is not so before this Court that it can be marshalled here. The orator urges against the defendant's claim of priority of attachment, that no attachment of the dividend in the hands of the assignee, on process out of the State Court, could be made.

That the dividend was not attachable on process from the State Courts would seem to be quite clear. While in the hands of the assignee, it would be a part of the estate of the bankrupt in the custody of the Court. It would not be the property of the debtor, but would only be property that would become his when he should get it. He could not maintain any suit against the assignee for it, nor obtain it by any legal process other than by application to the District Court

having control of the fund, as a party to the proceedings in that Court. Money in the hands of a disbursing officer of the United States, due to a private person, cannot be attached on process against such person out of a State Court, because the money will not be his, but will remain the property of the United States, until it is paid to him. (*Buchanan* v. *Alexander*, 4 *How.*, 20.) Neither can any fund be so attached that is so situated that the debtor in the process is not entitled to sue for and recover it. (*McLaughlin* v. *Swann*, 18 *How.*, 217; *Gassett* v. *Grout*, 4 *Met.*, 486.) These reasons are applicable to a dividend in the hands of an assignee. (*Colby* v. *Coates*, 6 *Cush.*, 558; *Coppell* v. *Smith*, 4 *T. R.*, 312, and *Grant* v. *Hawding, in note; In re Bridgman*, 2 *Nat. Bank. Reg.*, 252.) The order of the District Court would be, that the dividend be paid to Alden J. Adams; and there would not appear to be any tenable ground on which any other Court or officer could order it paid to any one else, or order that payment to another should be payment to him or answer the effect of the order. And, if the attachments were both wholly inoperative, as the orator claims and it seems they are, there is no ground left for making the plaintiff in the first attachment, or the attaching officers, parties here. Payment of the dividend to them by the assignee, on such process, would be no more than payment to them or any one else without process, and he would remain subject to the order to pay to Alden J. Adams, the same as before, and no interposition through this Court would make his liability any greater or different. And, if the process of the State Court would have any validity or effect in attaching the dividend, there is another reason why they should not be proceeded against in this manner here. The Revised Statutes of the United States provide (*sec.* 720,) that writs of injunction shall not be granted by any United States Court to restrain proceedings in a State Court, except where authorized by a law relating to proceedings in bankruptcy. The *express* authority to restrain such proceedings in the bankrupt law extends only to suits against the bankrupt himself. (*Rev. Stat. U. S.*, *sec.* 5,106.) The

implied authority would extend only to proceedings to realize the assets and bring them into the custody of the bankruptcy court. (*Id.*, *sec.* 4,972.) This dividend is a part of the bankrupt estate of Union Adams, but this suit has no reference to it as such, but only as a part of the property of Alden J. Adams. (*Peck* v. *Jenness*, 7 *How.*, 612.)

It is argued, for the orator, that the jurisdiction given to the Circuit Courts in bankruptcy matters warrants proceeding in this manner against this fund. This jurisdiction is given by sections 4,979 and 4,986 of the Revised Statutes. The provisions of the former section evidently relate to actions for the recovery, defence, or ascertainment, of the estate of the bankrupt for his creditors, (*Lathrop* v. *Drake*, 91 *U. S.*, 516; *Burbank* v. *Bigelow*, 92 *U. S.*, 179;) and those of the latter section to the review of decisions upon questions that have arisen in the course of the proceedings in the District Court. (*In re Alexander*, 3 *Nat. Bank. Reg.*, *quarto*, 6; *Morgan* v. *Thornhill*, 11 *Wall.*, 65.) This is not a case of either class, as is apparent from the reasons before stated; and this Court has not any fund, as such, before it, or in custody, as it would have if it were administering upon the bankrupt estate, nor on account of any other proceedings of its own, as the Court in *Burbank* v. *Bigelow* had, by the appointment of a receiver.

Still, the parties are residents of different States, and the amount in controversy is more than five hundred dollars, so that this Court has jurisdiction of the parties and of the cause of action, if there is any ground for relief. It is, doubtless, true, that, by the law of New York, where this partnership was and these transactions took place, individual creditors have a preference, as to individual property, over firm creditors, (3 *Kent's Comm.*, 65; *Murray* v. *Murray*, 5 *Johns. Ch. R.*, 60;) although the law may be different in some other places. (*Bardwell* v. *Perry*, 19 *Vt.*, 292.) But, whether the orator has such paramount lien or not does not seem to be very material to the decision here, for, the defendants are not asserting any lien that the orator is bound to take notice of,

or that can affect his rights in any degree, according to his own argument. If the defendants were about to dispose of individual property, by creating a lien upon it which would be good but for the orator's paramount equity, there would be occasion for him to assert his equity. Till then he has no ground to complain.

The assignee, holding the dividend ordered to be paid to Alden J. Adams, and the creditor of Alden, are both before the Court, and, if there were grounds for it, the dividends should be taken to pay his debt. He is not a party to this suit, but should be, if his property and rights are to be adjudicated upon in it. If that lack could be supplied, then the question would remain, whether a Court of equity could grant the relief. A bill for the purpose of appropriating the dividend to the debt would be, in effect, an action at law, (*Wilson* v. *Koontz*, 7 *Cranch*, 202;) and, if the dividend could not be reached at law, there is no good reason apparent why it could be by such a bill. There is no relief about the dividend which a Court of equity could furnish to any party, that a Court of law could not. The fund is subject to the order of the District Court, and neither could interfere with that. There must be some ground for equitable relief, in reaching the property of the debtor, before a bill will lie, in such a case. (*Public Works* v. *Columbia College*, 17 *Wall.*, 521.) There does not appear to be any ground on which the bill can be sustained.

Let there be a decree dismissing the bill of complaint, with costs to such defendants as have answered the bill.

S. Sidney Smith, for the plaintiff.

Isaiah T. Williams, for the defendants.

THE KEYSTONE BRIDGE COMPANY

vs.

JAMES H. BRITTON. IN EQUITY.

This statement: "Funds for the payment of this note at maturity have been placed in my hands, as trustee," written across the face of a promissory note, and signed by the defendant, such note having been made by a party for whom the plaintiff built a bridge, and the bridge having been delivered by the plaintiff to such party on the faith of the signing of such statement, *held*, to make the defendant liable for the full amount of the note, although he had not such funds when he signed said statement, and the plaintiff knew it.

(Before WHEELER, J., Southern District of New York, January 20th, 1880.)

WHEELER, J. The orator built a bridge across the Mississippi River, at St. Louis, for the Illinois and St. Louis Bridge Company, in which the defendant was interested, and of which he was treasurer. After the bridge was completed, but while it was still in the possession of the orator, the Illinois and St. Louis Bridge Company executed its promissory note for $51,510 95, payable in ten months after date, to its own order, at the Bank of Commerce in New York. Although the defendant at that time had not funds in his hands, as trustee, or otherwise, for the payment of the note, which the orator knew, it was arranged between him and the Illinois and St. Louis Bridge Company, that he should receive the tolls of the bridge for that purpose, which they thought would be sufficient to pay it; and a statement, written across the face of the note, in these words: "Funds for the payment of this note at maturity have been placed in my hands, as trustee," was signed by the defendant, to induce the orator to accept the note and deliver up the bridge. The note was endorsed by the Illinois and St. Louis Bridge Company and delivered to the orator. The note was equal in amount to the balance due the orator for building the bridge. The

orator took the note and delivered up the bridge, and the defendant received the tolls of the bridge. All tolls received by the defendant have been applied to the payment of the note, but they were not sufficient to pay it, and there is a large balance still due upon it. This suit is brought to compel payment. The defendant claims, that, in view of the circumstances, the true meaning of the statement signed by the defendant is, that some funds for the payment of the note had been placed in his hands, and that the extent of his obligation thereby assumed was, that he should apply to its payment what funds he so had, and that, if the statement means more than that, the undertaking beyond that is without consideration. The orator insists that the statement signifies that funds sufficient for the payment of the note are in his hands, and implies an undertaking that he will apply them to its payment, all amounting to an obligation to have funds and pay the note at maturity, which could be discharged only by payment of the note, and that evidence of a lack of funds placed in his hands is contrary to his agreement and not admissible.

The entire want of consideration for an agreement may always, between the original parties to it, be shown, for, it would not add to or vary a contract, but show that there was none. As this note was given upon a pre-existing debt of the Illinois and St. Louis Bridge Company, if, by the law where made, it would not discharge or affect the debt, proof of that fact might show a want of consideration as to the defendant, unless there was a new consideration. The proof, however, shows the delivery up of the bridge on which the debt was due; and this was an ample consideration, in which the defendant participated. There are many cases in which persons who are not parties to notes as written, but become so by putting their names upon them in blank, indicating authority to the holder to fill the blank, have been permitted to show the intention of the parties; and where persons who have become parties by signing an undertaking written out in *full* are permitted to show the circumstances under which it was done, to place the transaction in its true light. (*Good* v.

Martin, 95 *U. S.*, 90.) This case is not one of the former class, for, it is apparent that the defendant wrote what he intended to sign, and left no blank to be filled. Under the rule as to the latter class, the evidence as to circumstances is proper to be considered, to enable the Court to see the transaction as the parties saw it. When this evidence is viewed, the interpretation of the defendant's undertaking is not doubtful. The orator would not rely upon the tolls, as they should come to the defendant's hands, for the payment of the note, and the defendant executed this instrument. "Funds for the payment of the note," must be taken as signifying funds for the payment of the whole note. The defendant agreed that he had the funds for that payment, which was an agreement, in effect, that he might be treated as if he had, whether he had or not. He became situated like a receiptor of property as if it were attached, when there was none, or a person who has acknowledged the receipt and holding of property for some purpose otherwise, when none has been received; each of whom is held bound by the terms of the receipt or acknowledgment. (*Harman* v. *Anderson*, 2 *Camp.*, 243; *Stonard* v. *Dunkin*, *Id.*, 344; *Lyman* v. *Lyman*, 11 *Mass.*, 317; *Chapman* v. *Searle*, 8 *Pick.*, 38.) If he had funds in his hands for the payment of the note at maturity, a Court of equity would charge him with the payment of the amount of the note. He agreed that he had such funds, the orator took the note on faith in that agreement, and he must stand now, as if he had them, charged with the payment of the note. No account of the funds is necessary to be taken, for, he is to be charged with the amount due on the note, which can, apparently, be ascertained by mere computation.

Let there be a decree for the payment, by the defendant to the orator, of the amount due on the note, to be ascertained by reference to a master, if necessary, with costs, within twenty days after the filing of the decree, and for execution in case of any default in making such payment.

Man & Parsons, for the plaintiff.

Tracy, Olmstead & Tracy, for the defendant.

JOSEPH SELIGMAN AND OTHERS

vs.

LAWRENCE WELLS AND EDWARD MORGAN. IN EQUITY.

K., having no funds in the hands of B., drew three drafts on B., and negotiated them to the plaintiffs. Before they were accepted by B., K. delivered to M., the agent of B., funds towards meeting the drafts, which M. transmitted to B. B. then accepted two of the drafts, and paid them, but did not accept the third. The remainder of the funds was not enough to pay the third. The plaintiffs claimed the funds in the hands of B., while B. had them. Afterwards, K. was adjudged a bankrupt, and the defendants became his trustees in bankruptcy. B. delivered to them such remainder of the funds. The plaintiffs brought this suit to recover such sum: *Held*,

(1.) The money having been placed in the hands of B. expressly to provide for the drafts, and having been claimed by the plaintiffs, while it was in the hands of B., and before the bankruptcy proceedings, the plaintiffs were entitled to it;

(2.) The defendants acquired no greater right to the money than B. had to it.

(Before WHEELER, J., Southern District of New York, January 20th, 1880.)

WHEELER, J. Kaufman & Co., bankers at New York, drew three drafts, of 25,000 francs each, a few days apart, on the Basler Bank Verein, at Basle, Switzerland, where they had no funds, at sixty days each, payable to their own order, and negotiated them severally to the orators, who presented them for acceptance. After the first two had been so presented, and before the bank knew of the third, the bank, through its agents, Alfred Merian & Co., bankers at New York, called upon Kaufman & Co. to provide funds to meet the two drafts, whereupon they delivered to Merian & Co. 14,500 dollars, in gold, to meet the three drafts, which Merian & Co. received for that purpose and transmitted to the Basler Bank Verein. The bank then accepted the two drafts and paid them, which, with charges, amounted to $10,139 81, leaving $4,360 19 towards the other, but not suffi-

cient to pay it, and refused to accept or pay the other. Kaufman & Co. were adjudged bankrupts, and the orator, Joseph Seligman, and the defendants, became trustees of their estate in bankruptcy, and, on the demand of the defendants, the bank transmitted and delivered to them the sum of $4,360 19, gold, against the claim of the orators. This bill is brought to recover that sum.

That a check drawn against a fund does not, of itself, operate as an assignment of the fund or any part of it, so as to vest any right to it in the holder of the check, before acceptance, either at law or in equity, is well enough settled, both on principle and by authority. (*Bank of Republic* v. *Millard*, 10 *Wall.*, 152; *Rosenthal* v. *Mastin Bank*, *ante*, *p.* 318.) Here, the checks were not drawn against any funds in the hands of the drawees, but the money was placed in the hands of the drawees expressly to provide for the checks. They were not legally bound to receive the funds for that purpose, or to accept or pay the drafts, unless they chose to do so. (*Williams* v. *Everett*, 14 *East*, 582.) They did not, however, refuse to receive the funds for that purpose, as the defendants in *Williams* v. *Everett* did, but received them with full knowledge of the purpose, and without objection or protest. This sum was set apart and appropriated by the bankrupts, before bankruptcy, for the holder of the checks, and was in the hands of the Basler Bank Verein for that purpose, and was claimed by the holders of the check, while it was there for that purpose, and while they had the right to it, and before bankruptcy proceedings were commenced. This case is like *De Bernales* v. *Fuller*, (14 *East*, 590, *note a*,) where it was ruled at the trial, before Lord Ellenborough, C. J., that money paid in to the defendants, to take up a particular bill, could not be recovered by the holder, for want of privity; but, afterwards, a rule for a new trial was made absolute, after much discussion by the Court, because it appeared that the money was paid into the defendants' house for the specific purpose, declared at the time, of taking up that bill, which purpose was not directly repudiated till afterwards, and the

plaintiff finally recovered. (*De Bernales* v. *Fuller*, 2 *Camp.*, 426.) That case is not contrary to *Williams* v. *Everett*, or *Bank of Republic* v. *Millard*, or cases elsewhere, holding that drawing and delivering a check is no assignment of the fund. And, on principle, it would seem, that, when Kaufman & Co. directed the Basler Bank Verein to pay money to the orators, which would include a direction to the orators to receive it, and had been paid by the orators for the right to receive it, and then sent the money to be paid, and it was received for the purpose of making the payment, the orators would have a right to the money, on calling for it while it was there.

As the orators were entitled to the money in the hands of the bank, they have a right to follow it into the hands of the defendants, who, in receiving it, acquired no greater right than the bank had.

It is ordered that a decree be entered for the payment by the defendants to the orators, of the sum of 4,360 dollars and 19 cents, gold, received by the defendants from the Basler Bank Verein, with costs.

George W. Soren, for the plaintiffs.

Siegmund Spingarn, for the defendants.

FREDERICK W. MUSER AND OTHERS

vs.

ALEXANDER HOLLAND, TREASURER OF THE AMERICAN EXPRESS COMPANY.

M. delivered to an Express Company, for transportation, a trunk, with contents of the value of $4,172, taking a receipt exempting the company from loss by fire and from liability beyond $50, "at which sum said property is hereby valued, unless the just and true value thereof is stated herein." The value

of the trunk and contents was not stated in the receipt. Through the negligence of the employees of a railroad company employed by the Express Company to transport the property, it was destroyed by fire. In a suit by M. against the Express Company, for the value of the property: *Held*,

(1.) Common carriers cannot exonerate themselves from liability for the negligence of their own agents;

(2.) The Express Company is liable notwithstanding the stipulation against liability by fire;

(3.) The limitation of the liability to $50 is binding upon M., as a reasonable condition;

(4.) The Express Company is liable for $50, and for no more.

(Before WALLACE, J., Southern District of New York, January 24th, 1880.)

WALLACE, J. The plaintiffs delivered to the American Express Company, at Syracuse, N. Y., a trunk, with contents of the value of $4,172, for transportation to New York city, taking a receipt, which, among other stipulations, contained those reading as follows: "This company is not to be held liable for any loss or damage by fire, * * * nor, in any event, shall this company be held liable or responsible, nor shall any demand be made upon them, beyond the sum of fifty dollars, at which sum said property is hereby valued, unless the just and true value thereof is stated herein." The value of the trunk and contents was not stated in the receipt, and no evidence was given to show that the agents of the defendant knew the value of the property. Through the negligence of the employees of the New York Central and Hudson River Railroad Company, which corporation was employed by the defendant to transport the property in question, the car in which the Express Company shipped the property for transportation to New York city was thrown from the track, and a fire ensued, which destroyed the plaintiff's trunk and contents. The question now is, whether the defendant is relieved from responsibility by reason of the stipulation in the receipt, or, if not wholly absolved, whether it is liable for more than fifty dollars.

It will not be profitable to review the authorities which consider the right of common carriers to limit or modify their common law liabilities by notices or special contracts.

It is the settled law in the Federal Courts, that common carriers cannot relieve themselves from liability for negligence, either by notice or by special contract, though they may, by contract with the shipper, stipulate for such a reasonable modification of their common law liability as is not inconsistent with their essential duties to the public. They cannot, therefore, exonerate themselves from liability for the negligence of their own agents, but may from the acts or misconduct of persons over whom they have no authority or control, actual or legal. (*York Co.* v. *Central Railroad*, 3 *Wallace*, 107; *Railroad Co.* v. *Lockwood*, 17 *Wallace*, 357; *Bank of Kentucky* v. *Adams Express Co.*, 93 *U. S.*, 174.)

The plaintiffs' property was destroyed by the negligence of the railroad company, the agent of the defendant, and the defendant is, therefore, liable, notwithstanding the stipulation against liability for fire.

The precise question presented under the stipulation limiting the defendant's liability to fifty dollars, in the absence of a statement of the real value in the receipt, was decided in *Berry* v. *Dinsmore*, where, at *nisi prius*, I held such a stipulation valid. After a more careful consideration of the question than I was then able to give, I am confirmed in the conclusion then reached. The case of *Hopkins* v. *Westcott*, (6 *Blatchf. C. C. R.*, 64,) which was not then called to my attention, is a controlling authority in this Circuit, and decides that such a limitation is binding upon the shipper. To the same effect are *Belger* v. *Dinsmore*, (51 *N. Y.*, 166;) *Magnin* v. *Dinsmore*, (62 *N. Y.*, 35, and 70 *N. Y.*, 410;) and *Kirkland* v. *Dinsmore*, (62 *N. Y.*, 171.)

The right of a carrier to exact fair information as to the value of property confided to his care has always been recognized. He has the right to insist that his compensation be measured by his risk, and, obviously, the degree of care which he will exercise will measurably depend upon the extent of the responsibility he may incur. While it is not primarily the duty of the shipper to inform the carrier of the nature or value of the contents of the parcel sent, the carrier has the

right to make inquiry and receive a true answer; and any concealment on the part of the shipper, intended to mislead the carrier as to the character or value of the property, and which does mislead, is a fraud, which absolves the carrier from responsibility. (*Sewall* v. *Allen*, 6 *Wend.*, 335; *Phillips* v. *Earle*, 8 *Pick.*, 182; *Brooke* v. *Pickwick*, 4 *Bing.*, 218; *Riley* v. *Horne*, 5 *Bing.*, 217; *Sleat* v. *Fagg*, 5 *B. & Ald.*, 342; *Crouch* v. *L. & N. W. Railway*, 14 *C. B.*, 255.)

The question has generally arisen in cases where the carrier sought to protect himself under the terms of a general notice or regulation requiring the shipper to state the value or character of the property, and, when the notice or regulation was brought to the knowledge of the shipper, the carrier was protected by it. How much stronger is the case when, as here, the shipper enters into a contract, by which he agrees that the property shall be valued at fifty dollars, in the absence of specific statement of the real value. In *Express Co.* v. *Caldwell*, (21 *Wall.*, 264,) a clause in a contract relieving the carrier from liability for any loss or damage to a package whatever, unless claim should be made therefor within a limited time, was sustained, as a reasonable condition. The stipulation in the present case is plainly as reasonable as was that in *Express Co.* v. *Caldwell*. In effect, it exacts from the shipper only that fair information of the extent of the carrier's risk to which he is entitled.

Upon the argument, it was contended, that this stipulation could not shield the carrier from the consequences of his own misfeasance. Undoubtedly, a carrier may so conduct himself with property entrusted to him as to divest himself of the character of a carrier. In such case, his contract would not protect him. This is not such a case.

Judgment is rendered for the plaintiff, for $50, with interest from January 3d, 1879.

D. M. Porter, for the plaintiffs.

Hamilton Cole, for the defendant.

WILLIAM H. GEBHARD

vs.

THE CANADA SOUTHERN RAILWAY COMPANY.

Bonds were executed and issued in Canada, by a railway company, for the payment of money and interest thereon, secured by mortgage. By their terms, they were payable at the city of New York. Subsequently, an Act was passed by the Parliament of the Dominion of Canada, authorizing the company to issue new bonds, in substitution, bearing a lower rate of interest, and declaring that the assent of the holders of the old bonds should be deemed to have been given to the substitution. The plaintiff did not, in fact, assent, and sued the company to recover the interest on the old bonds held by him: *Held*, that he was entitled to judgment.

Such Act is repugnant to the fundamental principles of justice.

(Before WALLACE, J., Southern District of New York, January 24th, 1880.)

WALLACE, J. The plaintiff sues upon certain obligations executed and issued by the defendant, representing instalments of interest due and unpaid upon the defendant's issue of first mortgage bonds. The case, for convenience, may be considered as though the action were brought to recover several instalments of interest due on the 1st day of January, 1877, upon the first mortgage bonds of the defendant. These bonds were executed and issued in Canada, but, by their terms, were payable at the city of New York. The defendant is a Canadian corporation, and insists, in defence, that it is discharged from payment of these bonds by virtue of an Act of the Parliament of the Dominion of Canada, passed in April, 1878, whereby the defendant was authorized to issue new bonds payable in thirty years, in substitution of its first mortgage bonds, and bearing a lower rate of interest. This Act declares that the assent of the holders of the first mortgage bonds shall be deemed to have been given to the substitution of the new bonds. The plaintiff, in fact, never assented to

the substitution of the new bonds in the place of the first bonds.

On first impression, the defence seems an extraordinary one. It rests upon the theory, that, the original bonds, having been issued in Canada, are contracts controlled, as respects the obligation and its discharge, by the law of Canada, and that the Canadian Parliament, in the exercise of its unlimited powers, has discharged or modified the obligation of the contract, and that, even though this be an arbitrary or unjust act, it is conclusive upon the rights of the parties.

Several general propositions, applicable to the case, are elementary. The law of the place of the contract determines the nature, the obligation, and interpretation of the contract. But, when the contract is to be performed in a different place from that in which it is made, the law of the place of performance, in conformity to the presumed intention of the parties, determines the nature, obligation and interpretation of the contract. A defence or discharge, good by the law of the place of the contract, is good wherever the contract is sought to be enforced; but, when the place of performance is not the place where the contract was made, the defence or discharge is valid or invalid according to the law of the place of performance. The doctrine, that a defence or discharge good by the law of the place of the contract is good everywhere, is subject to several qualifications, one of which is, that a discharge or defence must not be of such character that it would conflict with the duty of the State where it is sought to be enforced, towards its own citizens, to recognize it. The laws of a State have no extra-territorial vigor, and are enforced by other States only upon considerations of comity, and these always yield to those higher considerations which demand of every State the protection of its own citizens against the unwarrantable acts of a foreign sovereignty. These familiar general propositions require no citation from the authorities to support them. Applying them here, the defence cannot succeed.

The plaintiff sues upon a contract which was made in Can-

ada, but was to be performed in the State of New York, the place of payment being the place of performance; and a discharge of the obligation, which derives its vitality solely from the authority of a foreign sovereignty, is of no more effect than would be the case if New York were the place where the contract was made. One of the most common instances, in illustration of the rule, is where the defence of usury is interposed, in an action brought here upon an obligation made in a foreign State, and bearing a higher rate of interest than is permitted by the laws of that State. When the obligation is payable here, the cases all agree, that the usury laws of the foreign State have no application.

Another class of cases, more analogous to the present, because they involve the effect of an *ex post facto* discharge of the obligation, is where a discharge in bankruptcy has been obtained under the laws of the State where the contract was made. Such a discharge is not a defence when the place of performance of the obligation is in a different State. The question has frequently been considered by the Supreme Court of the United States, and, although generally discussed in connection with constitutional questions, it has been ruled, with the concurrence of all the judges, that, irrespective of other considerations, the discharge is inoperative, when obtained in a different State from that where the debt was payable, because the contract and its obligation cannot be affected by the legislation of other States. (See opinions of Grier, Daniel, and Woodbury, JJ., in *Cook* v. *Moffat*, 5 *How.*, 295.)

The decision of the present case may properly rest upon this ground alone; but, if the obligations in suit were Canadian contracts, the defence would be untenable. The Act of the Canadian Parliament is an attempt to impair and destroy the obligation of a contract. Undoubtedly, it was supposed, in view of the financial embarrassments of the defendant, that the new obligations, authorized by the Act, would be acceptable to the holders of the original bonds, and would be of equal, if not of greater, value. But, the plaintiff was entitled to the money due by the terms of his bonds, and any legisla-

tive Act which attempts to deprive him of it, by compelling him to accept something different, violates fundamental principles of justice and is, in effect, an arbitrary confiscation of the plaintiff's property. Although, by the theory of the British Constitution, Parliament is omnipotent, the jurists and statesmen of England have denied its right to transcend the boundaries which confine the discretion of Parliament within the ancient landmarks. When it was proposed, by Act of Parliament, to impair vested property rights, by remodelling the charter of the East India Company, in 1783, the attempt was denounced by Lord Thurlow and Mr. Pitt, "as a total subversion of the law and constitution of the country;" and some of the greatest jurists and judges of England have declared that an Act of Parliament against common right and natural equity is void. (*Angell and Ames on Corporations*, § 767.) In our own country, we regard such Acts as so subversive of natural rights as not to be within the authority delegated to the legislative department of the Government. It is sometimes supposed, that, because the Constitution of the United States prohibits the States from passing such laws, and is silent as to the United States, the authority to pass them resides in Congress, by implication. This is an erroneous assumption. As is said by Nelson, J., in *The People* v. *Morris*, (13 *Wend.*, 328:) "It is now considered an universal and fundamental proposition, in every well regulated and properly administered Government, whether embodied in a constitutional form or not, that private property cannot be taken for strictly private purposes at all, nor for public without a just compensation; and that the obligation of contracts cannot be abrogated or essentially impaired. These and other vested rights of the citizen are held sacred and inviolable, even against the plenitude of power of the legislative department." The same views are expressed by the learned author of *Cooley's Constitutional Limitations*, (*p.* 176,) as follows: "However proper and prudent it may be expressly to prohibit those things which are not understood to be within the proper attributes of legisla-

tive power, such prohibition can never be regarded as essential, when the extent of the power apportioned to the legislative department is found, upon examination, not to be broad enough to cover the obnoxious authority. The absence of such prohibition cannot, by implication, confer power." A contract is property. To destroy it partially is to take it, and to do this by arbitrary legislative action is to do it without due process of law. (*Sinking Fund Cases*, 99 *U. S.*, 746, 747.)

If any of our own States had passed such an Act as the one under consideration, it would have been the duty of the Courts of that State to treat it as an unlawful exercise of power; and, certainly, it cannot be expected that this Court will tolerate legislation by a foreign State, which it would not sanction if passed here, and which, if allowed to operate, would seriously prejudice the rights of a citizen of this State. Comity can ask no recognition of such unjust foreign legislation; and the case falls under the qualification of the general rule, which prescribes, that, when the foreign law is repugnant to the fundamental principles of the *lex fori*, it will be ignored.

Judgment is ordered for the plaintiff.

John M. Bowers, for the plaintiff.

Joseph H. Choate, for the defendant.

LEOPOLD WERTHEIMER AND OTHERS

vs.

THE PENNSYLVANIA RAILROAD COMPANY.

The defendant, a railroad company, received from W. goods for transportation to Pittsburgh, giving W. a bill of lading containing a condition that the company should not be responsible for loss or damage by fire, unless it could be shown that such damage or loss occurred through the negligence or default of the agents of the company. On the arrival at Pittsburgh of the car containing the goods, a mob took possession of it, and continued to hold it against the military power of the State, and ultimately fired and destroyed the goods; *Held*, that W. must prove that the loss by fire arose from the negligence of the defendant or its agents, and that, in the absence of such proof, the defendant was not liable for the value of the goods.

(Before WALLACE, J., Southern District of New York, January 24th, 1880.)

WALLACE, J. On or about July 17th, 1877, the defendant received from the plaintiffs, at the city of New York, for transportation to Pittsburgh, Penn., goods of the value of $1,710. At the time of receiving the goods the defendant delivered to the plaintiffs a bill of lading, whereby it agreed to transport the goods, subject to several conditions, among which was one that the company should not be responsible for loss or damage by fire, unless it could be shown that such damage or loss occurred through the negligence or default of the agents of the company. On the 17th of July the car containing the goods was dispatched by the defendant from Jersey City for Pittsburgh, reaching Pittsburgh about one o'clock A. M., July 20th, at which time a mob took possession of the defendant's property, including the car in question, and held possession until July 22d, when troops, ordered by the Governor of the State to aid the sheriff in re-taking the property, came in conflict with the mob, failed to dispossess the mob, and the mob fired the property and thereby destroyed it.

The delivery of the bill of lading by the defendant, and its acceptance by the plaintiffs at the time of the delivery of the goods, must be deemed to constitute a contract between the parties, with the conditions contained in the bill of lading. (*York Co.* v. *Central Railroad Co.*, 3 *Wallace*, 107; *Bank of Kentucky* v. *Adams Express Co.*, 93 *U. S.*, 174; *Grace* v. *Adams*, 100 *Mass.*, 505; *McMillan* v. *Michigan Southern & N. I. R. R. Co.*, 16 *Michigan*, 79; *Hopkins* v. *Westcott*, 6 *Blatchf. C. C. R.*, 64; *Kirkland* v. *Dinsmore*, 62 *N. Y.*, 171.) These cases all hold, that the shipper who accepts the bill of lading cannot be heard to allege ignorance of its terms. It is unnecessary to refer to the cases where, from the peculiar circumstances attending the acceptance of the receipt, assent to its terms was held not to be implied, as the present case is the ordinary one, where no peculiar circumstances are shown. Neither are the cases in point which decide that assent on the part of the shipper will not be implied, to any conditions which do not appear on the face of the bill of lading. Such was the case in *Ayres* v. *The Western Railroad Corporation*, (14 *Blatchf. C. C. R.*, 9,) which was decided upon the authority of *Railroad Co.* v. *Manufacturing Co.*, (16 *Wall.*, 318.)

The effect of the contract made between the parties was to impose upon the plaintiffs the burden of proving that the loss of the goods by fire arose from the negligence of the defendant or its agents. In *Clark* v. *Barnwell*, (12 *How.*, 272,) Mr. Justice Nelson says, that, although the injury may have been occasioned by one of the excepted causes in the bill of lading, yet still the owners of the vessel are responsible if the injury "might have been avoided by the exercise of reasonable skill and attention on the part of the persons employed in the conveyance of the goods." But, the *onus probandi* then becomes shifted upon the shipper, to show the negligence. In *Transportation Co.* v. *Downer*, (11 *Wallace*, 129,) the judgment of the Court below was reversed, because the jury were instructed that it was incumbent upon the defendant, the carrier, to bring itself within the exception, by show-

ing that it had not been guilty of negligence. Other authorities to the same point need not be cited, as the cases referred to are conclusive upon this Court.

The plaintiffs have not shown negligence on the part of the defendant, and, therefore, cannot recover. But, irrespective of any considerations concerning the burden of proof, when it appeared, as it did here, that the fire by which the plaintiffs' goods were destroyed was the act of a mob, engaged in a struggle with the military authorities of the State, without anything to show that the defendants were bound, from the circumstances, to anticipate such a result, the defence was affirmatively established.

The motion for a new trial is denied.

Adolph L. Sanger, for the plaintiffs.

E. R. Robinson, for the defendant.

THE UNITED STATES

vs.

ANTONIO GIOVANNI AUCAROLA.

What it is to "inveigle," and what it is to "hold to involuntary service," under the Act of June 23d, 1874, (18 *U. S. Stat. at Large*, 251,) defined.

An arrangement made in Italy, which contemplated the delivery of a child to the defendant, to be by him brought to the United States for the purpose of being employed there as a beggar or a street musician, the child being enticed in Italy to consent to such arrangement, *held* to have been an inveigling of the child in Italy, under that statute.

An intention in the defendant, in bringing the child to the United States, to employ him as a beggar, or as a street musician, for his own profit, if such employment would be injurious to the morals of the child and inconsistent with its proper care and education, according to its condition, is an intention to hold the child to involuntary service, although the child consented in Italy to

the employment, and although it be not shown that the child subsequently dissented, while under the control of the defendant.

(Before BLATCHFORD, BENEDICT AND CHOATE, JJ., Southern District of New York, January 26th, 1880.)

BLATCHFORD, J. On the 23d of June, 1874, an Act was passed by Congress, (18 *U. S. Stat. at Large*, 251,) entitled, "An act to protect persons of foreign birth against forcible constraint or involuntary servitude." It provides, "that whoever shall knowingly and wilfully bring into the United States, or the territories thereof, any person inveigled or forcibly kidnapped in any other country, with intent to hold such person so inveigled or kidnapped in confinement, or to any involuntary service, and whoever shall knowingly and wilfully sell, or cause to be sold, into any condition of involuntary servitude, any other person, for any term whatever, and every person who shall knowingly and wilfully hold to involuntary service any person so sold and bought, shall be deemed guilty of a felony, and, on conviction thereof, be imprisoned for a term not exceeding five years, and pay a fine not exceeding five thousand dollars."

Under this statute, an indictment was found in this Court against the defendant, charging, first, that he unlawfully, feloniously, knowingly, and wilfully, brought into the United States, to wit, into the city and county of New York, in the State of New York, one Francesco Libonati, a person who had theretofore been inveigled in the kingdom of Italy, with intent to hold said Libonati in confinement, and to an involuntary service of begging and playing on musical instruments. A second count was like the first, substituting "forcibly kidnapped" for "inveigled." A third count was like the first, substituting "inveigled and forcibly kidnapped" for "inveigled." A fourth count charged that the defendant unlawfully, feloniously, knowingly, and wilfully, held to an involuntary service of begging and of playing on musical instruments, one Francesco Libonati, a person who had theretofore been unlawfully and knowingly sold by certain persons

to the jurors as yet unknown, into a condition of involuntary servitude, for a term of four years and six months, and had been theretofore, by the said Aucarola, bought for the service and servitude aforesaid, and for the term aforesaid, of the persons aforesaid. A fifth count was like the third count, except that it charged the intent of the defendant to be to hold Libonati to an involuntary service. Two other indictments, with the same charges, were found against the defendant, except that one of them related to a person named Michele Quirino, and the other to a person named Giosue Gurieri. The three indictments came on for trial before this Court, held by Judge Benedict, and a jury, and were consolidated by the Court, under the provision of section 1024 of the Revised Statutes, and one trial was had on them as so consolidated. The jury found the defendant "guilty of the several offences charged in the indictments." The defendant now moves, on the minutes of the trial, as settled by the judge who tried the case, for a new trial and in arrest of judgment, the motion being made at an exclusively criminal term, held under section 658 of the Revised Statutes, before the Circuit Judge and the two District Judges named in section 613 of the Revised Statutes.

The evidence given on the trial showed these facts: The defendant arrived in the city of New York, on the 2d of November, 1879, in a steamer from Europe, having with him seven boys, of whom the three persons named in the indictments were three. He came on shore with the seven boys. Mr. Jackson, Superintendent of the depot at Castle Garden, where he landed, had a conversation with him there immediately after he landed. Mr. Jackson testifies: "I asked this man if those children were with him, and he said they were. I then asked his name, and he told me Aucarola. I brought him up to the register desk, and he registered their names. I asked him where they were going, and he said to Montreal, to their relatives there. I brought them inside then, and he handed me their passage ticket to Montreal, as evidence that they were going there." The children were not allowed to

go with him. He was arrested on the 8th of November. At the trial no evidence was introduced by the defendant. The chief testimony for the Government was that of the three boys named in the indictment, Quirino being 13 years old, and Libonati and Gurieri being each 11 years old.

The story of Libonati was this: He was born at Calvello, Italy. His mother is living there. His father is dead. The boy was working in a blacksmith's shop, for 2½ cents a day, making nails. He had two sisters and a brother in Calvello, and a brother and a cousin in New York. His family were poor. He could not play upon any musical instruments. His father had gone to New York and had died there. The boy, being at his shop, was sent for by his mother, and went, and found with her her brother and the defendant. His mother asked him if he wanted to go to America, and he said "yes." His uncle said, "Go to America with this man," and the boy said "yes." The defendant said to the mother, "Will you give me your son," and she said "yes." He also said to her that the boy was to play the harp in Chicago. The boy said that he wanted to play the violin, but the defendant said that he must play the harp, and the boy then said that he would play the harp. The boy went with his uncle to Naples. Thence he went to Marseilles and London with another boy. At London he met the defendant and other boys, and they came from London to New York, in the steamer. On the way over the defendant said to the boy, "If we get arrested, say we are going to Montreal." The boy had no relatives in Montreal.

The story of Quirino was this: His mother is living. His father died in New York. The boy was born in Calvello, Italy, and lived there. He is a relative of the defendant. He has a sister. His family are poor. He did not work at anything, but went to school. The boy and his mother, his uncle and the defendant, being together at Calvello, it was verbally agreed between the mother and defendant, that the boy was to be four years and a half with the defendant, in Chicago, and that the defendant was to give the mother 40

ducats. The defendant said, "You live four and a half years with me, and I will teach you the business, and whatever money you make you will give to me." The mother said, "If you want to go, go; I don't want to compel you to the contrary." The uncle said the same. The defendant told the boy he would have to learn the violin, and that he would be clothed and fed. The boy said that he would go. His uncle took him from Calvello to Marseilles. There he met the defendant, who took him to London, and thence to New York in the steamer. On the way over, the defendant told the boy to tell every one he was going to see his uncle in Montreal. He did not have an uncle in Montreal.

The story of Gurieri was this: His father and mother are living in Calvello, Italy, where he was born. He has a brother and a sister. His mother proposed to the defendant to take the boy to America. The defendant had just returned from there. He said, in the presence of the boy, that America was a good place, and he talked of the "beautiful things of America." He said to the father and mother, "If you let your son go with me, he will do very well in America, and send you plenty of money by and by." He said several times, in the hearing of the boy, that America was a good place, and that they would make plenty of money there, and that they were going to make money for him. The boy was to work, and all the money he was to give to the defendant. The defendant was to take the boy to Chicago and teach him music, and from Chicago he would take him further. This was said in the presence of the parents. They told the defendant not to ill-treat the boy, and to feed him properly, and that, if they should get a letter from him saying that he was not properly treated, they would come and take him away. It was then agreed that the defendant should give the father 80 ducats, and that the boy should go with the defendant for four years, and be fed and clothed by him, and taught music. The boy went to Marseilles, and there the defendant found him. On the way to New York in the steamer, the defendant said to the boy, "Let us pray to God that we can pass through

New York all right. After that I will teach you music." He gave the boy a paper with an address in New York where to go, and told him not to let himself be seen by any officer, for they might arrest him, and if any one asked him what he was going to do, not to say that he was going with a padrone. He also told him, if any one asked him what his business was, to say that he was a printer, and, if they asked where he was going, to say that he was going to Montreal, and, if they asked to whom, to say that he was going to an uncle. He did not have an uncle in Montreal.

The statute of Italy, of December 21st, 1873, referred to in the charge of the Court to the jury, was put in evidence. Portions of the charge of the Court to the jury were excepted to by the defendant. One portion of the charge was as follows: "In connection with the evidence in respect to the arrangement made in Italy, it will be important for you to consider the law of Italy relating to the employment of children in wandering professions. But, it must be remembered that the accused is not on trial for violating the law of Italy, and cannot be found guilty by you because of any violation of the law of Italy that you may believe to have been disclosed by the evidence. He must be found guilty, if at all, for a violation of the law of the United States that you have heard read. The law of Italy has been admitted in evidence as bearing upon the question of inveiglement, and solely for the purpose of showing the character of the act to which the consent of these children was obtained in Italy. The law of Italy provides as follows: 'Section 1. Any person who shall intrust, or under whatever pretence shall commit, to natives or strangers, other persons of either sex under the age of eighteen years, though his or her own children or pupils, and any native or stranger who shall receive them with the intent to employ them in the kingdom, in whatever manner or under whatever denomination, in the practice of wandering professions, as saltinbanks, witches, charlatans, errant players or singers, rope dancers, guessers, fortune tellers, animal exposers, beggars and similar

wanderers, shall be punished with imprisonment from one to three months, and fined from fifty-one to two hundred and fifty lire.' 'Section 3. Any one who shall trust or deliver in the kingdom, or take abroad in order to trust or deliver to natives or strangers abroad, persons under eighteen years of age, however his or her own children or pupils, and any native or stranger who shall receive such persons in order to take, trust or deliver them abroad, for the purpose to employ them in whatever way, and under whatever denomination, in the practice of wandering professions, as shown in section one, shall be punished with imprisonment from six months to one year, and fined from one hundred to five hundred lire.' You will observe, that the arrangement to which the assent of these children was procured in Italy was unlawful, provided the children were intended to be employed in a wandering profession, such as errant players, or beggars, or similar wanderers. It has been contended here, that these children were not intended to be employed as wanderers, in violation of the law of Italy, because the evidence is, that they were to be employed to play the harp, or be musicians, in Chicago. But, gentlemen, a child of eleven or thirteen years of age may be a wanderer in the streets of a great city, and if, upon considering the evidence and what has been proved in regard to the character of the arrangement made in Italy, and the age of the children, and their ability to earn money for the accused by labor, you conclude that the arrangement made in Italy in regard to those children, or either of them, contemplated the delivery of the children to the accused, to be by him brought to this country for the purpose of being employed as beggars or street musicians in Chicago, and that the child was then and there enticed to consent to such an arrangement, then you will be justified in finding that such child had been inveigled in Italy." The foregoing portion of the charge was excepted to by the defendant.

After charging that it must be "proved that the accused brought the child here with the intent to hold the child, when so brought, to involuntary service as a beggar or as a

musician," the Court proceeded as follows: "Upon this question the age of the child is important, for, as you know, in regard to some things, a child of such tender years is incapable of consent. The nature of the employment to which the accused intended to put the child, the evidence in regard to the arrangement made in Italy, and the ability of the child to labor or play an instrument, are important circumstances in this connection, also, for, if you believe, from the evidence, that the intention of the accused, in bringing the child to this country, was to employ the child as a beggar, or as a street musician, for his own profit, and that such intended employment was one injurious to its morals, and inconsistent with its proper care and education, according to its condition, then you will be justified in finding that he intended to hold such child to involuntary service, as charged in the indictment, and this notwithstanding the fact that the child had consented to the employment in Italy, and that no evidence of a subsequent dissent, while under the control of the accused, has been given." The foregoing portion of the charge was excepted to by the defendant.

The defendant also contends that there was no evidence that any of the children had been inveigled in Italy, and no evidence that the defendant had the intent to hold any of the children to any involuntary service in this country.

"Inveigle" is defined by Worcester thus: "To persuade to something bad; to wheedle; to entice; to seduce; to beguile." He defines "entice" thus: "To allure to ill; to attract; to lure; to draw by blandishments or hopes; to decoy; to tempt; to seduce; to coax." To inveigle or persuade or entice necessarily implies that the person is persuaded or enticed and yields assent as the result of the persuading or enticing. Yet the statute is founded on the view that the person so assenting and so inveigled may be brought here by one who knows the circumstances of the case, with the intent to hold such person to involuntary service, although the service be the one to which the inveigling related. The arrangement made in Italy was, clearly, a transfer of the children to

the service of the defendant, to earn money for him as street musicians in Chicago. They were of an age to be able to do so. The influence brought to bear upon them by their parents and uncles, and by the statements of the defendant, to induce them to consent, in view of their condition in life and their ages and their inexperience, was enticement and inveiglement. The charge on this subject was proper and not open to exception. (*Moody* v. *The People*, 20 *Illinois*, 315, 319.)

In regard to the other portion of the charge, the children, in serving the defendant as street musicians, for his profit, to the injury of their morals, subject to his control, could not properly be considered as rendering him voluntary service. They were incapable of exercising will or choice affirmatively on the subject. They were cast off by their parents, in violation of the law of Italy, and their being in this country at all with the defendant was, on all the facts, really involuntary on their part, although the sham form of their consent was gone through with. The charge seems to us entirely correct. (*Moody* v. *The People*, 20 *Illinois*, 315, 319; *The State* v. *Rollins*, 8 *N. H.*, 550, 565.)

The observations already made, taken in connection with the testimony recited, show that there was ample evidence to warrant the jury in finding inveiglement in Italy and the intent of the defendant, with full knowledge of such inveiglement, to hold the children in this country to involuntary service to him as street musicians.

The motions are denied.

William P. Fiero, (*Assistant District Attorney*,) for the United States.

Charles S. Spencer, for the defendant.

ISAAC FAULKS AND OTHERS

vs.

JACOB C. KAMP AND CHARLES BROWN. IN EQUITY.

Whether letters patent No. 68,282, granted August 27th, 1867, to Charles Brown, for an improvement in baling short cut hay, are valid, is doubtful, short cut hay having been known before, and the invention consisting only in applying to short cut hay the well known process of baling hay.

The defendant, owning an interest in the patent, conveyed such interest to the plaintiff. Afterwards, the defendant continued to practise the invention, and he acquired a prior patent, which he alleged covered the same improvement. In a suit in equity against him by the plaintiff, for infringement: *Held*, that he was estopped, by his conveyance, from denying the validity of the patent, and that the acquiring by him of the prior patent enured to the benefit of the plaintiff.

(Before WHEELER, J., Southern District of New York, January 27th, 1880.)

WHEELER, J. This suit is brought for relief against infringement of letters patent No. 68,282, dated August 27th, 1867, and granted to the defendant Charles Brown, for an improvement in baling short cut hay. The orators claim to have the title to the whole of the patent for the New England States, New Jersey, and New York, except Erie county, and allege infringement at the city of New York. Their title is not disputed, except that the defendants allege that one Lemuel B. Clark owns a share in the patent, said to be one-twenty-fourth part; and they justify under a license granted by former owners to Angelina Brown, wife of Charles Brown. The share of Clark does not appear to cover the territory involved in this suit; and the license to Angelina Brown was revocable, and was revoked by the conveyance of the title of the licensors, so that the orators are considered as holding the title to the patent for this territory. Of course, the whole of their title must have been derived from the de-

fendant Brown, to whom the patent was granted. Faulks, orator, first acquired, by various mesne conveyances, the whole title for this territory. He conveyed shares to each of the defendants, and they, with him and a son of his, formed a co-partnership, which carried on the business of baling hay under the patent. Then they sold their interest in the partnership business and property, including the patent, to him, and, in their conveyances of the patent, each described the thing conveyed as the full and entire right, title, and interest which he had and possessed in and to the patent, and the inventions and improvements described in and secured by it. He conveyed an interest to each of the other orators. The defendants now deny the validity of the patent, because, they say, Brown was not the original and first inventor of the improvement described in it; and they have acquired a prior patent, which, they say, covers the same improvement, under which they claim the right to practise the invention; and they deny all infringement of the patent.

There is considerable doubt whether the patent, as between the owners and the public generally, is of any validity. Hay has long been baled, to the common knowledge of all. The whole invention in controversy consists in baling hay cut short, in the same manner. The well known process of baling hay was applied to another kind of hay. The short cut hay was well known before, and the process made no change in its properties or quality. When baled, it could be more conveniently handled, as common hay could be. (*Langdon* v. *DeGroot*, 1 *Paine*, 203; *Alcott* v. *Young*, 16 *Blatchf. C. C. R.*, 134.)

But, it is argued for the orators, that they are entitled to have the patent treated as valid as against the defendants, whether it is valid generally or not; and this claim seems worthy of consideration. Every seller of personal property impliedly warrants that he has title to, and right to sell, what he assumes to sell. His undertaking to sell includes an undertaking to that effect. (2 *Black. Comm.*, 451; *Long on Sales*, *Rand's ed.*, 203; *Defreeze* v. *Trumper*, 1 *Johns.*, 274;

Coolidge v. *Brigham*, 1 *Met.*, 547.) In *Heermance* v. *Vernoy*, (6 *Johns.*, 5,) it was held, that a sale of a millstone of a bark-mill to a tannery, as personal property, which might belong to the realty and not pass by such a sale, implied a warranty of title to it as personalty; and, in *Hannum* v. *Richardson*, (48 *Vt.*, 508,) that a sale of a negotiable note, although endorsed without recourse, involved a warranty that it was a genuine note, due the seller. It is urged strenuously, in behalf of the defendants, that these principles do not apply to sales of patent rights, on account of their incorporeal nature and the interests of the public. In *Medina* v. *Stoughton*, (1 *Salk.*, 210,) Lord Holt is reported to have said that such a warranty was implied upon a sale by one in possession, and not by one not having possession; but this saying is doubted, and the distinction denied, by Mr. Justice Buller, in *Pasley* v. *Freeman*, (3 *T. R.*, 51.) But, if possession should be material, the defendants appear to have claimed and had the exclusive right to this invention, and to have sold and conveyed all the right possessed by them. The nature of the right covered by letters patent does not seem to be such that a warranty of the right cannot be implied. The patent purports to grant the right to exclude all others from practising the invention. It adds nothing to the right of the owner to practise it. This exclusive right is property, recognized and protected by law. (*Cammeyer* v. *Newton*, 94 *U. S.*, 225.) Whoever assumes to sell a patent assumes to sell that property, and assumes that he has it to sell. This suit is between these parties, and involves their rights alone, and not the rights of the public. The determination of the validity of the patent in this suit will only determine its validity between them, and not affect its validity as to others not parties. The defendants, in possession and enjoyment of that exclusive right, assumed to sell and transfer it. After that, in justice, they ought not to be heard to say that they had it not, and did not sell it, and to be allowed to derogate from their own grant by setting up that it did not pass. They may have deprived themselves of the right to practise it within the territory, when otherwise

they would have retained the right in common with all others; but, if they did, that would not so affect the public as to avoid their obligation. They could exclude themselves in that way by contract, independently of the patent, and the contract would be upheld, if it went no further than upholding this patent as against them, in the territory in question, would take them. It would be upon good consideration, reasonable, and only in partial restraint of trade. (*Pierce* v. *Woodward*, 6 *Pick.*, 206; *Chitty on Cont.*, 576.) The question as to the right of a vendor of a patent to deny its validity afterwards came up in *Chambers* v. *Crichley*, (33 *Beavan*, 374.) That case was similar to this in important features. The parties had been partners in the manufacture of stoves, under a patent which they owned. The defendant sold his share in the partnership assets, including the patent, to the plaintiffs, but afterwards continued the manufacture, and the suit was brought for that infringement. Upon that case, Sir John Romilly, Master of the Rolls, in delivering judgment, said: "I do not intend to express my opinion as to the validity of Wright's patent. I will assume, for the purpose of my judgment, that it is worth nothing at all. But this is certain, that the defendant sold and assigned that patent to the plaintiffs as a valid one, and, having done so, he cannot derogate from his own grant. It does not lie in his mouth to say that the patent is not good." And an injunction and an account were decreed. It is argued, for the defendants, that, as the conveyances were of the right, title and interest of the grantors, the warranty would only extend to whatever right they might have, which passed, and that the warranty was kept. But, the conveyances were made to carry out the sale, in the manner required by law for passing the title, and the warranty grew out of the sale, and not out of the form of the conveyance.

The patent subsequently purchased by the defendants may be better than this for covering this invention, but, if it is, it cannot help the defendants, as against the orators. It is familiar law, and has been for a long time, that a warranty of

title or right draws to it any after acquired right or title of the warrantor, and carries it to the benefit of the person to whom the warranty runs. So, whatever right, if any, the defendants acquired to the invention covered by this patent, enured directly to the benefit of the orators.

It is also urged, that the purchaser knew of the defects, and was not deceived, and that, therefore, the defendants are not estopped. But, the rights of the orators do not rest upon the estoppel merely; they rest upon the purchase, which must operate so that the orators may have what they bought, and so that the defendants shall not both sell and keep the same thing.

The evidence of the acts, conduct and claims of the defendants leaves no room for any fair doubt but that they infringe, by doing what they claimed and exercised as their exclusive right, when they had the patent, and by practising the invention which the patent purports to cover.

Let a decree be entered for an injunction and an account, according to the prayer of the bill, with costs.

Charles N. Judson, for the plaintiffs.

J. C. Clayton, for the defendants.

RAFAEL DE FLOREZ AND ERNEST P. BERNARD

vs.

CHARLES T. RAYNOLDS AND OTHERS. IN EQUITY.

Re-issued letters patent were granted to Moritz Pinner, as assignee of Jean Bouvet, as inventor, November 1st, 1864, for 17 years from June 28th, 1864, for an improvement in metal cans for preserving food, the original patent having been granted to Pinner, June 28th, 1864, for 17 years from that day.

In June, 1878, in this suit, brought for the infringement of said re-issue, an interlocutory decree was made, for an account of profits and a perpetual injunction. Afterwards, the defendants moved for leave to introduce in evidence, for the first time, a prior patent, granted in France, to Bouvet, for the same invention, and to amend the answer for that purpose, with a view to limit the duration of the plaintiffs' patent to the term of 17 years from the date of the French patent. The French patent consisted of (1) a patent, "taken" November 30th, 1861, for 15 years; (2) a certificate of addition, "taken" December 21st, 1861; (3) another certificate of addition, "taken" November 27th, 1862. Under the French law, the 2 certificates of addition expired with the original French patent, namely, at the end of 15 years from November 30th, 1861, and the 2 certificates of addition had effect, as patents, respectively, from December 21st, 1861, and November 27th, 1862. The 2d certificate of addition, in connection with the original and the 1st certificate, patented the same invention covered by said re-issue: *Held*, that said re-issue was valid, for the purposes of said injunction, only for 17 years from November 27th, 1862, and that said motion ought to be granted.

The French patent law of July 8th, 1844, examined and explained.

The defendants held not to have been guilty of laches in not sooner making the motion, but the case not to be regarded as a precedent for the case of an application to set up a defence to defeat a patent for want of novelty.

The successive statutes of the United States as to the duration of patents, examined.

The effect of § 16 of the Act of March 2d, 1861, (12 *U. S. Stat. at Large*, 246,) providing that all patents thereafter granted should remain in force for the term of 17 years from the date of issue, and prohibiting all extension of such patents, was, to limit the duration of a United States' patent for an invention previously patented abroad to the same inventor, to the term of 17 years from the date when the foreign patent had effect, as a patent, in his favor.

(Before BLATCHFORD and WHEELER, JJ., Southern District of New York, February 2d, 1880.)

BLATCHFORD, J. The original letters patent, in this case, were granted to Moritz Pinner, as assignee of Jean Bouvet, of La Rochelle, France, on the invention of Bouvet, and on his application, as a subject of the Empire of France, for an "improvement in metal cans, cases, boxes, &c., for preserving food, gunpowder, liquors, fruits, oils and other articles." The date of the patent was June 28th, 1864, and, on its face, it was granted for the term of 17 years from the 28th day of June, 1864. The patent was re-issued to Pinner, November 1st, 1864, the re-issue being granted, on its face, for the term of 17 years from the 28th day of June, 1864. This suit is

founded on the re-issued letters patent. It was brought to a hearing on bill, answer, replication and proofs, and, on the 29th of June, 1878, a decree was made by the Court, (14 *Blatchf. C. C. R.*, 505,) establishing the validity of the re-issue and the fact of infringement by the defendants, and referring it to a master to take an account of the profits made by the defendants by the infringement, and awarding a perpetual injunction against the defendants from making, using or selling cans or boxes containing the patented invention.

There was introduced in evidence, by the defendants, a patent, granted in England to Bouvet, for the same inventions that are claimed in the re-issued United States' patent. This English patent was sealed January 6th, 1863, and dated September 19th, 1862. Bouvet filed, on the latter day, a provisional specification with the English Commissioners of Patents, and, on the 19th of March, 1863, he filed a full specification in the Great Seal Patent Office in England. The French patent to Bouvet, hereinafter referred to, was not introduced in evidence in the cause by either party. It covers the same inventions which are claimed in the re-issued United States' patent. It is now presented to the Court, and on it and on all the pleadings, proofs, and papers in the case, and sundry new affidavits, a motion is now made by the defendants, before the Court held by the Circuit Judge and Judge Wheeler, that the said decree be amended by inserting therein a finding that the plaintiff's re-issued patent is valid only for the term of 17 years from the date or publication of the prior patent, for the same invention, in France and England; that the defendants be permitted to amend their answer by setting up said prior French patent; that the decree and the proofs be opened in order to prove the same in the cause; and that the injunction herein be suspended pending said proof, or discharged; and for such other or further order or relief as may be just.

The answer to the bill sets up, that, by the act of, or by and with the consent of, Bouvet, the improvements described in the United States' re-issued patent were "patented in Great

Britain with date of September 19th, 1862, the British patent thereon having been sealed on the 6th day of January, 1863," and that the said re-issued patent expired by limitation or operation of law on or before January 6th, 1875.

We have been furnished with a copy of the French patent, in the French language, in manuscript, duly authenticated by the proper authority in Paris, and with what purports to be a translation of it. The French law concerning patents, which was in force when the transactions took place in France in respect to said French patent, was that promulgated July 8th, 1844. Under that law patents are granted for 5, 10 or 15 years, according to the tax paid. Whoever wishes to take out a patent for an invention must deposit, under seal, at the office of the Secretary of the Prefecture, in a specified department, a petition, with a description of the invention, and necessary designs or patterns and a list of the pieces deposited. The patent begins to run from the time of such deposit. Within five days after such deposit the Prefect transmits all the pieces deposited to the Minister of Agriculture and Commerce. There they are opened and the petition is enrolled. If the application is regular, a decree of the Minister is delivered to the applicant and constitutes the patent. To such decree a duplicate of the description and designs is annexed. The patentee, during the duration of the patent, has a right to make additions, under the same regulations as to deposit of a petition, &c. A certificate of addition is delivered in the same form as the original patent, and has, from the dates of the demand and grant respectively, the same effect as the principal patent with which it expires. If a patentee wishes to take out a patent for 5, 10 or 15 years, for an addition, instead of a certificate of addition expiring with the original patent, he must, besides the same formalities, pay a new tax, as on an original patent. In the French patent under consideration, there is, first, a patent granted to Bouvet for 15 years, and dated November 30th, 1861, with a description and a drawing annexed, referred to in the description. The text shows that the patent was "taken" November 30th,

1861. The decree or grant appears to have been made by the Minister January 25th, 1832. Next, there is a certificate of an addition by Bouvet, of the date of December 21st, 1861, to the patent of November 30th, 1861, with a description and a drawing annexed. The text shows that the certificate of addition was "taken" December 21st, 1861. The certificate appears to have been made by the Minister February 27th, 1862. Next, there is a certificate of an addition by Bouvet, of the date of November 27th, 1862, to the patent of November 30th, 1861, with a description and a drawing annexed, referred to in the description. The text shows that the certificate of addition was "taken" November 27th, 1862. The certificate appears to have been made by the Minister February 20th, 1863. It is apparent, from these papers, that the two certificates of addition expired at the same time the original patent expired, namely, at the end of 15 years from November 30th, 1861; that the first certificate of addition had effect as a patent from December 21st, 1861: and that the second certificate of addition had effect as a patent from November 27th, 1862.

On the motion to amend the decree, it is insisted, by the defendants, that the plaintiffs' patent is valid only for 17 years from March 19th, 1863, (the date of the filing of the full specification of the English patent,) or only for 17 years from November 27th, 1862, (the date of the deposit of the description and drawing annexed to the second certificate of addition in the French patent,) or only for 17 years from February 20th, 1863, (the date of the making of the certificate by the Minister.) On this view, it becomes unnecessary to consider, in respect to the English patent, any date earlier than March 19th, 1863, or, in respect to the French patent, any date earlier than November 27th, 1862, so far as the motion to amend the decree is concerned, or so far as the motion to amend the answer is concerned, or so far as the motion to open the decree and the proofs is concerned, or so far as the motion to discharge the injunction is concerned. The defendants do not contend, on any such motion, that the plaintiffs' patent is

valid only for 17 years from a date earlier than March 19th, 1863, in view of the English patent, or only for 17 years from a date earlier than November 27th, 1862, in view of the French patent and certificates of addition. No motion is now made to limit or define the time of the expiration of the United States' patent, in reference to the time down to which the accounting must extend, and we do not consider the question whether, for the purposes of such accounting, the United States' patent may not expire at a date earlier than 17 years from November 27th, 1862, namely, at a date 17 years from a date earlier than November 27th, 1862, in view of either the English patent or the French patent or certificates of addition. Nor is it, under these views, necessary to consider the English patent at all. It is plain that the second certificate of addition to the French patent, taken in connection with the original French patent and the first certificate of addition, show fully and patent the same inventions patented by the United States' re-issued patent. Whether such inventions are fully shown and patented by the English provisional specification, or by the French original patent alone, or by the latter in connection with the first certificate of addition, we do not now consider or decide, for any purpose.

We determine, on inspection, and in the absence of any affidavit to the contrary on the part of the plaintiffs, that the inventions patented by the French patent and the two certificates of addition to it, all three taken together, are the same as those patented by the United States' re-issued patent, to an extent sufficient to warrant the granting of the motion to amend the decree, and to amend the answer, and to open the decree and the proofs, and to discharge the injunction. The French patent and certificates of addition are not now admitted, as a patent to a third party, to defeat the plaintiffs' patent on the question of novelty, but only on the question of the extent of duration of the patent. The patent can have no life beyond the time limited by statute. The question of such life, in view of the French patent and certificates of addition, has not been before presented and passed

upon. It can now be presented and passed upon, on a motion to vacate or limit the duration of the injunction, or on a motion by the plaintiffs for an attachment for violating the injunction. The words "perpetual injunction," in the decree, mean only for the life of the patent. That must be determined by the statute and all the facts of the case, and not merely by the terms of the grant in the patent; and an interlocutory decree is always open to amendment and correction. In this view, it seems proper, that the answer should be amended, to set up the French patent and certificates of addition, and that the decree should be amended, by fixing a date beyond which, for the purposes of the injunction, the patent cannot have life, and by allowing the French patent and certificates of addition to be put in evidence in the proofs, with such relevant proofs respecting the same and their contents as either party may wish to offer. We think, that, in view of the subject-matter of the application, the defendants have not been guilty of laches, that the application does not come too late, and that the reasons assigned in excuse for not making an earlier application are sufficient. But, this case is no precedent for the case of an application to set up a defence to defeat a patent for want of novelty.

The plaintiffs' patent runs, on its face, for 17 years from June 28th, 1864. The question is as to when it expires. The plaintiffs contend, that, under the statute, it runs according to its tenor, and does not expire until the end of 17 years from June 28th, 1864. It becomes necessary, therefore, to examine the statutes on the subject.

By the Act of April 10th, 1790, (1 *U. S. Stat. at Large*, 109,) a patent was to be granted to the inventor "for any term not exceeding fourteen years." By the Act of February 21st, 1793, (1 *Id.*, 318,) it was required that the invention should have been "not known or used before the application," and the patent was to be granted "for a term not exceeding fourteen years," and only to a citizen of the United States, as inventor, or his assigns. By the Act of April 17th, 1800, (2 *Id.*, 37,) the privilege was extended to alien inventors,

who, at the time of petitioning, had resided for two years within the United States, and it was required that the invention should not have been known or used before the application. By the Act of July 13th, 1832, (4 *Id.*, 577,) the privilege was extended to every alien who, at the time of petitioning, should be resident in the United States, and should have declared his intention, according to law, to become a citizen thereof. These prior Acts were all of them repealed by § 21 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 125.) By that Act, (§ 5,) patents were to be granted "for a term not exceeding fourteen years." Any inventor could obtain a patent, whether an alien or a citizen. It was required that the invention should not, at the time of his application for a patent, be in public use or on sale, with his consent or allowance, as the inventor. The Commissioner could not grant the patent if it appeared to him, (§ 7,) that the invention "had been invented or discovered by any other person in this country, prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance, prior to the application." It was further provided, as follows, (§ 8:) "Nothing in this Act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. And, whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not, however, exceeding six months prior to the actual issuing of the patent." The effect of this legislation was to allow an inventor to take out a patent in a foreign country, for his invention, and, subsequently, to obtain a patent for it here, provided he filed his specification and drawings on his application here, within six months after the taking out of his foreign patent. By

§ 6 of the Act of March 3d, 1839, (5 *U. S. Stat. at Large*, 354,) it was provided as follows: "No person shall be debarred from receiving a patent for any invention or discovery, as provided in the Act approved on the fourth day of July, one thousand eight hundred and thirty-six, to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application: *Provided*, That the same shall not have been introduced into public and common use, in the United States, prior to the application for such patent: *And provided, also*, That in all such cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters patent." The effect of this provision was to allow an inventor to take out a patent here for an invention which he had previously patented in a foreign country, no matter how long previously, but the duration of the patent granted here was limited to the term of 14 years from the date or publication of such foreign patent. Then came the Act of March 2d, 1861, (12 *U. S. Stat. at Large*, 246,) the 16th section of which provided as follows: "All patents hereafter granted shall remain in force for the term of seventeen years from the date of issue; and all extension of such patents is hereby prohibited." Section 17 of the same Act, repealed all Acts and parts of Acts, theretofore passed, which were inconsistent with the provisions of that Act. Under this state of legislation, the original patent and the re-issued patent in this case were granted.

The view urged by the plaintiffs is, that, by § 16 of the Act of 1861, all patents thereafter granted were to remain in force for 17 years from the date of issue; that the provision of § 6 of the Act of 1839 was inconsistent with this new provision, and was, therefore, repealed; and that, consequently, the plaintiffs' patent does not expire until June 28th, 1881.

By § 22 of the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 201,) now § 4,884 of the Revised Statutes, every patent is to be granted for the term of 17 years. It cannot

be antedated. By section 25 of the same Act, now § 4,887 of the Revised Statutes, it is provided as follows: "No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented, or caused to be patented, in a foreign country; *provided* the same shall not have been introduced into public use in the United States for more than two years prior to the application, and that the patent shall expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years." These provisions of the Act of 1870 apply only to patents granted after that Act was passed, and do not apply to this case. Moreover, § 111 of that Act, in repealing the Acts of 1836, 1837, 1839 and 1861, provides, that such repeal shall not affect, impair or take away any right existing under any of said laws.

It is quite apparent, that the idea running through § 16 of the Act of 1861 is, that no patents thereafter granted should be extended, but, that, instead thereof, their original terms of duration should be seventeen years, instead of fourteen years with a privilege of extension for seven years more, which had been the prior law. The language is, that "all patents hereafter granted shall remain in force for the term of seventeen years from the date of issue;" not that they shall, by their terms and on their face, be granted for seventeen years from a date, but that they shall "remain in force" for the term specified. It was not improper, under this provision, to grant them for seventeen years from a date, as came to be the practice. But, the text is, that, whatever be the term on their face, they shall remain in force for the term of seventeen years from the date of issue. What is "the date of issue?" Under § 8 of the Act of 1836, in force when the Act of 1861 was passed, and when the patents in this case were issued, the patent could "take date" from a date earlier, though not exceeding six months earlier, than "the actual issuing of the patent." The actual date of issuing was one

thing, one date. The date from which the patent took date, or its term began to run, was another thing, another date. The latter date may very properly be called "the date of issue." Such latter date need not necessarily be a date expressed on the face of the patent. Under § 6 of the Act of 1839, such latter date is "the date or publication" of the foreign patent. Looking at the state of legislation before 1861, and at the evident scope of § 16 of the Act of 1861, as aimed at extensions of patents, it would be reasonable to say, that "the date or publication" of the foreign patent, spoken of in § 6 of the Act of 1839, might be regarded, in reference to patents issued under such § 6, as the one in this case was, as "the date of issue" intended by § 16 of the Act of 1861—the date from which, under such circumstances, the United States' patent is to take its departure—and that as, before, in practice, United States' patents were granted for fourteen years, and patents for inventions previously patented abroad to the same inventor were before limited to fourteen years from "the date or publication" of the foreign patent, so, now, under the new system introduced by the Act of 1861, such a patent, still to be granted otherwise in accordance with the provisions of the Acts of 1836 and 1839, was to remain in force for seventeen years from "the date or publication" of the foreign patent, while other United States' patents were to remain in force for seventeen years, instead of fourteen years, from their "date of issue," the privilege of having them "take date" from a date not exceeding six months prior to the actual issue, as the "date of issue," under § 8 of the Act of 1836, being still preserved, and such patents expiring seventeen years from such "date of issue" and not seventeen years from the actual issuing. There is nothing in these views that is inconsistent with, or does violence to, the language of § 16 of the Act of 1861, and they are in harmony with the course of legislation. Contrary views would determine that there was, by § 16 of the Act of 1861, a sudden, unexpressed and only implied change of the policy of § 6 of the Act of 1839, then in force for twenty-two years, such policy making

the terms of patents like those in the present case take date from the date or publication of the foreign patent, and run from that time for the same time other United States' patents run from their time of beginning to run; and such contrary views would establish an enlargement of term by the Act of 1861, in favor of an invention previously patented abroad, such enlargement remaining in force till 1870, and then curtailed, in 1870, so as to be more narrow than under the Act of 1839, and to make the United States' patent expire at the same time with the foreign patent having the shortest term.

No argument can be drawn in favor of the plaintiffs' view, from the fact, that, in § 16 of the Act of 1861, the expression is, "*all* patents hereafter granted." Literally, such expression covers future patents granted as re-issues. By § 13 of the Act of 1836, (5 *U. S. Stat. at Large*, 122,) which continued in force after the Act of 1861 went into force, a re-issue is authorized, and the re-issued patent is there called "a new patent," and is authorized to be issued only "for the residue of the period then unexpired for which the original patent was granted." Yet, it never was or could be supposed that, under § 16 of the Act of 1861, a re-issued patent was to be granted for seventeen years from the date of the actual issuing of such re issued patent, or for any other term than the residue of the seventeen years granted by the original patent. The expression "date of issue," as before defined, controls re-issues under said § 16, and the re-issue of an original seventeen years' patent is to run for seventeen years from the date when the original term of seventeen years began to run, which date is to be considered "the date of issue," under § 16, for the purposes of a re-issue. So, again, "all patents," literally, includes design patents, granted under § 11 of the Act of 1861. Yet, it never was or could be supposed that § 16, though later in place in the Act than § 11, varied the terms defined in § 11 for the duration of design patents, namely, three and one-half years, seven years, or fourteen years; or, that the provision in said § 16, as to extension, ap-

plied to "all patents," when § 11 had authorized the extension of design patents, for seven years.

We are not referred to any judicial decision where the question now considered was directly involved, which holds to the contrary of the construction we thus give to § 16 of the Act of 1861.

In *Weston* v. *White*, (13 *Blatchf. C. C. R.*, 364,) the United States' patent was granted August 6th, 1867. A prior English patent for the same invention had been granted to the patentee, and had been published October 22d, 1859. The question arose, in May, 1876, whether the United States' patent had expired October 22d, 1873, at the expiration of 14 years from October 22d, 1859, or whether, under § 16 of the Act of 1861, it remained in force in May, 1876. If it should expire October 22d, 1876, (being 17 years from October 22d, 1859,) or, if it should remain in force till August 6th, 1884, (being 17 years from August 6th, 1867,) it remained equally in force, in either case, in May, 1876. It was necessary, in May, 1876, only for the Court to decide that the patent had not, under § 6 of the Act of 1839, run out in 14 years from October 22d, 1859, and the question, whether it would run out October 22d, 1876, or not till August 6th, 1884, was not directly involved, nor does it seem to have been argued or considered, except as may be inferred from the fact, that the Court says that the patent would not expire until October 22d, 1876, and further says, that the effect of the 16th and 17th sections of the Act of 1861 was, that patents issued after the passage of the Act of 1861, and falling within the proviso of § 6 of the Act of 1839, would run for 17 years from the date or publication of the foreign patent. The case was one in the Circuit Court of the United States for the District of Connecticut, before Judge Shipman.

In *Badische Anilin and Soda Fabrik* v. *Hamilton Mfg. Co.*, (13 *Off. Gaz. of Pat. Off.*, 273,) before Judge Shepley, in February, 1878, in the Circuit Court of the United States for the District of Massachusetts, the decision was, that § 25 of the Act of July, 1870, now § 4,887 of the Revised Statutes,

did not apply to a re-issue granted by the United States, in April, 1871, of a patent originally granted by the United States in October, 1869, and that, therefore, the re-issue did not expire in December, 1871, when the prior foreign patent, taken in June, 1869, expired. Nothing was said as to whether it would expire in June, 1883, or in June, 1886, or in October, 1886, or in April, 1888.

In *Goff* v. *Stafford*, (14 *Off. Gaz. of Pat. Off.*, 748,) before Mr. Justice Clifford and Judge Knowles, in October, 1878, in the Circuit Court of the United States for the District of Rhode Island, the United States' patent was granted October 3d, 1865, for 17 years from that day. An English patent had been previously granted to the same patentee for the same invention. The English patent was dated June 13th, 1863, and was for 14 years, it was sealed December 8th, 1863, and the complete specification was filed December 12th, 1863. The question arose as to whether the United States' patent had expired. It had expired December 12th, 1877, if it remained in force for only 14 years from December 12th, 1863. If it remained in force for 17 years from December 12th, 1863, or for 17 years from October 3d, 1865, it was equally in force in October, 1878, for the purposes of the injunction which the Court granted. The only question raised, in pleading or argument, seems to have been, as to whether the patent had expired. When, in the future, it would expire was not directly involved. The contention of the defendant in the case seems to have been, that, because of the Act of 1870, the United States' patent had expired when the foreign patent expired, namely, June 13th, 1877. The Court held, that the Act of 1870 did not apply to the case, because the patent was granted before that Act was passed. But, Mr. Justice Clifford, in the decision, went on to say, that the patent would remain in force for 17 years "from the time it was granted," because it was granted under the Act of 1861. He seems to have meant, for 17 years from October 3d, 1865. We cannot regard the case, in that respect, as a decision on a point necessarily involved. With the highest regard for all the judicial

views of so eminent a Judge as Mr. Justice Clifford, particularly as to questions arising under the law of patents, our examination of the question directly involved in the present case has led us to different views, and to the belief that such question was not argued before, or fully considered by, the Court in Rhode Island, because not directly involved in the case.

The views announced in this decision, which are concurred in by both of the Judges, lead to the conclusion, that the motion of the defendants must be granted, so far as to direct that the decree be amended by inserting a finding that the plaintiffs' re-issued patent is valid, for the purposes of the injunction granted, only for the term of 17 years from November 27th, 1862, without holding whether, for the purposes of the accounting ordered, it is valid for as long a term as that, and that the defendants be permitted to amend their answer, by setting up said French patent and the two certificates of addition; and that said decree and the proofs be opened, in order to allow them to introduce the same in evidence, and to allow either party to introduce any relevant testimony in respect to the same and their contents; and that the provision for the injunction, and the injunction, be now vacated and discharged.

We fix the date of November 27th, 1862, and not the date of February 20th, 1863, because we regard it as the clear intention of the provisions of law limiting the duration of a United States' patent patenting an invention previously patented abroad to the same inventor, to give to the patentee a specified term from the date at which his foreign patent had effect as a foreign patent in his favor. In this case, such date was November 27th, 1862, and not February 20th, 1863. This view is not necessarily applicable to a case where a foreign patent to one inventor is set up to defeat a United States' patent to a different inventor. In such case, the manifest intention of the law is, that the foreign patent shall apply only as of a date when the invention was published, or was accessible to the public, and not as of an earlier date, from which the in-

ventor may have enjoyed the benefit of the foreign patent, as a patent. The language of § 16 of the Act of 1861, in saying that the 17 years is to run from "the date of issue," is a marked departure from the expression, "date or publication" of the foreign patent, in § 6 of the Act of 1839, and, in reading the two sections together, full effect must be given to the new expression.

W. K. Hall and *J. J. Marrin*, for the plaintiffs.

E. Wetmore, for the defendants.

THE UNITED STATES

vs.

MORITZ MILLINGER AND OTHERS.

A judgment entered in 1872, on an assessment of damages, on a default, was opened in 1880, to allow evidence to be given of payments made by one of the defendants, or out of his property, which should have been allowed, and deducted from the assessment, when the judgment was entered.

(Before SHIPMAN, J., Southern District of New York, February 2d, 1880.)

SHIPMAN, J. The default in this case was taken in the year 1872, and judgment was thereupon rendered against the defendants. The only tenable reason for opening the judgment is, that, in the assessment of damages, credits were omitted from the amount of the plaintiffs' original claim, presumably by inadvertence and mistake. The Court has power to open a judgment rendered upon default, for the purpose of correcting errors of fact in the amount of the judgment, arising from the inadvertent omission of the plaintiff to give credits and allow payments made by the defendant, or out of

his property, upon the claim of the plaintiff, which should have been deducted at the time of the assessment of damages. (*Crookes* v. *Maxwell*, 6 *Blatchf. C. C. R.*, 468.) The defendant is open to the charge of laches, (*Avery* v. *United States*, 12 *Wall.*, 304,) but, under all the circumstances of the case, I am inclined to open the judgment for one purpose only. The judgment is opened only for the purpose of a re-assessment of damages, and of allowing the defendant to give evidence of payments made by Millinger, or out of his property, which should have been allowed and have been deducted from the face of the assessment, but not for the purpose of giving evidence of other defences to the plaintiffs' claim than those of payments which had been made by Millinger, or by Millinger's property, upon the assessment, prior to the date of the judgment. Let there be a reference to ascertain and report the amount of such payments thus inadvertently omitted in the computation of the amount due at the date of the judgment.

E. B. Hill, (*Assistant District Attorney*,) for the United States.

Roger M. Sherman, for the defendants.

JOHN COOKE

vs.

JOSEPH SELIGMAN AND OTHERS. IN EQUITY.

Where one of the defendants in a suit is, on the averments in the complaint in the State Court, an unnecessary and improper party, and no real and actual party, and the plaintiff is an alien, and the other defendants are all citizens of various States of the United States, the case is one removable into this Court under the first clause of § 2 of the Act of March 3d, 1875, (18 *U. S. Stat. at*

Large, 470,) where all such other defendants apply for the removal, and where there is a controversy between the alien and such citizens, which is the only controversy in the suit.

Some of the petitioners for removal signed the petition by an attorney, but the order of the State Court for the removal stated that the petition was duly made and filed by the petitioners, and that the petitioners appeared by counsel and moved for such order. On the contents of the petition and the bond, and the action of the petitioners by their counsel, in moving for such order, and the contents of such order: *Held*, that the petition must be regarded as the petition of the petitioners.

The averment, in the petition, that certain of the petitioners, "as they are the qualified executors of the last will and testament of J. B., deceased," were and are citizens of the State of New York, was *held*, in this case, to mean, that they were sued as such qualified executors, and to be an averment of their personal citizenship.

The absence of any acknowledgment or proof of the execution of the bond was *held* to be a matter of practice for the State Court to pass upon, and not reviewable by this Court, after the State Court had accepted the bond.

The bond contained, in its condition, a clause providing that the defendant should do, or cause to be done, such other and appropriate acts as, by said Act of 1875, and other Acts of Congress, are required to be done, on the removal of a suit: *Held*, that such clause was a sufficient compliance with any requirement in § 3 of the Act of 1875, that the bond should be one for appearing in the Federal Court.

(Before BLATCHFORD, J., Southern District of New York, February 5th, 1880.)

BLATCHFORD, J. Although the complaint avers that Wostenholme owns a number of bonds, it does not aver that he makes any claim in respect of them, on account of any matters alleged in the bill as matters on account of which the plaintiff makes a claim in respect of bonds. Nor does the plaintiff sue on behalf of Wostenholme, or claim to represent him, as respects any claim made on the other defendants or any of them. On the whole scope of the bill, the words "similarly situated," in the preamble to the complaint, and in paragraphs 14 and 16, and in subdivisions 1, 2 and 3 of the prayer, mean the original allottees, called, also, "takers" in paragraph 14. Subdivisions 1 and 2 of the prayer pray no relief for the benefit of Wostenholme, nor does subdivision 3. That subdivision only prays that the moneys to be accounted for may be refunded for the benefit of the original allottees,

of whom Wostenholme was not one. It does not pray that such moneys be refunded for the benefit of the original allottees and holders not original allottees, leaving such moneys to be distributed afterwards. Therefore, the complaint makes no case on which persons not original allottees could put in any claim to any moneys refunded. So, that part of the prayer of subdivision 3 which relates to the superior right of the original allottees, is to be rejected as surplusage, and Wostenholme stands an unnecessary and improper party to the suit, and no real and actual party. This being so, it follows that the suit was removable under the first clause of section 2 of the Act of 1875, as being a suit in which there is a controversy between citizens of various States of the United States and a foreign citizen or subject, and where all the parties defendant have applied for the removal, and where such controversy is the only controversy there is in the suit. The petition for removal makes out a case under said clause, although it may be framed so as to attempt to make out, also, a case under the second clause of the same section.

It is alleged that there are certain defects on the face of the petition and the bond, which invalidate the removal.

The petition, in the body of it, purports to be the petition of all of the defendants, except Wostenholme, by the same names and designations as set forth in the caption or title of the suit in the summons and in the complaint in the State Court. In such caption or title, among the names of the defendants, are these: "James M. Brown, John Crosby Brown, Howard Potter and John S. Shultze, as they are the qualified executors of the last will and testament of James Brown, deceased." An aggregation or list of the names of the defendants is not found in any place, in the summons or complaint, except in such caption or title. The complaint states, that James Brown, by his will, appointed "the defendants James M. Brown, John Crosby Brown, Howard Potter and John S. Shultze," with two other persons, "his executors," and that letters testamentary were issued "to the defendants James M. Brown, John Crosby Brown, Howard Potter and John S.

Shultze, as the qualified executors of the last will and testament of the said James Brown, deceased." The petition is preceded by the title or caption of the suit, giving the name of the plaintiff and the names of all the defendants, and in it, among the latter, "James M. Brown, John Crosby Brown, Howard Potter and John S. Shultze, as they are the qualified executors of the last will and testament of James Brown, deceased." The petition states, "that the controversy in said suit is between foreign citizens or subjects and citizens of different States of the United States;" that, of the defendants, sundry ones named, and, among them, "John Crosby Brown, individually," (he being named by that designation, as a defendant, in the title to the summons, and in the title to the complaint, and in the title to the petition, and as a petitioner, in the list of petitioners in the beginning of the body of the petition,) "and James M. Brown, John Crosby Brown, and Howard Potter, as they are the qualified executors of the last will and testament of James Brown, deceased," were each and all, at the time of the commencement of this suit, and still are, citizens of the State of New York, and that the defendant John S. Shultze, also a qualified executor of the last will and testament of James Brown, deceased, was then and still is a citizen of the State of New Jersey." Among the signatures to the petition are these: Jas. M. Brown—George H. Brown—John Crosby Brown—Howard Potter, by James M. Brown, Atty.—Jno. S. Schultze —as the qualified executors of the last will and testament of James Brown, deceased—the names being under each other, and included in a bracket, at the left of said designation—also, "Trenor W. Park, by J. G. McCullough, his atty."— also, "Isaac Seligman, by Jos. Seligman, atty."— also, "Leopold Seligman, by Jos. Seligman, atty."—also, "Henry Seligman, by Jos. Seligman, atty."—also, "Abraham Seligman, by Jos. Seligman, atty."—also, "Wm. Seligman, by Jos. Seligman, atty."—also, "A. A. Selover, by Billings & Cardozo, attys."—also, "W. Watts Sherman, by Bristow, Peet, Burnett & Oydyke, attys."—also, "George H. Brown"—also,

"John Crosby Brown." The petition is sworn to by the defendant Park.

The condition of the bond offered to the State Court is, that the obligation shall be void, "if the said petitioners shall enter in the said Circuit Court of the United States, on the first day of its next session, a copy of the record in said suit, and shall well and truly pay all costs that may be awarded by said Circuit Court of the United States, if said Court shall hold that said suit was wrongfully or improperly removed thereto, and do or cause to be done such other and appropriate acts as, by the Act of Congress approved March 3d, 1875, and other Acts of Congress, are required to be done upon the removal of a suit into the United States' Circuit Court, from a State Court." The bond is not acknowledged or proved.

On the 21st of October, 1879, the State Court made an order in the suit. The title of the suit, in the order, gives the names and designations of the defendants as in the title to the summons and the complaint. It says: "A petition having been duly made and filed in this suit, by the several defendants," naming the petitioners by the same names and designations as in the body of the petition, "on this 21st day of October, A. D. 1879, praying for the removal thereof into the Circuit Court of the United States for the Southern District of New York, and said defendants and petitioners having duly made and filed therewith a bond, with good and sufficient surety, for their entering in such Circuit Court, on the first day of its next session, a copy of the record in this suit, and for paying all costs that may be awarded by the said Circuit Court, if said Court shall hold that this suit was wrongfully or improperly removed thereto, and for doing such other and appropriate acts as required pursuant to the statutes of the United States in such case made and provided. now, upon motion of John G. McCullough, Esq., of counsel for the petitioners, it is declared, that it is made to appear to the satisfaction of this Court, * * * and that the controversy therein is wholly between an alien and citizen and subject of

the United Kingdom of Great Britain and Ireland, and citizens of different States of the United States of America, that is to say, between the above-named plaintiff, who is a citizen and subject of the United Kingdom of Great Britain and Ireland, and the above-named defendants and petitioners, who are citizens of different States of the United States of America, * * * and it is further declared and ordered, that this Court doth accept the said petition and bond so made and filed as aforesaid, and that the suit be removed for trial into the next Circuit Court of the United States to be held in the Southern District of New York, and that this Court proceed no further therein, and that all proceedings in this Court and the said cause be and the same are hereby stayed."

(1.) It is contended, that § 3 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 471,) provides only, that a "party" "may make and file a petition," and does not provide that an attorney may, and, that, if an attorney in fact may, the fact of his attorneyship and its scope must be shown to the State Court. The order of the State Court states, that the petition was duly made and filed by the petitioners named, and that such petitioners appear by Mr. McCullough, as their counsel, and move for the order which the Court makes. In *Meyer* v. *Construction Co.*, (10 *Otto*, 457,) the petition for removal stated, in the body of it, that it was made by the two defendants, the petitioners, naming them. The petition was not signed or sworn to, but it was filed with the clerk. The Court said: "The petition was not signed. No objection was made on this account in the State Court, and it came too late in the Circuit Court. If it had been made in the State Court, the defect, if, in fact, there was one, would, no doubt, have been cured at once by the signature of counsel. The petition was in writing. On its face, it purported to be the petition of Meyer and Dennison, and it was, in fact, the petition of Dennison. This the Court knew, because it was actually presented by the counsel of Dennison, and was accompanied by a bond purporting, also, to be signed in the name of Meyer and Dennison. In short, everything in the whole proceedings

showed that it was, in fact, what, under the circumstances, it purported to be, the application of Dennison, made in good faith, for the removal of the cause." These views cover the objections made in the present case. Although the plaintiff does not seem to have had prior notice of the application to the State Court for the removal, the contents of the petition and bond and the action of the petitioners, by their counsel, in moving for the order which the State Court made, and the contents of such order, show that the objection made is of no force in this Court.

(2.) It is objected, that the petition does not show that James M. Brown and Howard Potter were and are personally citizens of the United States or of any State thereof, and that the averment is merely, that they, "as they are the qualified executors of the last will and testament of James Brown, deceased," were and are citizens of the State of New York. The case of *Amory* v. *Amory*, (5 *Otto*, 186,) is cited. In that case, certain persons, as executors, brought a suit, in a State Court of New York, against a citizen of New Jersey. The defendant, in his petition for removal, averred, "that said plaintiffs, as such executors, are citizens of the State of New York." The Court said: "Clearly, this is not sufficient. Where the jurisdiction of the Courts of the United States depends upon the citizenship of the parties, it has reference to the parties as persons. A petition for removal must therefore, state the personal citizenship of the parties, and not their official citizenship, if there can be such a thing. From the language here employed, the Court may properly infer, that, as persons, the defendants in error were not citizens of New York. For all that appears, they may have been citizens of New Jersey, as was the defendant. Holding, as we do, that a State Court is not bound to surrender its jurisdiction, upon a petition for removal, until, at least, a petition is filed, which, upon its face, shows the right of the petitioner to the transfer, it was not error for the Court to retain these causes." The facts of the present case do not bring it within the decision in *Amory* v. *Amory*. The expression, "as they are

the qualified executors," &c., introduced by the plaintiff in the title of the suit, and strictly followed afterwards, is fairly to be interpreted as meaning and reading, "sued as qualified executors," &c. The petition is fairly to be read as averring that James M. Brown and Howard Potter, sued as qualified executors, are citizens, &c., meaning, that they personally, sued as executors, are citizens, &c. The averment as to James M. Brown and Howard Potter must be taken in the same sense as the averment as to Shultze, which is, that he, "also a qualified executor," is a citizen, &c., and as averring, substantially, that they, qualified executors, &c., are citizens, &c., rejecting the words "as they are," as surplusage. Then, there is the averment of the petition, that the controversy is "between foreign citizens or subjects and citizens of different States of the United States," taken in connection with the above cited averments in the complaint, and the declaration of the State Court, in the order, as to the citizenship of the defendants, which must be held to refer to their personal citizenship, showing the interpretation given by the State Court to the averments of the petition, and the fact that the State Court surrendered its jurisdiction. The State Court could not properly infer, and did not infer, nor can this Court infer, that, as persons, James M. Brown and Howard Potter were not citizens of New York.

(3.) The want of acknowledgment or proof of the execution of the bond was a matter of practice for the State Court to pass upon, and it will not be reviewed by this Court after the State Court has accepted the bond.

(4.) It is objected, that the condition of the bond does not provide for the defendants appearing in this Court and entering special bail in the suit if special bail was originally requisite therein. The clause in the condition, providing that the defendants shall "do or cause to be done such other and appropriate acts," &c., is a sufficient compliance with any requirement in § 3 of the Act of 1875, that the bond shall be one for appearing in the Federal Court.

The motion to remand the cause to the State Court is denied.

Clarence A. Seward and *Charles M. DaCosta*, for the plaintiff.

Clarkson N. Potter and *J. G. McCullough*, for the defendants.

SUSAN HAMILTON

vs.

GILBERT J. KINGSBURY AND GEORGE T. DAVIS. IN EQUITY.

Where L., the transferee of a right under letters patent, transferred to another only his right, title and interest, K., who subsequently acquired such interest, is chargeable with notice of what he might have learned as to the true extent of such interest, by enquiring of H., named in the transfer from L. as the grantor to L., although the transfer from L. stated the interest in L. as being greater than it really was, H. not being a party to such transfer.

(Before BLATCHFORD, J., Northern District of New York, February 5th, 1880.)

BLATCHFORD, J. When this case was before the Court, on the original bill and the plea thereto, it was decided, (15 *Blatchf. C. C. R.*, 64,) that the proper construction of the recorded conveyance of August 27th, 1866, from Milton A. Hamilton to Lombard and Thompson, was, that Lombard and Thompson acquired thereby the right to make, as well as the right to use and to sell to be used, the patented saw hangings, as they are or may be applied to mulay or single upright mill saws, for, to and in the State of New York, such right to use and to sell to be used being exclusive, but the grantor reserving to himself a right to make in common with the grantees. The

plea was allowed, and the plaintiff then amended the bill by setting forth two unrecorded instruments made August 27th, 1866, one executed by Milton A. Hamilton of the one part and Lombard and Thompson of the other part, and the other executed by Milton A. Hamilton and then delivered to Lombard and Thompson. There was a plea to the amended bill and a replication to the plea, and proofs were taken thereon. The main point of the plea was, that the defendants were *bona fide* purchasers under the said recorded conveyance of August 27th, 1866, without notice of either of the said unrecorded instruments of that date. The case was submitted to the Court on briefs, without oral argument, (*ante*, *p.* 264,) and the Court overruled the plea. The plaintiff contended, that, under the three instruments of August 27th, 1866, taken together, Lombard and Thompson acquired no right to make the invention, except in a certain contingency, which had never happened; that the three instruments were contemporaneous and were all portions of the same transaction, and must all be read together, to determine the intent of the parties to the transaction; that the three instruments were consistent with no intention other than the one set up in the bill, that is, an intention not to convey to Lombard and Thompson, by the recorded conveyance, any right to manufacture the invention; that, if the recorded conveyance gave to them the right to manufacture, the other two instruments had no meaning; and that the instruments were (1) a license, which, in terms, gave the licensees no power to manufacture; (2) an agreement, by which the licensor agreed to furnish the hangings to the licensees at fixed prices, and the licensees agreed that they would not manufacture so long as the licensor kept his agreement; (3) a permission from the licensor to the licensees to manufacture, in case the licensor failed to perform his agreement. The Court held, that the three instruments, taken together, must have the interpretation claimed for them by the plaintiff. The defendants contended that they were *bona fide* purchasers, without notice of any instrument but the recorded conveyance of August 27th, 1866, and that they were

protected from any unrecorded agreement between Milton A. Hamilton and Lombard and Thompson, in the absence of any actual notice thereof. On this question the Court said: "The recording Act in force when the defendants took their conveyance from Strong and Woodbury, on the 10th of December, 1869, was section 11 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 121,) which provided, 'that every patent shall be assignable in law, either as to the whole interest or any undivided part thereof, by any instrument in writing, which assignment, and also every grant and conveyance of the exclusive right under any patent, to make and use, and to grant to others to make and use, the thing patented, within and throughout any specified part or portion of the United States, shall be recorded in the Patent Office within three months from the execution thereof.' It is well settled, that mere licenses, or contracts conferring the limited, and not the exclusive, right to exercise some of the privileges secured by the patent, are not the subjects of regulation by this statute, and that it relates solely to grants or conveyances of the exclusive right or legal estate vested in the patentee, which leave no interest in the patentee for the particular territory and the particular right to which they relate. (*Curtis on Patents*, 3*d ed.*, § 179.) Within this rule, the recorded conveyance of August 27th, 1866, from Milton A. Hamilton to Lombard and Thompson, is not an assignment of the whole interest in the patent, or of any undivided part thereof, nor is it a grant or conveyance of the exclusive right, under the patent, to make and use, and to grant to others to make and use, the thing patented, within and throughout any specified part or portion of the United States. It is only a license. It reserves to the grantor 'the right to manufacture the said invention.' Whatever right to manufacture the grantees acquired by the face of it, such right was not exclusive in them. Therefore, such instrument was not one required to be recorded. Nor were the other two instruments of August 27th, 1866, instruments which it was necessary to record. The recording of the instrument of August 27th, 1866, which was

recorded, was not notice to the defendants that they could safely rely on the record as showing the whole transaction between the parties to the instrument, in respect to its subject-matter. The three instruments were all of them valid without recording, as against the defendants, although *bona fide* purchasers without actual notice. Although the recorded instrument of August 27th, 1866, may, on its face, convey the right to make to the grantees, seeing it on the record is of no more avail to the defendants than if they had seen it out of the record. The existence of the three instruments, taken together, as limiting the right of Lombard and Thompson, affects the defendants with the consequences of such limitation, for they can have no greater right than Lombard and Thompson had."

Before any order overruling the plea to the amended bill has been made, the defendants now present a petition to the Court for a rehearing or a re-argument of the case. The ground of the application is set forth in an affidavit made by Mr. Cogswell, the counsel for the defendants, who prepared the brief for the defendants on the plea to the amended bill, which states, that he understood that the case turned on actual notice to the defendants' assignors, of the unrecorded agreements between them and Milton A. Hamilton, limiting, as was claimed, the operation of the license given by the latter to such assignors; that he was furnished with the plaintiff's brief just before the case was submitted to the Court, and the question upon which the case was decided did not attract his attention until he saw the opinion of the Court; that justice to the defendants requires, that the case should be re-argued, to the end that the question may be presented, whether Milton A. Hamilton, having conferred upon Lombard and Thompson the apparent right to manufacture and sell the patented invention, without restriction or reservation, and the power to assign such right to others, without such restriction, is not, and the plaintiff, as his assignee, is not, estopped from setting up, as against the defendants, who are innocent third parties, and have bought in good faith such right, relying

upon the unconditioned and unrestricted license, the limitation or restriction of said license, contained in a separate instrument not in any way referred to in said license.

The amended bill alleged, that the defendants had constructed machines containing the patented invention, with full knowledge of the facts alleged in the bill, among which facts was the existence of the said two unrecorded instruments. The defendants denied knowledge and notice of the existence of said two instruments. No evidence of actual notice of either of them to the defendants was given by the plaintiff.

It is contended, for the defendants, that a point conclusive against the plaintiff's right was not brought to the attention of the Court; that the Court held, in its decision on the plea to the original bill, that the words "legal representatives," in the recorded conveyance of August 27th, 1866, included "assigns;" that such conveyance was absolute and unconditional, as was held in the same decision, except a reservation not applicable to the question in hand; that the evidence shows that the defendants and their immediate assignors were *bona fide* purchasers for value, without notice; that it is a rule of law, that, where the owner of property has conferred upon another person a power to dispose of it, and an innocent third party has dealt with such person upon the assumption that he possessed such power so apparently conferred, such owner is estopped from asserting that the power was not what it purported to be, but was limited or restricted by some secret agreement; that the purchase by the defendants was made upon the faith of the title which Milton A. Hamilton had apparently given to Lombard and Thompson, and it would be contrary to justice and good conscience to prevent him, or the plaintiff, as his assignee by a title derived from him subsequently to his conveyance to Lombard and Thompson, to assert his real title against the defendants; that a contrary rule would operate as a fraud by Milton A. Hamilton upon the defendants; that the case is one for the application of the principle, in favor of the defendants, that, where one of two innocent parties must sustain loss from the fraud of a third,

such loss must fall upon the one, if either, whose act has enabled such fraud to be committed; that the defendants are innocent purchasers, upon the faith of the apparent title conferred upon Lombard and Thompson; that any fraud which has been committed has been committed by virtue of the evidence of title which the plaintiff's assignor put into the hands of Lombard and Thompson; and that frauds may be perpetrated on the public, if the owners of patents who give absolute assignable licenses, are permitted to treat as infringers purchasers of such licenses, by virtue of a secret agreement entered into at the time of the execution of the license.

Two cases are referred to by the defendants—*McNeil* v. *Tenth National Bank*, (46 *N. Y.*, 325,) and *Moore* v. *Metropolitan National Bank*, (55 *Id.*, 41.) The head note of the first case is, that where the owner of property confers upon another an apparent title to it, or power of disposition over it, he is estopped from asserting his title as against an innocent third party, who has dealt with the apparent owner in reference thereto, without knowledge of the claims of the true owner; and that the rights of such third party do not depend upon the actual title or authority of the one with whom he dealt, but upon the act of the owner, which precludes him from disputing the title or authority he has apparently conferred. The doctrine was limited by the decision to the case where the owner had intrusted to another, not merely the possession of the property, but written evidence, over his own signature, of title thereto, and of an unconditional power of disposition over it. The same doctrine was applied in *Moore* v. *Metropolitan National Bank*, where it was held that the *bona fide* purchaser, for value, of a non-negotiable chose in action, from one upon whom the owner had, by written assignment, conferred the apparent absolute ownership, where the purchase is made upon the faith of such apparent ownership, obtains a valid title as against the real owner, who is estopped from asserting a title in hostility thereto.

Since the decision in this case on the plea to the amended bill, it has been stipulated in writing by the plaintiff, that

Edmund F. Woodbury would testify that the consideration paid for the conveyance of April 29th, 1868, from Lombard and Thompson to Russell, Reese, and the firm of Strong & Woodbury, (consisting of Henry A. Strong and Edmund F. Woodbury,) was the sum of $4,000, in property and cash, and that the defendants respectively would testify that they paid, on the execution and delivery of the conveyance from Strong & Woodbury, of December 10th, 1869, to them, the sum of $1,000, in cash, and that such stipulation be filed and made a part of the record on the application for a rehearing, with the same effect as though such testimony had regularly been put in by the defendants originally.

In the proofs, Edmund F. Woodbury testified, that he negotiated with Lombard the purchase covered by the conveyance of April 29th, 1868; that he never heard, until the spring of 1877, of the two unrecorded instruments of August 27th, 1866; and that the only agreement between Hamilton and Lombard and Thompson, of which he had any information prior to 1877, was the recorded conveyance of August 27th, 1866.

The conveyance of April 29th, 1868, from Lombard and Thompson to Russell, Reese, and Strong & Woodbury, recites, that, "whereas, by virtue of assignment from Milton A. Hamilton, dated August 27th, 1866, the right for the State of New York was vested in us, Clinton A. Lombard and John Thompson," and then it conveys all their "right, title and interest" in the invention, as secured to them by the patent, for, to and in the State of New York. The conveyance of July, 1868, from Reese to Russell and Strong & Woodbury, recites, that, "by virtue of assignment, dated August 27th, 1866, the right for the State of New York was vested in Clinton A. Lombard and John Thompson," and that, by virtue of the assignment from them, of April 29th, 1868, "the right for the State of New York" was vested in Russell, Reese, and Strong & Woodbury, and then it conveys all the "right, title and interest" of Reese in the invention, as secured to him by the patent, for, to and in the State of New York. The convey-

ance of December 10th, 1869, from Strong & Woodbury to the defendants, recites, that, by virtue of the assignment from Hamilton, of August 27th, 1866, "the right for the State of New York" was vested in Lombard and Thompson, and that, by virtue of the assignment from them, of April 29th, 1868, "the right for the State of New York" was vested in Russell, Reese, Strong and Woodbury, and that, by virtue of the assignment from Reese, of July 15th, 1868, "all his right, title and interest in and to said right for the State of New York" was vested in Russell, Strong and Woodbury, and then it conveys all "our right, title and interest therein, as secured by the letters patent and assignment before-mentioned, which consists of the right, title and interest" of Russell, Strong and Woodbury "to the right for the whole State of New York, except one-half interest held by Robert P. Russell, and the counties of Cayuga and Franklin, previously assigned to John Busby and Sidney A. Paddock, respectively."

The conveyance of April 29th, 1868, from Lombard and Thompson, conveys only their "right, title and interest" in the invention. The conveyance from Reese conveys only his "right, title and interest" in the invention. The conveyance from Strong and Woodbury conveys only their "right, title and interest." No recitals in those instruments caused them to operate to convey to the defendants anything more than the right, title and interest of Lombard and Thompson, whatever it was, on the 29th of April, 1868. It is true, that the conveyance of April 29th, 1868, and the subsequent conveyances, recite, that what was vested in Lombard and Thompson, by the assignment, to them was "the right for the State of New York." But, Milton A. Hamilton was no party to those conveyances. He did not deal with any one but Lombard and Thompson. Even if they be regarded as acting as his agents, in subsequently conveying, they conveyed only their "right, title and interest." What that was has been defined. The parties taking from and under them were, by the form of the conveyance from them, referred to Hamilton, to ascertain

what, in fact, the "right, title and interest" of Lombard and Thompson was. What it was depended on the three instruments of August 27th, 1866, taken together, and an inquiry of Hamilton would have disclosed that fact. There was enough in the terms "right, title and interest," in the assignment from Lombard and Thompson, to put any purchaser from them, immediate or subsequent, on inquiry, and to charge him with notice of what such inquiry, if made of their grantor, would have disclosed. While, by the recorded assignment of August 27th, 1866, the right to make may appear to have been vested in Lombard and Thompson, yet they did not undertake to convey what that assignment appeared to convey, but only their "right, title and interest," as it in fact existed. The case, therefore, does not fall within the principle of the two cases cited for the defendants. In this case no one made any inquiry of any person but Lombard and Thompson. Neither Hamilton nor the plaintiff is bound by any suppression of the truth by them, or any failure on their part to disclose all three of the instruments, so long as they assumed to convey only their "right, title and interest."

It follows, that the prayer of the petition must be denied.

George H. Lothrop, for the plaintiff.

William F. Cogswell, for the defendants.

WILLIAM ADAIR *vs.* BARTON D. THAYER. IN EQUITY.

The second claim of re-issued letters patent No. 6,964, granted to William Adair, February 29th, 1876, for an improvement in pumps, namely, "The combination of the piston cylinder, the valve chamber and its valves, by which the water is supplied to and discharged from the lower side of the piston, the water head, and a cylinder cover which is removable from the pump

through the open water head, substantially as described," is a claim for such a combination in double-acting pumps, and is valid.

A pump sold by the defendant was held to infringe such claim, although a part of the combination was used in it for only one of the purposes for which such part was used by the plaintiff.

(Before WHEELER, J., Southern District of New York, February 11th, 1880.)

WHEELER, J. This suit is founded upon re-issued letters patent, No. 6,964, dated February 29th, 1876, granted to the orator, for an improvement in pumps. Before his invention single-acting pumps, cast in one piece, with open water heads, through which the piston and valves could be withdrawn and replaced readily, had been constructed; but all double-acting pumps, so far as has been shown, had been made in detached portions, were complicated, and their parts difficult of access. He devised a double-acting pump, with a piston cylinder, and an open cylinder beside it, for the valves below the piston, both below an open water head, through which the piston and those valves could be readily removed and replaced, and with another short cylinder beside, and opening into the upper part of, the piston cylinder, for one of the valves above the piston, and a floating top to the piston cylinder, constituting the other valve above the piston, all the stationary parts of which could be cast in one piece, and all the moving parts of which would, when once in operation, be covered with and made air-tight by the water. The patent was intended to cover these improvements. The specification commences by stating, that the invention consists in improvements in double-acting pumps, and describes the parts constituting the pumps as improved, their objects and modes of operation. There are five claims, the second of which only is claimed to be infringed, and that is for the "combination of the piston cylinder, the valve chamber and its valves, by which the water is supplied to and discharged from the lower side of the piston, the water head, and a cylinder cover, which is removable from the pump through the open water head, substantially as described." There cannot be a double-acting pump without two sets of valves, one below the piston, through which the water

is drawn when the piston ascends, and another above the piston, through which the water is drawn when the piston descends. Only one pair, the one below the piston, is specifically mentioned in that claim. That pair, with the other parts specifically mentioned in the claim, and without the pair above the piston, not mentioned, would constitute a single-acting pump only. For such a pump the claim could not be maintained, because of lack of novelty; and, as a claim for such a pump, it clearly would not be infringed by the pump of the defendants. The defendants argue and insist, that, as the inventor separated his claim into parts, each part must stand by itself, and be held to cover only devices mentioned in it. If this construction should be adopted, the patent, so far as this case is concerned, would be defeated. The patent is a grant, and is to be fairly and liberally construed in favor of the grantee, to effectuate the intention of the parties to it. This is the settled doctrine in this country. Construing according to this rule, the whole subject of the patent is to be looked at. It is for an improvement in double-acting pumps, and has no reference to single-acting pumps. The claim must be read as if it said, for the combination, in a double-acting pump, such as had been described, of the parts mentioned. This saves the patent, and saves this claim as a claim for the combination of the parts mentioned, in such a pump. There they work together, and are not a mere aggregation.

The defendant sells a pump which has an open cylinder, beside the piston cylinder, for the valves below the piston, both of which are below an open water head, through which the piston and these valves can be readily withdrawn and replaced; and another cylinder beside the piston cylinder, for the valves above the piston, opening into the water head which extends over it, with a fixed cover to the piston cylinder, so that the valves above the piston can be worked; all the stationary parts of which are cast in one piece, and all the moving parts of which are, when in operation, under the water and made air-tight by the water, and constituting a

double-acting pump. Here are all the elements of the combination described in the second claim of the patent, each doing the same thing in the same way as described in the corresponding parts of the specification, except the cylinder cover of the piston cylinder. As to that, in the orator's pump, it operates, during the down stroke of the piston, as a cover for that cylinder, without which the valves above the piston could not work at all; and, in the defendant's pump, it does precisely the same thing during the corresponding movement, without which the valves above the piston could not work there at all. In the orator's pump, it can be hauled up with the piston through the open water head, as far as the fastenings about the piston rod above the pump will permit. In the defendant's pump, it is fastened down to its place by braces from the supports of the piston rod above the pump, but is readily removable by removing those braces, and removable through the open water head. To free it wholly from the rest of the pump, the fastenings of the piston rod above the pump must be removed in each case. So, that element of the combination performs one office in the defendant's pump, in the same manner as in the orator's, and in the manner assigned to it in that claim. That part of the orator's invention has been appropriated to the construction of the defendant's pump. It is not necessary, in order to constitute infringement of a combination patented as such, that the whole combination should be used. If a part of it only that, separate from the rest, was new and patentable to the inventor, is used, taking that part is an infringement *pro tanto*. (*Lister* v. *Leather*, 8 *Ell. & Blackb.*, 1004; *Sellers* v. *Dickinson*, 5 *Exch.*, 312.) Here, the whole of this part of the patented invention is taken for one purpose, but not for all. It is none the less taken, however, and the taking is none the less an infringement, because it is not taken for all purposes.

The defendant's pump is, probably, in some respects, an improvement upon the orator's, but that is no excuse for taking that part which the orator invented, and is not claimed to be. It is said, that, as the double-acting pumps were well

known before, the orator could only have a patent for his particular form, and that the defendant's pump is of different form, and does not infringe, (*Railway Co.* v. *Sayles*, 97 *U. S.*, 554;) and the statements of Mr. Justice Bradley, in the opinion of the Court, are cited in support of that argument. Those statements are very applicable to cases like this. It is to be noticed, that each inventor is there said to be entitled to his own specific form, only so long as it differs from those of his competitors, and does not include theirs. Here, the defendant has included a part of the orator's specific form of double-acting pump, and cannot shield himself from being adjudged an infringer to that extent.

Let there be a decree for an injunction and an account, according to the prayer of the bill, with costs.

Andrew J. Todd, for the plaintiff.

J. Van Santvoord and *John S. Washburn*, for the defendant.

MARGARET DWYER, AS ADMINISTRATRIX OF JOHN DWYER, DECEASED

vs.

THE NATIONAL STEAMSHIP COMPANY.

D., while on the deck of a steamship belonging to the defendant, arranging in the hatch the pipe of a grain elevator, stepped upon a section of the grating of the hatch, which, not being properly placed in the groove in which it was intended to fit, tilted under his weight, and he fell through the hatchway and was killed. D. was in the employ of the owner of the elevator, who had a contract with the defendant to put the grain into the hold of the steamer. A stevedore had a contract with the defendant to load the steamer. It did not appear when or by whom the grating was negligently placed: *Held*,

(1.) It was no part of the defendant's duty to maintain a safe covering on the hatchway;

(2.) That, if the stevedore's men improperly placed or displaced the grating, the defendant was not responsible for their acts.

(Before BENEDICT, J., Eastern District of New York, February 12th, 1880.)

BENEDICT, J. This is an action at law to recover of the owners of the steamship Canada, for the death of one John Dwyer, who fell through the hatchway of that steamer on the 30th of October, 1878, and was killed. At the trial, the Court directed a verdict for the defendant. A motion to set aside the verdict, and for a new trial, has been made, and is now to be disposed of. The facts appearing at the trial are as follows: The deceased, on the morning of October 30th, and while in the act of arranging the pipe of a grain elevator in the hatch, stepped upon a section of the grating of the hatch, the section tilted under his weight, and he fell through the hatchway to the orlop deck and was killed. The hatchway was about 12 feet long. The grating was constructed in sections, each section about two feet wide, and intended to fit in a groove, when in position. No defect of construction or weakness of materials in the grating is pretended. The section on which the deceased stepped did not break, but tilted under his weight, and solely because it was not properly placed in the groove where it was intended to fit. Had it been in its proper position, it would have been abundantly strong to support the deceased, without danger. Similar hatchways, having similar gratings, are a common feature in vessels of this class. They are a necessary feature in the deck of a ship, and their position in the ship is controlled by the necessity of the business. It appeared in evidence, that, during the night before the accident in question, the gratings had been placed upon this hatchway, with a tarpaulin over them, for the purpose of preventing the falling rain from wetting the grain then being loaded into the steamer by means of the elevator. There was no direct evidence showing by whom the grating was placed upon the hatchway, or

how it was then placed, or whether it remained in the position as first placed up to the time of the accident. It was proved, that, a few moments before the accident, men employed by Walsh Brothers, stevedores, had taken off the tarpaulin from the hatchway, and removed several sections of the grating, in order to facilitate their labors in the loading of the cargo. At the time of the accident, the deceased and others employed by Burgess, the owner of the elevator, were engaged in putting another length of pipe to the elevator pipe, for the purpose of passing grain through the hatchway into the hold. The deceased was an employee of Burgess, who had a contract with the defendant to transfer the grain from a canal-boat to the steamer. The deceased was not, therefore, the servant of the defendant, but of Burgess, an independent contractor. Walsh Brothers were, also, independent contractors, who had a contract with the defendant to discharge and load the steamships of the line, at so much per ton. The stevedores' men at work on the cargo at this time were, therefore, not the servants of the defendant, but of Walsh Brothers. The cause of the accident is clearly proved to have been the unsafe manner in which the section of the grating upon which the deceased stepped was placed upon the hatchway. The actual wrong-doer was the person who placed the grating upon the hatchway during the night, or some person who changed the position of the grating after it had been so placed; but there is no evidence from which it can be determined whether the negligence occurred at the time the grating was placed upon the hatchway, or at a subsequent time, or by whom the negligent act was done. Accordingly, it is contended that the defendant, being the owner of the steamer, was charged with the duty of maintaining the hatchway in a safe condition, and, by reason of the failure to discharge that duty, is liable, without proof as to who was the wrong-doer.

If I were convinced that the condition of the hatchway at the time of the accident was proof of a failure on the part of the defendant to discharge a duty attaching to it in respect to the hatchway, I should find no difficulty in holding the de-

fendant liable, whether the grating was misplaced by the stevedores, the elevator men, or the crew of the vessel. But, I cannot agree to the proposition, that it was part of the defendant's duty to maintain a safe covering upon this hatchway. Hatchways are well-known features and sources of danger on a ship. They are intended to be open a large portion of the time, especially when in port, not only for the purposes of loading and unloading cargo, but also for ventilation. An open hatchway on a ship, when provided with the usual combings, is not evidence of a neglect of duty on the part of the ship-owner. On the contrary, a ship-owner has the right to allow the hatchways of his ship to remain uncovered and unprotected, except by the usual combing, and all persons moving upon the decks of a ship are chargeable with notice of the probable presence of open hatchways in the decks. Neither is it the duty of the ship-owner to maintain a guard stationed at the hatchway of his ship, for the purpose of protecting persons from injury by falling into it. Such a duty would be burdensome in the extreme, and is not required by the law. (*Murray* v. *McLean*, 57 *Ill.*, 378.) The requirement would be unreasonable, and has never been observed in practice, nor, so far as I know, declared in any adjudged case.

The cases cited, where the injury arose from defective machinery, afford no support to the position taken by the plaintiff, because, here, there is no pretence that the injury arose from any defective weakness or faulty construction of the grating. The cases cited, declaring a liability for injury arising from holes in thoroughfares, improperly protected, holes in floors, and the like, are, equally, inapplicable here. The deck of a steamer is not a highway, and is a place where open hatchways must be maintained, and, therefore, are to be expected and avoided. More in point are the cases where injury has arisen from man-traps, by which a person has been lured into a dangerous position, to his injury, although it is not clear that a grating upon a ship's hatchway can, in any proper sense, be said to be a lure. Indeed, I do not find any

adjudged case that can be considered authority for holding that a ship's hatchway, wholly uncovered as to a large portion, and insecurely covered as to a small portion, by reason of an improperly placed section of the grating, about which stevedores and elevator men were at work, is calculated to expose the men to an unforeseen or unnecessary danger. The character and uses and location of a ship's hatch, even when wholly covered by a grating, are calculated rather to warn than to induce a person to stand upon the grating, and, certainly, such would be the case when, as here, only a portion of the grating was upon the hatch.

But, if it be assumed, in this case, that the presence of some of the sections of the grating upon the hatchway at which the deceased was working gave him the right to suppose that those sections afforded a safe standing place, the liability of the defendant does not appear until it be shown that the insecure section was put in its unsafe position by the defendant. As has been seen, no liability attaches to the defendant by reason of a failure to discharge a known duty. If the defendant be liable at all, that liability arises not from an act of omission. He had the right to omit to cover the hatchway, and the bare fact that it was wholly uncovered, or partly uncovered, is not sufficient, therefore, to establish his liability. He is liable, if at all, for an act of commission, namely, the act of placing the grating upon the hatch in a negligent manner, or the act of disturbing the grating after it had been placed upon the hatchway in a proper manner. The decisive question, therefore, is, whether there was sufficient evidence to authorize the jury to find that the defendant improperly placed the grating upon the hatchway, or disturbed it after it had been once properly placed.

Here, the case of the plaintiff rests upon the presumption, that everything done on board the steamer, in respect to the hatchway, was directed to be done by the owner of the steamer. There is evidence showing that gratings were put on the hatchway during the night, leaving one off for the passage of the elevator pipe, and that a tarpaulin was put over the

hatchway, to keep the falling rain from reaching the grain, as it went into the ship; but there is no evidence to show who it was that put on the grating or the tarpaulin, or to show that the section which gave way under the deceased was disturbed after being put on in the night. There is a bit of evidence showing that the crew of the steamer were employed in washing the decks during the night; and it has been argued, that the grating and tarpaulin were put on at that time, to protect the cargo from the water used to wash the decks. But, the evidence is positive, that neither the grating nor the tarpaulin were put on or disturbed at that time, for that purpose. Conceding that the plaintiff is entitled to invoke the presumption upon which, in the absence of evidence as to the fact, he is compelled to rely, the difficulty is, that the case contains evidence by which the presumption is overthrown. The positive testimony of the boatswain of the steamship, from the steamer's deck, that he did not meddle with the grating, or see it meddled with by any of the crew, and the evidence showing that it would be for the stevedores engaged in loading the vessel to put on and remove the grating at the hatchway, is sufficient evidence to repel any presumption that the wrong-doer was one of the crew. The evidence points so strongly to the stevedores as the wrong-doers, as to forbid any other conclusion by the jury. Indeed, it appears to be conceded, in behalf of the plaintiff, that such was the fact, for, one point made in the brief is, that the defendant, "by the contract, authorized Walsh to do the very act which caused the injury, to wit, to remove the hatches, and is responsible for his negligence." The case is, then, reduced to the question of law, whether the defendant is responsible for the negligent act of the stevedores in improperly placing, or in displacing, the grating on which the deceased stepped. Upon this question I entertain no doubt. The contract with the stevedores, Walsh Brothers, was to load and unload the cargoes of this and other steamers belonging to the defendant, at so much per ton, and, as is said in the plaintiff's brief, the injury complained of did not result directly from any thing

which the contractor was bound by his contract to do. If the defendant had been under a duty to protect this hatchway by grating or otherwise, or if the stevedores had been employed or directed by the defendant to cover this hatchway, the case would have been different; but, in the absence of any such duty devolving upon the defendant, or of any evidence of such employment of the stevedores by the defendant, it is quite clear, that the defendant's liability has not been established. The case comes within the rule declared in a case greatly relied on by the plaintiff, where it is said: "If an independent contractor is employed to do a lawful act, and in the course of the work he or his servants commit some casual act of wrong or negligence, the employer is not answerable." (*Pickard* v. *Smith*, 10 *Common Bench, N. S.*, 470.)

The motion to set aside the verdict must be denied.

Morris & Pearsall, for the plaintiff.

John Chetwood, for the defendant.

S. Emerson Root

vs.

The E. N. Welch Manufacturing Company. In Equity.

Re-issued letters patent were granted August 3d, 1875, to S. Emerson Root, for an improvement in clock dials, the original patent having been granted to him May 10th, 1859, and extended for seven years from May 10th, 1873. The plaintiff filed a disclaimer December 24th, 1877. It appearing that a clock dial composed of a printed paper dial and a metallic back united by a metallic rim was old, and that a metallic back with a lateral outside flange was commonly in use, it was *held*, that it was no material part of the invention to make the rim to correspond generally with the old pattern of the

back; that that was all there was left of the invention after the disclaimer; and that, therefore, no patentable invention remained.

(Before SHIPMAN, J., Connecticut, February 13th, 1880.)

SHIPMAN, J. This is a bill in equity to restrain the defendant from the alleged infringement of re-issued letters patent, dated August 3d, 1875, for an improvement in clock dials. The original patent was issued to the plaintiff on May 10th, 1859, and was subsequently extended for seven years from May 10th, 1873. The plaintiff's invention was made in the spring of 1855. An application for a patent was filed on September 5th, 1855, which was rejected, and was withdrawn on January 30th, 1858. A renewed application was filed January 31st, 1859.

Prior to the date of the plaintiff's invention, painted metallic dials were commonly used upon the ordinary wooden clocks then and now largely manufactured in Connecticut. The painted surface of the dial was apt to crack, and much time was required to paint and dry them properly. For the purpose of avoiding these difficulties, the plaintiff made the invention which subsequently became the subject of his letters patent.

Paper dials were known prior to the date of the invention. Metallic backs with a paper dial, the edge of the back being turned over upon the paper dial, so as to secure the paper to the back, were also known and had been made by the Terry Manufacturing Company in 1854. The plaintiff's invention consisted in the combination of a paper dial, a back, preferably of zinc, and a metallic cap or frame or scalp, which united the back and the dial. The function of the cap or frame or scalp, as correctly described by the plaintiff's expert, was "to cover the edge of the dial by the inner edge of said frame, and hold the dial firmly against the back, so that its edge will not warp up or become displaced, while the outer edge of said frame is turned over and embraces the edge of the back, while the body of the scalp serves to unite these two edges which I have described, and thereby the three

parts, to wit, the dial, the back and the frame are all held together and constitute, as a whole, a clock dial."

The patentee, after referring to the drawings, which show the form of frame and of back, which will be described hereafter, says, in the re-issued specification, that the back may be made entirely flat, if desired. The dial may be made of the same diameter as the back, and the frame made plain and turned over the edges of the dial and the back, thus compressing them thoroughly together. "When it is desired to make a molding frame and back, the edge of the back is made nearly the shape of the frame. The dial, B, is made of such diameter as to just fill in between the raised portion from the flat surface of the back, A. The frame or scalp, C, is placed over the dial, B, and the edge, D, turned over the edge of the back, A, and pressed together, thus firmly compressing the edge of the dial between the inner edge of the frame, C, and back, A." The claims of the re-issued patent were as follows: "(1.) The combination of a metallic scalp with a clock dial, substantially as and for the purpose described. (2.) The combination of a metallic scalp and zinc back with a paper dial, substantially as and for the purpose shown. (3.) The combination of a zinc back with a paper dial, substantially as and for the purpose set forth. (4.) The combination of metallic back and paper dial with a rim of 'struck up' sheet metal, substantially as and for the purpose described. (5.) As a new article of manufacture, the combination of a clock dial, B, metallic back, A, and frame, C, substantially as and for the purpose set forth."

On December 24th, 1877, and before this suit was brought, the plaintiff duly made and entered in the Patent Office a disclaimer, whereby he disclaimed the third clause of the claim, and further disclaimed as follows: "Further, in the first and second clauses of said claim, wherein 'a metallic scalp' forms one of the elements of the combinations respectively covered by said claims, a disclaimer is hereby entered to a metallic scalp, broadly considered, and the scope of the claims is restricted to the combination of parts specified in

said first and second claims, when the metallic scalp therein specified is provided with lateral flanges on its outer and inner edges, substantially as illustrated in the drawings forming a part of said re-issued letters patent. Further, your petitioner enters a disclaimer to 'a rim of struck up sheet metal,' broadly considered as entering into the fourth clause of claim, and restricts said claim to the combination of parts therein specified, when the 'rim of struck up sheet metal' therein specified is formed on the edge of the metallic back, and serves to govern the position of the dial, substantially as illustrated in the drawings forming a part of said re-issued letters patent. Further, your petitioner enters a disclaimer to 'frame C,' broadly considered as entering into the combination of parts specified in the fifth clause of claim, and restricts the scope of said claim to the combination of parts therein specified, when the 'frame C' is provided with lateral flanges on its outer and inner edges, substantially as illustrated in the drawings of said re-issued letters patent." The plaintiff stated, in the disclaimer, that he had secured claims in the re-issued patent which were too broad and included that of which he was not the first inventor. He made the disclaimer in consequence of having seen a clock dial which had been sold by the Terry Manufacturing Company, and which he supposed preceded the date of his invention. In fact, the dial was made by himself, in 1856.

The drawings of the patent show that the inside edge of the frame covering the edge of the paper dial is a lateral flange. The outside part of the frame which turns over the edge of the back is also a lateral flange.

I am of opinion that infringement of the first, second and fifth claims is clearly proved, and that want of novelty is not proved. It is conceded that there was no infringement of the fourth claim.

The answer sets up divers defences. The only one which I think it is desirable to examine particularly is, that "the supposed invention remaining after said disclaimer was not and is not a material part of the thing patented." The defend-

ant says that the invention consisted in a combination of paper dial, back, and metallic frame or rim; that the shape of the rim was entirely a matter of taste, ornament or convenience; that there is nothing functional in the form of the rim; and that the specification shows clearly that the form of the rim was an immaterial circumstance. The plaintiff says that the lateral flanges and their offices were shown in the drawings; that the office of the inside lateral flange was "to conceal the edge of the clock dial and to furnish a flat, annular seat against which the front of the dial rests, and by which it is held in position in such a manner as to prevent the dial from coming forward;" and that the office of the outer flange, in addition to its furnishing means by which to secure the scalp to the dial, was to furnish a flat seat upon which the whole dial is supported when placed against the front of a clock case, and through which seat screws may be inserted to secure the dial in place.

The disclaimer admits, in effect, that the patentee was not the first inventor of the combination of a paper dial, a back, and a metallic rim or frame not having lateral flanges on its outer and inner edges, but that this combination was old. It is also a fact, that painted dials of one piece of metal having an outwardly projecting lateral flange, which was secured to the clock case by screws drilled through this flange, were in common use prior to the date of the invention. The sash upon the door of the clock case was fastened by a catch to this flange.

No objection is made to the form of the disclaimer. The question simply is, whether there is anything in the specification of the patent, or outside of it, which shows that a material part of the invention consisted in the flanges upon the edges of the frame, or whether the form of the frame, as exhibited in the drawings, was an immaterial matter, which did not partake of the character of invention. It must be remembered, that the question is not whether the flanges perform a certain office, or whether the drawings exhibit the office, but it is whether there was any invention in the means for the

performance of such office. The second deflecting plate in *Dunbar* v. *Myers*, (94 *U. S.*, 187,) performed an office, but the Court was of opinion that the addition of such second plate involved no invention. The "close chamber," and the "freezing mixture," in *Brown* v. *Piper*, (91 *U. S.*, 37,) performed the office of preserving fish, but the Court was of opinion that the means used were an application of an old process to a new subject, without invention.

An inspection of both the re-issued and the surrendered patents, and of the rejected specification, shows, that the flanges constituted no portion of the invention upon which the mind of the inventor relied as important. He says, in substance, that the back may be made plain, or may have a raised and then flattened edge. The dial may have the diameter of the back, or may be made of such diameter as to just fill in between the raised portion from the flat surface of the back. No patentable advantage is ascribed to one shape over another, or to any shape; and there is no suggestion of novelty in the method of attaching the clock dial to the case or the sash to the frame.

Furthermore, the backs of the painted dials which were commonly used in wooden clocks at the date of the invention were made, substantially, like the back of the dial shown in the drawings, that is to say, their edges were raised and then flattened, so as to give room for the hands inside the sunken portion of the dial, and so as to form a peripheral flange, by which the back could be attached to the case. The patentee put a paper dial, upon which the figures denoting the hour were printed, within the rim of the back, instead of having the figures painted upon the painted surface of the plate, and, in order to keep the paper dial in place, united it to the back by a metallic rim, one edge of which covered the edge of the dial, and the other edge was turned over the outside edge of the back. The shape of the rim was determined by the shape of the back which might be desirable in any particular style of clock, or as a matter of ornament. Flanges were not used because they made a seat for attaching

the dial to the case, but were used to conform to the old style of back, when that style, which had an old function of its own, was used.

Given the two facts, that a clock dial with a printed paper dial, a metallic back, and a metallic rim uniting the back and the paper dial, was old, and that a metallic back, with a lateral outside flange, through which screws were inserted to fasten the dial to the clock case, was commonly in use, was it any material part of the invention to make the rim to correspond generally with the old pattern of the back? I am of opinion that it was not, but that the shape of the rim was a matter merely of mechanical convenience. The inside lateral flange has the same offices which are performed by any edge of the rim, and the form is the one which would be naturally adopted upon a sunken dial plate.

The bill should be dismissed.

H. A. Seymour and *Rodney Mason*, for the plaintiff.

Charles E. Mitchell and *Richard D. Hubbard*, for the defendant.

PRISCILLA W. PAGE, AS ADMINISTRATRIX, &C., AND THE WESTERN UNION TELEGRAPH COMPANY

vs.

THE HOLMES BURGLAR ALARM TELEGRAPH COMPANY.

IN EQUITY.

The re-issued letters patent granted October 10th, 1871, to Priscilla W. Page, administratrix, &c., of Charles G. Page, deceased, and the Western Union Telegraph Company, for improvements in induction coil apparatus and circuit breakers, the original patent having been granted to said Page, as in-

Page v. The Holmes Burglar Alarm Telegraph Company.

ventor, April 14th, 1868, are valid, so far as claims 11, 12 and 13 are concerned.

The history of the invention, and of the efforts of Page to obtain a patent for it, set forth.

The defendant held to have infringed claims 11, 12 and 13, namely, "11. The adjustment of the retractile force of an automatic circuit breaker, substantially as set forth. 12. The combination of an electro-magnet, armature and adjustable retractor. 13. Adjusting or regulating the length of vibration of the armature of an electro-magnet, by means of a set screw, or any mechanical equivalent for substantially the same purpose, substantially as herein set forth."

Claim 11 held to have been infringed, although, in the plaintiff's patent, the armature was retracted by a weight, made adjustable, and, in the defendant's apparatus, the retractile force was a spiral spring, made adjustable as to its tension, the two having the same extent of adjustable capacity, by minute adjustments capable of being made without stopping the working of the apparatus; and although the adjustable functions of the spring were used only to ascertain whether the apparatus was in working order originally, and then the spring was left at the tension fixed upon.

The words "the adjustment," in claim 11, held to mean, the mechanical means of making the adjustment.

Claim 13 held to have been infringed, although the defendant's set screw was set originally at a given point, to determine the extent of vibration of the armature, and was not afterwards changed.

Claim 13 held to be a claim to the set screw so arranged as to be capable of making the regulation.

The special Act of Congress of March 19th, 1868, (15 *U. S. Stat. at Large*, 356,) under which the patent was granted, construed.

The words "circuit breakers described by him prior to said application," in said Act, defined, and held to include such appendages and added instrumentalities, so previously described by Page, as were calculated to make the circuit breaker more efficient or perfect.

The inventions covered by claims 11 and 12 examined, as to their history and the prior description of them by Page.

Claim 13 examined, as to the time from which the invention covered by it takes date, as having been described by Page.

The novelty of the inventions covered by claims 11, 12 and 13 held not to have been successfully impeached.

The provision in § 2 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 118,) which disqualified a person, while an employee in the Patent Office, from acquiring an interest in a patent, did not operate to dedicate to the public inventions made by such employee before he became such employee.

The said special Act construed, on the question of the abandonment of the inventions by Page to the public, and held not to be open to the objection that it deprived any person of his property without due process of law.

The application to be made under said special Act was subject to the same

rules as other applications, and the same right to a re-issue existed as in the case of other patents.

(Before BLATCHFORD, J., Southern District of New York, February 17th, 1880.)

BLATCHFORD, J. This suit is founded on re-issued letters patent granted October 10th, 1871, to Priscilla W. Page, administratrix, &c., of Charles G. Page, deceased, and the Western Union Telegraph Company, for improvements in induction coil apparatus and circuit breakers, the original patent having been granted to said Page April 14th, 1868. It was granted under an Act of Congress approved March 19th, 1868, (15 *U. S. Stat. at Large*, 356,) which provided as follows: "The Commissioner of Patents is hereby authorized to receive and entertain a renewal of the application of Charles Grafton Page, for letters patent for his 'induction apparatus and circuit breakers,' now on file in the United States Patent Office, including therewith his circuit breakers described by him prior to said application, and that, if the Commissioner shall adjudge the said Page to have been the first inventor thereof, he shall issue to him a patent, which patent shall be valid, notwithstanding said Page's invention may have been described or in use prior to said application, and notwithstanding the fact that said Page is now an examiner in the United States Patent Office: *Provided*, that any person in possession of said apparatus prior to the date of said patent shall possess the right to use, and vend to others to use, the said specific apparatus in his possession, without liability to the inventor, patentee, or any other person interested in said invention or patent, therefor."

There are 15 claims in the re-issue. It is insisted that claims 11, 12 and 13 have been infringed by the defendant. They are as follows: "11. The adjustment of the retractile force of an automatic circuit breaker, substantially as set forth. 12. The combination of an electro-magnet, armature and adjustable retractor. 13. Adjusting or regulating the length of vibration of the armature of an electro-magnet, by means of a set screw, or any mechanical equivalent for substantially the

same purpose, substantially as herein set forth." Portions only of the specification are necessary to be considered. After describing the arrangement of a revolving armature for an automatic circuit breaker, the specification says: "Instead of a revolving armature for a circuit breaker, a vibrating armature may be substituted, and the latter will be found more convenient, for several reasons. One especially is, that it can be readily adjusted so as to increase or diminish the rate of interruption of the circuit and the force to be overcome in working it. A vibrating automatic circuit breaker, consisting of a very small electro-magnetic bar, vibrating between the arms of a permanent magnet, the magnet changing its poles at each vibration, the length of vibration of the bar being regulated by a set screw, makes a good circuit breaker, and will be found fully described by the said Charles G. Page in Silliman's Journal, volume 32, pages 355 to 358, in a communication dated April 19th, 1837. This species is, however, not so simple as others, and further allusion to it is not necessary. A vibrating armature is preferable, as it requires no change of poles to effect its motion, this being produced by merely intercepting the galvanic current at suitable intervals. One form of vibrating armature is shown at figure 8. A small rod of soft iron, about the size of that shown in the figure, is mounted upon an axis or shaft, *s*, which is supported in suitable bearings upon two pillars, *r*, so as to vibrate freely. A small electro-magnet is supported upon one of these pillars, and the armature is placed between its branches, so that one end is above and the other below the plane of the magnet. One end of the armature bears a branching copper wire, its branches passing down into mercury cups *c*, c^1. Cup *c* may be partly of glass, so that the play of the end of the branch wire in and out of the mercury in the cup may be seen and the spark produced on breaking the circuit rendered visible. When the magnet is charged the armature is attracted toward its poles, and around the ends of the armature is a ferrule of thin brass or non-magnetic, metal to prevent magnetic adhesion of the armature to the magnet. The gal-

vanic connections are under the base board, and may be traced as follows: One pole of the battery being connected with cup p, and the other with cup n, the current will pass along from cup p to cup c, as indicated by the arrow, thence upward through one branch of the wire and downward through the other branch, into cup c^1, thence upward again into one end of the wire around the electro-magnet, and, circulating around the wire coil, will pass out through the other end to cup n and so back to the battery. The passage of the current charges the magnet, lifts one end of the armature, raises the branch wire from the mercury in the cups c, c^1, and breaks the circuit. This end then falls by its weight, the branch wire overbalancing the other end, the circuit is again completed, and thus it may be broken with great rapidity. An adjusting or set screw may be placed on a suitable support over this end, after the manner of the last-named vibrating circuit breaker, so as to regulate the extent of the vibrations. The weight of this end, or what may be denominated its retractile force, may also be regulated by a small movable weight placed on or over this half of the armature, after the manner shown in figure 10. This circuit breaker is introduced into the circuit of the primary coil in the same way as the revolving armature. A more simple form of vibrating armature is shown in figure 9, in which the armature n vibrates to and from the electro-magnet u, u, in a direction parallel to itself. It is attached to a light brass spring s, fastened to pillar 2. This spring passes through an opening in the yoke y on the top of pillar 3. At p is a tip or small disk of platinum, soldered to the spring, which is in contact with the platinum point on the lower end of set screw s^2, passing down through the top of the yoke. Set screw s^2 is accompanied with a tightening nut, s^1. This set screw regulates the proximity of the armature to the magnet, and, to some extent the tension of the spring and the rapidity of its vibrations. It will be seen, however, that the regulation or adjustment is imperfect, for, as the spring is pressed down toward the magnet, the armature is brought nearer to the magnet,

and, as the attractive force increases more rapidly with the diminution of the distance between the armature and the magnet than does the force of the spring increase, the adjustment is, in a measure, defective. If, now, the magnet *d d* be connected with the battery and charged, and the circuit with the battery is made by the current passing up pillar 2, thence into spring *s*, thence into set screw s^2 and pillar 3, and thence through the wires of the electro-magnet back to the battery, the magnet will draw down the armature, and with it spring *s*, and thus break the circuit, by pulling the platinum disk away from the platinum point on the lower end of set screw s^2. On breaking the circuit the magnet loses its power, and the spring rises and completes the circuit again, the magnet is again charged and the armature drawn down and breaks the circuit again, and thus a very rapid series of vibrations and interruptions of the circuit may be effected. It is evident, therefore, if the circuit of this breaker is included in or forms part of the main circuit which passes through the primary coil, that at each break an induced current will be set up in the secondary coil, as with the other circuit breakers. In figure 10 is shown an electro-magnet and armature in which the retractile force of the armature is made adjustable. This is oftentimes important. The coils *i* are secured to a base board and inclose a bundle of soft iron wires, seen projecting slightly at *a*. Between the two pillars *x* is suspended the vibrating electrotome or circuit breaker. *g* is a small cylinder of soft iron attached to one end of the lever *e*, which passes through, or is otherwise secured to, the vibrating shaft *k*. The other end of the lever dips into a mercury cup *m*, fixed upon the metallic strap b^1. On the strap *b* is another mercury cup of brass, into which descends a branch wire *h*, from the vibrating wire *e*. Arising from the shaft *k* is a stiff brass wire in the form of a bent lever, carrying upon its horizontal portion *o* a ball *f*, which is movable on a screw thread from end to end of portion *o*. It will be seen, that, as the ball is moved toward the extremity *o*, it increases the weight of the long arm of wire *e*. If the coils

and magnet be charged by the current from the battery, and the current passes from strap *b* to b^1, through the lever *e* and mercury cups, the magnet *a* will attract the hammer piece *g*, and, in so doing, will lift the end of lever *e* out of the mercury in cup *m* and break the circuit, when the armature lever, being drawn back by the retractile force of the weight, will again close the circuit. As the weight *f* is further removed from the centre of vibration, the more magnetic power will be required to move the hammer *g*; its distance from magnet *a* remaining the same, the greater is its retractile force, and the more suddenly and completely will the circuit be broken in cup *m*. The distance between *g* and *a* can be varied by slightly bending the wire *e*." The text of the specification of the original patent is, in the foregoing parts, substantially identical with that of the specification of the reissue, and the drawings of the two are identical. Among the claims of the original patent were the following: "Eleventh. I claim the adjustment of the retractile force of an automatic circuit breaker, substantially as set forth. Twelfth. In combination with such adjustment, I claim adjusting the distance of the hammer or the armature from the pole or poles of the electro-magnet which actuates them, as set forth. Thirteenth. I claim adjusting or regulating the length of vibration of the circuit breaking bar by means of a set screw, or any mechanical equivalent for substantially the same purpose, substantially as herein set forth."

Dr. Page was appointed principal examiner in the United States Patent Office in 1842. It is claimed, that, before that time, and in 1836, 1837 and 1838, he had made some or all of the inventions covered by the patent sued on in this case. Being prevented by statute from obtaining a patent while such examiner, he applied to Congress, in 1845, to remove such disability. Not obtaining such relief, he resigned his office of examiner in 1852. On the 2d of February, 1854, he applied for a patent for what he called "a new and useful machine for administering electricity as a remedial agent." The specification was sworn to February 2d, 1854. Part of

the contents of the file wrapper in that case is an affidavit made by Dr. Page, January 27th, 1854, in which he states "that, some time prior to his appointment as an examiner of patents in the United States Patent Office, he made an invention entitled by him the compound magnet and electrotome, the same consisting chiefly in combining a self-acting electrotome with a compound magnet and helix, and that, sometime after said appointment, upon discovering that said invention was being extensively made and sold, he applied to Congress for authority, by special Act, to take out a patent for said invention, by and with the advice and written recommendation of Hon. H. L. Ellsworth, then Commissioner of Patents, and that said application was refused by Congress; that, as soon as he was able, he resigned his office and took the necessary steps to secure his rights to said invention, and that said invention is now in public and common use, and extensively made and sold, and that he has never consented to such sale or use, nor abandoned said invention to the public." Accompanying said application was a letter from Dr. Page to the Commissioner of Patents, dated January 27th, 1854, in which he said: "Being about to apply for letters patent for the invention set forth in the accompanying affidavit, I beg leave to request that you will authorize the examination of my claims without delay, in view of the facts in the case, but more especially for the reasons, that the invention has been so long in public use without my consent or power to restrain it, and that I have hitherto made application for letters patent for this invention to Congress, the only source from which, under the law, I could expect to get a patent." The drawings accompanying said application do not seem to have been preserved on file, though the record shows that there were two drawings. The specification on the application, as originally filed, said: "Fig. 1 is a perspective view of the machine. Fig. 2 is a bottom view of the base board of the machine, showing the wire connections. Figs. 3, 4, 5, 6 are views of various forms of compound electro-magnets. Figs. 7, 8 exhibit different forms of interrupters or electrotomes.

My invention consists, first, in combining with a helix or helices, inclosing a compound and adjustable electro-magnetic core, a self-acting electro-magnetic electrotome, so that, when said helix or helices are connected with a galvanic battery, the galvanic circuit shall be instantly broken and re-established, and thus continuously and rapidly interrupted and completed without the aid of the operator or mechanical movements, whereby a rapid succession of shocks may be obtained and graduated in a convenient manner for medical purposes. Prior to my invention mechanical interrupters or electrotomes were employed to produce shocks from helices inclosing electro-magnets, and required the services of an attendant, and the size, expense and difficulty of working such machines prevented their use to any considerable extent, but the employment of the self-acting electrotome in combination with the compound electro-magnet reduced the size and expense of the machine, rendered it more simple and efficient, dispensed with the attendant, and thus brought it within the reach of almost every afflicted person requiring the remedial aid of electricity. The helix consists, usually, of two sizes of wire, the layers nearest the magnetic core being of large size, say No. 16, and those exterior to them of fine wire, say No. 20 and upwards. The large wire is to be connected with a galvanic battery, to induce magnetism in the core, and the shocks are obtained by contact with the ends of the fine wire. The helix *a*, thus formed, is secured to a base board by brass straps *b b*, and the extremities of the fine and large wires are led down through suitable holes in the base board for the purpose of making all the necessary connections underneath the board, out of sight, and give a neat appearance to the instrument. The connections through which the galvanic circuit is completed, and the mode of breaking the circuit, are as follows: The positive pole of the battery is to be connected, we will suppose, with a binding screw cup 1. A wire, P, soldered to the lower part of this cup, passes under the base board, to the point p^2, where it rises through the board to connect with one extremity of the large wire of the helix, the other ex-

tremity coming down through the board to connect with wire p^3. The wire p^3 is soldered to the lower part of the pillar 2, and upon the top of this pillar is secured a metallic spring, s, which is in contact with a metallic point upon the lower end of set screw s^2, and by this means in contact with pillar 3, from the lower end of which passes a short wire, p^3, to the extremity, 4, of the wire d, d, surrounding the little electro-magnet e. The other extremity, 5, descending through the board, is connected by a short wire, p^4, with the lower end of binding screw cup 6. The metallic circuit for the battery is thus completed, and the magnet e draws down the armature n attached to the end of spring s, and, breaking the contact between spring s and the point of the set screw s^2, interrupts the galvanic circuit and produces the shock. The force of the spring s renews the contact with the set screw, and the magnet e again acts, and thus we have a series of shocks produced with a rapidity dependent upon the strength of magnet e and the adjustment of spring s by the set screw s^2. The fine wire helix has its extremities connected with cups x, x by wires p^5, p^5. The shocks are obtained by immediate contact of the fingers with the cups x, x, or by other well known modes of communicating shocks. The figs. 3, 4, 5 and 6 represent different forms of compound magnets. The term, compound magnet, was originally applied to a bundle of iron plates, as in fig. 3, or a bundle of wire, as in fig. 4, but, as the scroll of thin plate iron, fig. 5, and an iron bar divided down to its centre, as in fig. 6, act in a similar manner to the bundle of wires or plates, they are termed, also, compound magnets, though they are not so efficient as the two first named. The lower end or tip of the set screw is armed with platinum, and the surface of the spring s, immediately under the set screw, is covered with platinum, in order to preserve a clean surface when the current is broken. The bundle, m, of iron or steel wires is generally inserted loosely in the helix, for the purpose of graduating the shocks, the strength of the shocks depending upon the degree of insertion of the bundle of wires. Figs. 7 and 8 represent two varieties of electrotome, either of which may

be substituted in place of the electrotome or interrupter shown in fig. 1. The drawings, without any special description, will suffice to explain these interrupters to persons skilled in the subject, and full descriptions of both have been hitherto published by me in Silliman's Journal, vol. 35, pages 262 and 267." The claim was in these words: "What I claim as my invention is, combining with a helix or helices inclosing a compound electro-magnet, a self-acting interrupter or electrotome, substantially in the manner herein set forth." The Patent Office, on the 15th of February, 1854, addressed Dr. Page as follows: "In the matter of your application for letters patent for an alleged improvement in magneto-electric machines, it is found you have been anticipated in the device of combining with a helix or helices inclosing a compound electro-magnet, a self-acting interrupter, in the publication of the same thing by Golding Bird, in the London, Edinburgh and Dublin Philosophical Magazine for January, 1838." Dr. Page replied thus, on the 17th of February, 1854: "I have examined the publication of Golding Bird upon which you have rejected my claim, and, if you will take pains to read the whole of his article, you will find that he gives me credit, in so many words, as the first inventor. I, therefore, ask for a reconsideration of the case." He also, on the same date, addressed the Patent Office thus: "As my invention for the medical application of electricity has been for some years in public use, if the Office, in view of the affidavit which I have recently filed, should consider the question of abandonment, I beg leave further to state, that I have, from the first, had in contemplation the making of this application as soon as practicable, and that I have used all reasonable diligence in seeking protection of my rights in relation thereto. I made application for a special patent for this invention to the only tribunal to which I was allowed to go, as soon as I discovered that it was going into public use, and that application, it would seem, might justly be regarded as still pending and entitling me to privileges of protection as well as those who, under the law, make application to the Patent Office. I ask

of the Patent Office as much indulgence as the law gives to inventors and patentees within the pale of the law. An inventor is not debarred his patent by reason of public use for any number of years after his application and before his patent, nor are his acts of consent and allowance called in question if his application lie untouched by him for years. Nor is public use and sale for any number of years within the term of a patent, held to be a bar to the recovery of that which was inadvertently not claimed, though its publication unclaimed in a patent seems to me to approach very near a formal dedication of it to the public. The statute of limitations applies neither to the applicant nor the patentee, in this particular, and, as my case is novel, peculiar and without precedent, I trust the Office will leave this question to be decided by the Courts, and grant my patent, provided no other objection should be found." The Office replied thus, on February 23d, 1854: "Yours of the 17th instant, relating to the matter of your machine for administering medical electricity, has been received, together with an amended claim. The publication made by you, of the subject of this claim, in Silliman's Journal in 1837, anticipates the publication made by Bird, as referred to in the official communication of the 15th instant. The only remaining difficulty in the way of the grant of a patent to you, therefore, so far as the Office is informed, is the fact that the machine has been, for a long course of years, in public use. By the seventh section of the Act of 1836 it is made the duty of the Commissioner of Patents to take cognizance of the case where the invention has been in public use, or on sale, with the applicant's consent and allowance, this being placed on the same footing as the other conditions for refusing a patent. The only modification of this part of the section is that by which a period of two years is allowed for the previous sale or use, as provided in the seventh section of the Act of 1839. In the present case that period has been exceeded many years. The only remaining question, therefore, is, whether the sale and use has been with the applicant's consent and allowance.

In the affidavit made by you on the 27th January, 1854, it is testified that you have never consented to such sale or use, nor abandoned said invention to the public. It is not, however, necessary that the consent should be actually expressed. It may be inferred from the acts of the applicant, and it will be inferred when nothing appears to show that he has properly warned the public, or the parties selling and using, against the sale and use, or that he has taken timely measures to secure a patent for his invention. All that has been adduced to show this, in the present case, is the allegation, that the applicant, from the time he found the invention going into general use, was laboring under a legal disability to procure a patent therefor under the law, in consequence of his official connection with the Patent Office, and that he applied to Congress for a special patent for this invention. But it does not appear that the particular invention now in question was described in the application to Congress, or indicated by any title sufficient to identify it. That application, therefore, cannot be taken as a notification to the public of your intention to reserve to yourself the right to this invention. Neither could it be considered equivalent to an application filed, according to law, in the Patent Office, where a description of the thing is required. It can only be entertained as showing what effort was made to remove the disability which would prevent you from obtaining a patent while holding the office of examiner of patents. If it was proved that the effort thus made had reference to the procuring the patent now applied for, it is allowed it would be worthy of much consideration, and, as it is, the refusal of Congress to grant the petition that was made, may be regarded as enforcing the fact of the disability. But, then, in either case, the disability must be considered as self-imposed, inasmuch as the applicant had it in his power at any time to remove it, by resigning his office. The fact that he retained his office for many years, and declined to take the only course open to him for obtaining a patent, while his invention was going into extensive public use, without any public reclamation by him, must be

considered proof of consent and allowance. This inference that the public sale and use was with the applicant's consent and allowance is, also, much strengthened by the fact that nearly five years elapsed after the first publication in Silliman's Journal, before the legal disability commenced, without any steps being taken to secure a patent, and by the further fact, that, after the disability ended, and notwithstanding the great length of time the invention had been before the public, nearly twenty months more were allowed to pass before the filing his application, making, in all, a period of nearly seventeen years from the time of the first announcement of the invention to the public. For these reasons the patent is refused." On the 28th of July, 1854, Dr. Page addressed the Office as follows: "To the Commissioner of Patents, Sir, I hereby withdraw my application for a patent for machine for administering electricity as a remedial agent, now in your Office, and request that twenty dollars may be refunded to me agreeably to an Act of Congress in such cases made and provided." On the same day the $20 was returned to Dr. Page in person. Subsequently Dr. Page presented to Congress a petition, dated January 16th, 1866, in which he said: "During the years 1836, 1837 and 1838, your petitioner invented a magneto-electric apparatus for administering electricity as a remedy for diseases, and, also, for purposes of scientific illustration, since known under the various names of Page's compound magnet and electrotome, Page's induction coil, Page's separable helices and Page's analysis of shocks, a distinguishing feature of which invention was an automatic or self-operating circuit breaker, by which the presence of an attendant or assistant was dispensed with. Said apparatus also embraced other novel and original features of improvement. In the year 1842 your petitioner was appointed principal examiner in the United States' Patent Office. Some time after said appointment your petitioner discovered that his said invention was being introduced into public use by others without his consent, and, being disabled, under the law, from obtaining a patent, your petitioner, at

the recommendation of Hon. Henry L. Ellsworth, then Commissioner of Patents, in the year 1845, applied to Congress to remove the disability in his case, inasmuch as the invention was made before his said appointment to office. Failing in this to obtain relief, your petitioner, as soon as his circumstances permitted, did, in the year 1852, resign his office, and, as soon thereafter as practicable, February 2d, 1854, applied for a patent for this, his said invention. After a very thorough investigation, the Commissioner of Patents decided that the invention was novel and original with your petitioner, but refused to grant a patent, on the ground of abandonment of the invention to the public. Your petitioner is unwilling to admit that the public use of said invention was with such entire consent and allowance on his part, as in equity to have worked an abandonment against him, as the circumstances were peculiar and extraordinary, and such as have never before occurred to an American inventor, and he, therefore, prays your honorable bodies to remove the disabilities in his case, and enable him again to apply for, and take out, and hold, a patent for this, his said invention, notwithstanding its previous public use. Your petitioner, moreover, states, that, by a recent Act of the Emperor of France, the honor of this, his said invention, has been accredited to M. Ruhmkorff, by an imperial award of fifty thousand francs for the same. (See Silliman's Journal, vol. 39, No. 115, January, 1865.) Thus deprived of all emolument from this, his invention, and robbed of the honor which justly belongs to him, by this Act of a foreign power, your petitioner is prepared to show, by testimony of the highest character, from men of science in this country and in Europe, and by experimental demonstrations before your honorable bodies, that this invention is entirely his own; (see Silliman's Journal, vol. 15, 1853, page 115, foot note by the editors; also, same vol., page 115, foot note by the editors; also, London and Edinburgh Philosophical Magazine, vol. 12, page 22; also, Sturgeon's Annals of Electricity and Magnetism, vol. 1, pages 293, 294, 1837; also, same vol., page 500, 1837; also, Davis' Catalogue,

of 1838; also, Scientific American, vol. 12, No. 1, page 5 vol. 12, No. 5, page 69; vol. 12, No. 15, page 230; also, Silliman's Journal, vol. 35, page 252, 1839; also, Silliman's Journal, vol. 32, pages 355–6, 1836; also, Silliman's Journal, vol. 31, page 141, 1836; from all of which publications verbatim extracts are hereto annexed;) and he, therefore, prays that your honorable bodies will, as an offset to this foreign appropriation of his rights, and in justice to an American inventor, empower him to apply for and take and hold a patent for this, his said, invention, notwithstanding said imperial award, and the aforesaid previous public use, provided the Commissioner of Patents shall be satisfied of his right thereto, as the original and first inventor of the same." Extracts from the publications referred to were annexed to the petition. The Act of March 19th, 1868, was then passed. Under that Act Dr. Page applied, on March 26th, 1868, for the patent which was granted April 14th, 1868. The specification was sworn to March 19th, 1868. In a letter to the Patent Office, dated March 25th, 1868, accompanying the application, Dr. Page said: "In making this application for a patent according to the recent Act of Congress authorizing the same, permit me to say, that, on the original application, filed February 2d, 1854, the claim, as first presented, was rejected on the 15th of February, 1854, upon a publication of Dr. Golding Bird in the London, Edinburgh and Dublin Philosophical Magazine for January, 1838. It so happened, that, in the conclusion of that article, Dr. Bird gave me credit as the first inventor of what he at first supposed was the novelty of his apparatus, viz.: the automatic circuit breaker. Finding, however, that the precise combination which I claimed was used by him before I used the same, I amended my claim, making it much broader than before, striking out the word *compound* electro-magnet, and substituting the word electro-magnet, and also claimed the automatic circuit breaker in connection with a helix or helices. This amendment the examiner accepted, and admitted the claim to be good, but rejected the application on the ground of abandonment.

I have not, therefore, in this application, reiterated the original claim, but have claimed the helix or helices and compound electro-magnet in combination with an automatic circuit breaker in which the length of vibration of the circuit breaking bar is regulated by suitable devices. I have also claimed the combination of the helix or helices and compound electro-magnet with a circuit breaker in which the retractile force of the vibrating or circuit breaking bar is regulated. Both of these features are original with myself, and their introduction distinguishes these claims from the original. The introduction of these and other claims is in accordance with the provisions of the Act of Congress."

The defendant is a corporation, which manufactures and sells telegraph burglar alarms, in which a circuit breaker acts automatically to make and break the circuit, so that, by the movement of an armature to and from an electro-magnet, a bell is rapidly struck by a hammer. The plaintiffs' specification, and figs. 10 and 11 of the drawings, show an arrangement whereby, when the circuit is broken and the magnet ceases to attract the armature, the armature is drawn back or retracted to make the circuit again, by a weight attached to an arm, and adjustable thereon. Such weight overbalances the weight of the armature, and draws it away from the magnet when the circuit is broken. The adjustment of the weight or retractile force is made by moving the weight on a screw-thread cut on the arm. In the defendant's apparatus, the retractile force which acts on the armature, to draw it away from the magnet, is a spiral spring, the tension of which spring is made adjustable, by minute adjustments, which can be made while the apparatus is working and without stopping it. The weight in the plaintiffs' patent has the same extent of adjustable capacity. The defendant's apparatus has the combination of an electro-magnet, an armature, and an adjustable retractor. It also has a set screw, against which the armature strikes when it is withdrawn from the magnet by the retractile force, such set screw being adjustable and regulating the length of the vibration of the armature. It is quite

clear, that the defendant's apparatus infringes the 11th, 12th and 13th claims of the plaintiffs' patent, and the plaintiffs' expert so testifies.

It is contended, for the defendant, that the 11th claim is not infringed because the plaintiffs' weight and the defendant's spring are not mechanical equivalents. In the place in which the two are used, and in view of the service they perform, it is manifest that they are mechanical equivalents. It is also contended, that the object of making the spring adjustable is to ascertain, by using the adjustable functions of the spring, whether the apparatus is in working order originally, and that then the spring is left at the tension fixed upon. But, the defendant makes the apparatus adjustable for some purpose, as to the retractile force, and such adjustability is confessedly availed of, in setting the apparatus for use originally. The words "the adjustment," in the 11th claim, are to be read as meaning the mechanical means of making the adjustment.

It is not really seriously contended that the 12th claim is not infringed.

In regard to the 13th claim, it is contended, that, in the defendant's apparatus, the set screw is set originally at a given point, to determine the extent of the vibration of the armature, and is not afterwards changed. But, the apparatus is made with a set screw which can regulate the length of vibration of the armature, and it is used for that purpose, if used only once. Moreover, the claim is to the set screw, or its mechanical equivalent, so arranged as to be capable of making such regulation, and is a claim to the mechanical means.

The Act of Congress of March 19th, 1868, authorized a renewal of the application made by Dr. Page, February 2d, 1854, to the Patent Office, for a patent, "including therewith his circuit breakers described by him prior to said application." Such application shows the combination of a self-acting electrotome, that is, an automatic circuit breaker, with a compound and adjustable electro-magnetic core and a helix.

The expression, "circuit breakers described by him prior to said application," is to be understood by a reference to the petition to Congress on which the Act was passed. That petition refers to an apparatus invented by Dr. Page in 1836, 1837 and 1838, and states that a distinguishing feature of it was an automatic or self-operating circuit breaker, and that it embraced other novel features. The petition refers to various publications, some of which were descriptions by Dr. Page of circuit breakers invented by him. Those are the circuit breakers intended by the Act; and the word "circuit breakers" there includes such appendages or added instrumentalities, so previously described by Dr. Page, as were calculated to make the circuit breaker more efficient or perfect.

The apparatus which embraces the invention covered by the 11th claim of the plaintiffs' patent is the one shown by fig. 10 of the drawings of the patent. That identical drawing is found on page 258 of volume 35 of Silliman's Journal, published January 12th, 1839, in an article by Dr. Page, commencing on page 252. There is, in the text, on pages 258 and 259, a description of the manner in which the retractile force of the automatic circuit breaker is adjusted, with references to the drawing and to the letters on it, which description is substantially the same as the description, in the plaintiffs' patent, of what is shown by figure 10 of the drawings of the patent. The same description and drawing set forth and show the combination covered by the 12th claim of the plaintiffs' patent, as it is described in that patent.

Figure 1 of the drawings of the application of February 2d, 1854, was, undoubtedly, the same as figure 9 of the drawings of the patent. Such application describes, by references to letters which must have been on such figure 1, the same apparatus, and by substantially the same description, which is described in the patent by references to letters on figure 9 of the drawings of that patent. The 13th claim claims the regulation of the length of vibration of the armature of an electro-magnet by a set screw or its mechanical equivalent for that purpose. The specification of the re-issue says, that

the set screw in figure 9 regulates the proximity of the armature to the magnet. It does so. As the set screw is turned, so as to press down further the spring which carries the armature, the armature is brought nearer to the magnet. Thus its proximity to the magnet is regulated. Such proximity is a different thing from the tension of the spring, and a different thing from the rapidity of the vibrations of the spring. Nothing is claimed, in the 13th claim, as to regulating such tension or such rapidity. It is such tension and such rapidity which are stated in the specification to be regulated only to some extent by the set screw, so that the regulation of them is imperfect. When the proximity of the armature to the magnet is regulated, its length of vibration is regulated, although the consequence of pressing down the spring and bringing the armature nearer to the magnet is, that the attractive force of the magnet on the armature increases more rapidly, as the distance between them is lessened, than the force of the spring increases, and thus the same relation is not maintained between the tension or force of the spring and the attractive force of the magnet on the armature which the spring carries, as the spring and the armature are brought down by the set screw. So, the regulation of the rapidity of vibration of the spring and armature is imperfect. But, the length of vibration of the armature, or the distance from the magnet to which the spring can carry the armature, is regulated; and that is all that the claim deals with. The description in the application of February 2d, 1854, says, that the set screw adjusts the spring, against which it bears, and that the armature is attached to the end of the spring. Of course, it follows, from the construction, that, if the set screw is turned, so as to carry the spring down, the armature will be brought nearer to the magnet, although the description does not state that conclusion. It does state that the rapidity of the vibration of the armature depends on the strength of the magnet and the adjustment of the spring by the set screw. On page 356 of an article by Dr. Page in Silliman's Journal, volume 32, published in July, 1837, is a description and drawing of an auto-

matic circuit breaker, in which there is a metallic wire vibrating between the poles of a horse-shoe magnet, with a thumb screw for regulating the vibrations of the bar, they being made more rapid by bringing down the thumb screw on the bar. This, of course, regulates the length of vibration of the bar, as well as the rapidity of the vibrations. This apparatus is referred to in the specification of the plaintiffs' re-issue, as described in Silliman's Journal, volume 32, pages 355 to 358, and as "consisting of a very small electro magnetic bar, vibrating between the arms of a permanent magnet, the magnet changing its poles at each vibration, the length of vibration of the bar being regulated by a set screw," and as being "a vibrating automatic circuit breaker."

There is no doubt that what is covered by the 13th claim, as described in the specification and shown by fig. 9, can take date from February 2d, 1854, because described in the application of that date. But it cannot take date from the date of the publication in volume 32 of Silliman's Journal, pages 355 to 358. The specification of the re-issue draws, on its face, a clear distinction between an electro-magnetic bar vibrating between the arms of a permanent magnet, which changes its poles at each vibration, and a vibrating armature of soft iron, attracted towards the poles of an electro-magnet, when such magnet is charged, no change of poles being necessary to effect the motion of the armature, and its weight causing it to fall away from the magnet when the circuit is broken. The former is the arrangement in volume 32 of Silliman's Journal, and the latter is that of figure 8 of the patent drawings. The specification states, that into the arrangement shown by figure 8 an adjusting or set screw may be introduced, to regulate the extent of the vibrations of the armature, after the manner of the set screw in the arrangement in volume 32 of Silliman's Journal. The same distinction is drawn in the specification, in reference to the vibrating armature shown in figure 9 of the patent drawings, which is an armature vibrating to and from an electro-magnet, and carried at one end of a horizontal spring, the magnet, when charged, drawing

the armature down and the spring carrying it up and away from the magnet, when the circuit is broken. Then, after thus describing the vibrating automatic circuit breaker, with the electro-magnetic bar, the permanent magnet, and the regulating set screw, and two forms of vibrating armature, such vibrating armature vibrating to and from an electro-magnet, temporarily charged and then losing its power of attraction, on the breaking of the circuit, the 13th claim limits itself studiously to adjusting or regulating the length of vibration of the armature of an electro-magnet. It discards all claim to adjusting or regulating the length of vibration of the bar in the circuit breaker which has a permanent magnet. The specification plainly says, that an electro-magnetic bar vibrating between the arms of a permanent magnet is not a vibrating armature, because it says that a vibrating armature is preferable to an electro-magnetic bar vibrating between the arms of a permanent magnet, for the reason it assigns, that, when the permanent magnet is used, with the electro-magnetic bar, such magnet changes its poles at each vibration, while with the electro-magnet and the vibrating armature no such change of poles occurs, the motion of the vibrating armature being effected by merely intercepting the galvanic current at suitable intervals. It is apparent, therefore, that the patent itself makes the adjusting or regulating the length of vibration of the armature of an electro-magnet by means of a set screw, as set forth in the specification, a different invention from the adjusting or regulating by a set screw the length of vibration of an electro-magnetic bar vibrating between the arms of a permanent magnet. Hence, the date of the description of the latter invention cannot be taken as the date of the description of the former invention. The matter of the 13th claim is patentable under the Act of March 19th, 1868, because it was described in the application of February 2d, 1854, and not because it was described by Dr. Page, in connection with a circuit breaker of his, prior to said application. It is not shown to have been described by him prior to said application.

The novelty of the invention covered by the 11th claim is attacked. A publication in volume 1, page 534, of "Scientific Memoirs," in 1837, in London, edited by Richard Taylor, in regard to an apparatus of Dr. Schulthess, is adduced; also, a publication in volume 6, page 25, of the "Report of the seventh meeting of the British Association for the Advancement of Science," in 1838, in London, in regard to an apparatus of the Reverend J. W. MaGauley. The same two publications are adduced against the novelty of the invention covered by the 12th claim. The defendant has failed to establish by them the defence of want of novelty in the 11th and 12th claims. In the Schulthess apparatus there is no adjustment of the retractile force of an automatic circuit breaker, of any practical utility, none by minute increments and decrements, as in the plaintiffs' and the defendant's apparatuses, and the description gives no evidence of any design to regulate the retractile force so as to accommodate it to varying currents of electricity. The description of the MaGauley apparatus is not so full and explicit as to entitle it to be considered as a description anticipating either the 11th or the 12th claim. At page 532 of the same book, above-mentioned, which contains the description of the Schulthess apparatus, is a description of an apparatus of Professor Botto, which is adduced to affect the novelty of claims 11 and 12. Little need be said about it. The description is too vague and uncertain to entitle it to any weight. The defendant's expert, Mr. Renwick, makes no allusion to it.

The MaGauley description is adduced against the 13th claim, but it is not sufficiently explicit.

There is nothing to affect the novelty of the 11th, 12th or 13th claim, in any of the prior publications introduced in evidence.

The Morse model, with its placard, proves nothing of itself, and there is not a particle of legal evidence as to when it was made or by whom.

The answer of Dr. Page to the 9th interrogatory to him in the suit of French v. Rogers, is of no force. It relates

solely to certain adaptations, made by Professor Morse, to a long or main circuit, for telegraphing purposes. Such is the purport of all the interrogatories.

It is contended, for the defendant, that the Act of March 19th, 1868, is unconstitutional and void. One ground urged is, that, as Dr. Page was, by § 2 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 118,) disqualified, while an employee in the Patent Office, from acquiring an interest in a patent, he necessarily, as a consideration for becoming such employee, dedicated to the public, on becoming such employee, all inventions which he had previously made, and could not, afterwards, reclaim them. The soundness of this proposition cannot be admitted. The second section of the Act of 1836 does not declare that a person taking employment in the Patent Office shall be held to have forfeited, or dedicated to the public thereby, any invention before made by him. It simply prevents him from acquiring an interest in a patent while he remains such employee. But, as soon as his employment ceases, he is in the same position, so far as any effect of the mere fact of his having been in such employment is concerned, as if he had never been in such employment.

It is contended, that the Act of March 19th, 1868, declares only that the patent to be granted "shall be valid notwithstanding said Page's invention may have been described or in use prior" to his application of February, 1854, and does not declare that it shall be valid although Dr. Page might have, before said application, abandoned his inventions to the public, and that, if it did so declare, it would be void. It is urged, that Dr. Page, by withdrawing his application of February, 1854, abandoned his invention to the public. A consideration of all the language of the Act, taken together, shows that Congress intended to say, and said, that Dr. Page should have a patent which should be valid, if he was the first inventor of the inventions in question, notwithstanding all that had taken place in regard to the prior description by Dr. Page of the inventions, and in regard to their use prior to his

former application, and in regard to such former application. The fact of the withdrawal of the application was necessarily known, as it was a public record. That application had been rejected solely on the ground of the use by the public of the invention, with his presumed consent. No other form of abandonment was alleged, and none other is now alleged, except the withdrawal of the first application. Congress has a right to secure to an inventor the exclusive right to his invention for a limited time. It has no right to deprive any person of his property without due process of law. In the Act in question it is provided, that "any person in possession of said apparatus, prior to the date of said patent, shall possess the right to use, and vend to others to use, the said specific apparatus in his possession, without liability to the inventor, patentee, or any other person interested in said invention or patent, therefor." So far as Dr. Page's right to obtain a patent was affected by his presumed consent to the public use of his inventions, or by his withdrawal of his first application, Congress had full power, if he was the first inventor of those inventions, to exercise its sovereign power of waiving any obstacle arising from such consent or from such withdrawal, by exempting Dr. Page from the operation of the general statutory rule. But, neither such consent nor such withdrawal operates to vest in any one a right, as against the patent finally granted to Dr. Page, to use his inventions after the granting of such patent, except to the extent covered by the proviso in the special Act. Neither such consent nor such withdrawal vested in the general public, including the defendant in this suit, any right, which amounted to a right of property, in the sense of the 5th Amendment to the Constitution of the United States, unless there was, in a particular case, a reduction of the inventions to use and practice, by their embodiment in some apparatus, prior to the granting of the patent. Then the apparatus had become property. But, the inchoate right to make an apparatus embodying the inventions, such right being unexercised before the granting of the patent, was not property, in such a sense as to make it

possible to hold, that to forbid the use, after the granting of the patent, of an apparatus made after the granting of the patent, is to deprive its owner of property which was in existence when the patent was granted. The proviso in the special Act fully protects and preserves all that was property when the patent was granted. The defendant does not present any case within the proviso, nor any case, except that of a right claimed, which any other one of the general public might equally have claimed at the time the patent was granted.

The application to be made under the special Act was subject to the same rules as other applications, and the same right to a re-issue existed as in the case of other patents.

All the considerations urged against the validity of the patent and the right of the plaintiffs to recover in this suit have been examined, although some of them may not have been particularly alluded to in the foregoing decision. The result is, that there must be the usual decree for the plaintiffs.

Edward N. Dickerson and *Edward N. Dickerson, Jr.*, for the plaintiffs.

Everett P. Wheeler and *Charles T. Polhamus*, for the defendant.

THE UNION PACIFIC RAILROAD COMPANY

vs.

HENRY S. MCCOMB. IN EQUITY.

A suit brought by a corporation created by an Act of Congress is a suit arising under the laws of the United States, and, as such, is removable into this Court, under § 2 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470.)

(Before BLATCHFORD, J., Southern District of New York, February 21st, 1880.)

BLATCHFORD, J. This is a suit commenced in the Supreme Court of New York, and removed into this Court by the defendant. The plaintiff now moves to remand it to the State Court. The complaint in the suit, put in in the State Court, alleges that the plaintiff is a corporation created by an Act of Congress. The suit is brought for an accounting for certain moneys and securities alleged to belong to the plaintiff, and to have been fraudulently received and converted by the defendant, and for the cancellation of a note alleged to have been wrongfully issued and to have been fraudulently obtained from certain officers of the plaintiff by the defendant and others. The petition for removal states that the plaintiff is a corporation created by an Act of Congress and that the suit and the matters in dispute therein arise under the laws of the United States. The ground on which the motion to remand is based is, that the matters in dispute in the suit "in no wise concern, or are involved in, or are controlled by, any of the laws of the United States, except in so far as the same may be concerned by the fact" that the plaintiff was incorporated by an Act of Congress.

The 2d section of the Act of March, 3d, 1875, (18 *U. S. Stat. at Large*, 470,) provides for the removal of a suit "arising under the Constitution or laws of the United States," by either party to such suit. This enactment is warranted by

the provision of section 2 of article 3 of the Constitution of the United States, that the judicial power of the United States "shall extend to all cases, in law and equity, arising under this Constitution, the laws of the United States," &c. Under the principles laid down in the decision in *Osborn* v. *Bank of the United States*, (9 *Wheaton*, 738, 819,) it must be regarded as settled, that a suit by a corporation created by the United States is a suit arising under the laws of the United States.

The allegations of the petition, above recited, are sufficient to show that the suit arises under a law of the United States. The case is not like that of *Gold Washing Co.* v. *Keyes*, (6 *Otto*, 199.) In that case, the corporation was not one created by an Act of Congress, and the petition for removal, which was made by the corporation and others, did not state facts sufficient to show that the case, which was a suit against the corporation and others, arose under the laws of the United States. In the present suit, the mere allegation that the plaintiff is a corporation created by Act of Congress shows that the suit is one arising under the laws of the United States.

The motion to remand the suit is denied.

Emott, Hammond & Kidder, for the plaintiff.

Francis N. Bangs, for the defendant.

JOHN B. SLAWSON

vs.

THE GRAND STREET, PROSPECT PARK AND FLATBUSH RAILROAD COMPANY. IN EQUITY.

The second claim of re-issued letters patent No. 4,240, granted to John B. Slawson, January 24th, 1871, for an improvement in fare boxes, and extended for seven years from July 28th, 1871, (the original patent having been granted to said Slawson, July 28th, 1857, and re-issued January 24th, 1871,) namely: "2. A fare box, having two compartments, into one of which the fare is first deposited, and temporarily arrested, previously to its being deposited in the other, when the former is provided with openings covered or protected by transparent mediums or devices, so arranged that the passenger can see through one, and the driver or conductor through the other, in the manner substantially as and for the purpose set forth," contains no patentable combination and no invention.

The claim of letters patent No. 121,920, granted to Elijah C. Middleton, assignee of James F. Winchell, December 12th, 1871, for an improvement in fare boxes, namely: "Lighting the interior of a fare box at night, by light obtained from the head-light of the car, thrown by the reflector, I, through an opening, H, in the head lamp box, into the chamber for the temporary detention of the fare for inspection, substantially in the manner and for the purpose set forth," does not involve any invention.

(Before BENEDICT, J., Eastern District of New York, February 26th, 1880.)

BENEDICT, J. This is a suit in equity, brought to recover damages by reason of an alleged infringement by the defendant of two certain patents, owned by the plaintiff. One of these patents was issued to the plaintiff, July 28th, 1857, for an improvement in fare boxes. It was re-issued May 4th, 1858, again re-issued January 24th, 1871, and is now known as re-issue No. 4,240, and was extended for the term of seven years from the 28th day of July, 1871. The other patent sued on is also for an improvement in fare boxes, granted to Elijah C. Middleton, assignee of James F. Winchell, December 12th, 1871 numbered 121,920, and, on the 17th of April,

1873, assigned to the plaintiff. The defendant denies the infringement and also disputes the validity of the patents sued on.

The questions raised in respect to the Slawson patent, No. 4,240, will first be considered. The patent contains two claims, in the following language: "1. A fare box, composed of two compartments, so combined, that the fare, on being deposited through an opening in one of them by the passenger, without the intervention of the driver or conductor, shall be temporarily arrested therein for examination and inspection by the driver or conductor, through an opening therein covered by a transparent medium, and then, when approved of, transferred directly to the second or general receiving compartment, which, as well as the first, is made inaccessible, except by violence, to the driver or other unauthorized person, for the purpose set forth. 2. A fare box, having two compartments, into one of which the fare is first deposited, and temporarily arrested, previously to its being deposited in the other, when the former is provided with openings covered or protected by transparent mediums or devices, so arranged that the passenger can see through one and the driver or conductor through the other, in the manner substantially as and for the purposes set forth." Subsequent to the extension of this patent, and on September 6th, 1877, the patentee filed a disclaimer, in which he sets forth, that, through inadvertence, accident or mistake, the specification or claims of the said letters patent are too broad, including that of which the said patentee was not the first inventor, and thereupon he enters his disclaimer to that part of the claims in said specification which constitutes the first of the claims above set forth. The effect of this disclaimer was to limit the invention to a fare box composed of two compartments, when the compartment into which the fare is first deposited is provided with two windows so arranged that the passengers can see through one and the car driver through the other.

It will be observed, that no claim is made to any particular device by which the fare, when deposited, is temporarily

arrested before passing into the lower compartment, nor to any form of opening in the box, nor to any particular locality for the windows, provided only they are so arranged that the passengers can see through one and the driver through the other. It must also be observed, that the first claim described a fare box similar in all its respects to the fare box described in the second claim, with the single exception, that it contained but one window, so arranged that the driver could see through it. And such a fare box, the disclaimer asserts, was known prior to the plaintiff's invention. It is apparent, therefore, that the only novelty in the plaintiff's invention, as it now stands described in his patent, consists in the additional window, so arranged that a passenger, by looking through it, can see the fare deposited by him. The question, therefore, at once arises, whether the addition of such a window to a known style of fare box having a window arranged so that the driver can see the fare when deposited by the passenger, constitutes an invention, within the meaning of the patent laws.

The view taken in behalf of the plaintiff is, that the claim is for a combination consisting of certain old elements and one new element, namely, the additional window. But, no new result is accomplished by the introduction of the additional window in the fare box. The fare is deposited as before, and reaches its final destination in precisely the same way as before, without acceleration, detention or deviation. The only distinction between the old and the new box is, that, in the old box, the fare, in its passage from the passenger to the lower compartment of the box, passes by one window, while in the plaintiff's box it passes by two windows. This distinction does not constitute a difference in the result. The additional window, it is true, permits the transmission of light through a part of the box where before it could not pass. But, it accomplishes this result without aid from any other part of the machine, and, in so doing, it in no way modifies the operation of any of the other parts. There is, in fact, no joint operation, and the case is one of simple ag-

gregation, not combination. Furthermore, all that the plaintiff did was to duplicate one of the features of the machine. Some convenience doubtless resulted from this duplication, but, the effect produced by the additional window was the same in kind as that produced by the existing window, and accomplished in the same way. There was no patentable matter in the discovery that it would be more convenient to have light transmitted through the box in another place, and I am unable to see that any invention was required to accomplish that result by adding another window.

In order to constitute a patentable combination, the result must be some effect different from the effect of the separate parts, and produced by the combined forces. A new result must arise from the union of the elements of the combination, and not simply from the separate action of each element. So the law has been declared in numerous cases, and no different rule is contended for in this case. The difficulty in this case, as in most cases of this description, is not in regard to the rule of law, but in applying the rule, with proper discrimination, to the facts of the particular case. It is not, therefore, to be expected, in controversies of this character, that any prior adjudged case can be found so similar in its facts as to furnish a direct authority, one way or the other. But, in this instance, there is one prior adjudged case, so very similar to the one in hand, that it may very well be said to compel the conclusion that this patent is void. I refer to the case of *Hailes* v. *Van Wormer*, (20 *Wall.*, 353.) That was the case of a base burning stove having two chambers, in one of which the coal is first placed, and whence it descends to the other and is there consumed. One claim of the patent was for the construction of an "illumination window" in one of the chambers, in combination with certain other designated parts of the stove. The "illumination window" was an opening in the stove, covered with mica. The other parts of the stove were already known in combination, and the Court says: "It is impossible to regard the mere addition of such openings to a stove containing the improvements de-

scribed in the re-issued patent, as the formation of a new combination. It is not invention." In that case, the rest of the stove was old, as, here, the rest of the fare box is conceded by the disclaimer to be old. In that case, as here, the additional element was an opening covered by a transparent medium. In that case, the object of the opening was to enable the coal which passed from the upper to the lower compartment of the stove to be seen through the opening. In this case, the object of the opening is to enable the fares which pass from the upper to the lower compartment of the fare box to be seen through the opening. There, such openings were a well-known device applied to stoves. Here, a similar opening is employed for the same purpose, in the fare box admitted to be old. In this case, therefore, as in that, it must be said, that it is impossible to regard the mere addition of such an opening to a fare box, conceded to be old, as the formation of a new patentable combination. It is not invention.

There remains to consider the second patent upon which the plaintiff relies in his bill. This patent was issued to Elijah C. Middleton, assignee of James F. Winchell, December 12th, 1871, and is also a patent for an improvement in fare boxes. The specification states, that "the improvement relates to the mode of illuminating the interior of a fare box, in street railway cars or other vehicles, when used during the night, and it consists in the construction of the fare box with suitable openings and reflectors, arranged and adapted to receive light from the ordinary head lamp, placed above the fare box." The claim is as follows: "What I claim and desire to secure by letters patent is lighting the interior of a fare box at night, by light obtained from the head lamp of the car, thrown by the reflector, I, through an opening, H, in the head lamp box, into the chamber for the temporary detention of the fare for inspection, substantially in the manner and for the purpose set forth." The contention on the part of the plaintiff is, that this is a claim for a combination of certain old elements, viz., (1) a fare box with an opening at the top, covered by glass or other transparent substance; (2)

the head lamp of a car; (3) a reflector, in such a manner that a part of the light from the head lamp shall be reflected upon the platform of the fare box. Assuming the claim to be for a combination, the only novelty pretended consists in the arranging the fare box, lamp, and reflector in such a manner that light from the lamp will be thrown into the fare box. No invention was required to so arrange these parts. It would not fail to be accomplished by any person of ordinary intelligence and experience, who should attempt it. This patent, therefore, must be held to be void.

The result is, that the bill is dismissed, with costs.

George Gifford, for the plaintiff.

P. S. Crooke, for the defendant.

In the Matter of the Petition of Charles H. Woodbury.

It is proper for the clerk of this Court, instead of certifying the result of a search for liens on the original requisition delivered to him, to file such requisition and give a certificate of the result of the search on another paper.

A charge of 10 cents for filing such requisition is proper.

A charge of 15 cents for each person against whom a search is required to be made is proper, as a compensation for making the search, and for the act of signing the certificate and certifying the result.

A compensation of 15 cents per folio for making the certificate is proper.

No charge for affixing the seal of the Court to the certificate is proper unless it is required.

(Before Blatchford, J., Southern District of New York, March 1st, 1880.)

Blatchford, J. The petition in this case is presented to this Court by an attorney and counsellor of this Court. It sets forth, that the clerk of this Court demands, for searching the records of the Court for judgments, decrees or other instruments constituting a general lien on real estate, and certi-

fying the result of such search, fifteen cents for each person against whom such search is required to be made, and also fifteen cents for each and every folio of such certificate, together with the sum of twenty cents for affixing the seal of the Court to such certificate, when such seal is not required to be affixed; that said clerk is not authorized to demand any fee for the folios of his certificate, or for affixing the seal, unless he is required to do so; that the petitioner left with said clerk, for search and certification, a requisition of which the following is a copy: "The Clerk of the Circuit Court of the United States for the Southern District of New York will please search in his office for judgments and all other liens upon real estate, against Eugene L. Bushe, for ten years last past, and certify the result in writing for Chas. H. Woodbury, 33 Pine street;" that the said clerk proposes to give to the petitioner a certificate of which the following is a copy: "Circuit Court of the United States for the Southern District of New York. I, John I. Davenport, clerk of the Circuit Court of the United States in and for the Southern District of New York, do hereby certify, that I have searched the records of said Court for judgments, decrees and transcripts thereof, against the following named persons, for the period designated herein, viz.: Eugene L. Bushe, for ten years last past, and I do not find remaining or unsatisfied of record any judgment or decree against any of them, except as above set forth. In testimony whereof, I have hereunto set my hand and affixed the seal of said Court, at New York, this day of , A. D. 1879. Seal;" that said clerk will not give said certificate to the petitioner, unless the petitioner will pay him sixty-five cents, as follows: fifteen cents for the name searched against—thirty cents for the certificate, charging at the rate of fifteen cents a folio, there being more than one hundred words including the attestation clause, but not one hundred words excluding the attestation clause—and twenty cents for the seal; that the practice of the former clerks of this Court was to deliver the requisition to the party leaving it with the clerk, with the clerk's certificate thereon, which

consisted of a brief reference to the liens, if any were found, and the words "none others found," or, in case no liens were found, the words "none found," with the name of the clerk or searcher affixed; but that said clerk has introduced the practice of keeping to himself the requisition and delivering a certificate of the character above set forth. On this petition, the petitioner has applied to the Court for an order that the clerk deliver to him the certificate required by him by the said requisition, on the payment of the sum of fifteen cents.

In reply to this petition the clerk makes oath, that, for searching the records of his office for liens upon real estate, the following charges and no others are authorized by him to be made: Filing requisition, 10 cents; for each person searched against, 15 cents; drawing return to requisition, 15 cents per folio; affixing seal, when required, 20 cents; that he believes the authority for charging those fees is contained in section 828 of the Revised Statutes; and that the payment of the fee of twenty cents for affixing the seal of the Court was never exacted from the petitioner, or from any one else, before the return to a requisition would be delivered, but the seal and the charge therefor have been omitted in the case of the petitioner as well as all others who have stated that they did not wish the seal affixed.

The subject of the mode in which the clerk should certify the result of a search by him of the records of the Court for judgments, decrees or other instruments constituting a general lien on real estate, was brought to the attention of the Circuit Judge and the District Judge some time ago, in view of the fact that the clerk of a United States' Court in another District had been sued for damages for making a false certificate in respect to a search for such liens, such certificate being made on the original requisition delivered to the clerk. It had turned out, in that case, that an additional name had been inserted in the requisition after the clerk had returned it with his certificate on it, so as to make it appear that the clerk had searched against such name and had found nothing, when in fact there was a lien of record against such name. Fortunate-

ly, in that case, the clerk had been able to show the fact that the name had been inserted subsequently. But, the danger to which the clerk was exposed, in parting with the original requisition, induced the Judges to advise the clerks of the Circuit and District Courts for this District, that it was proper for them to retain and place on file the original requisition, and to give a certificate in due form, on another paper, of the result of the search, in such manner as to identify the certificate with the requisition. In carrying out this system, three objects must be had in view: (1.) To protect the clerk, who may be responsible in damages for an incorrect search; (2.) To charge no more than legal fees; (3.) To have a uniform system in the two United States' Courts for this District.

The following provisions are found in § 828 of the Revised Statutes, among the fees allowed to the clerks of the two Courts: "For filing and entering every declaration, plea, or other paper, 10 cents." "For entering any return, rule, order, continuance, judgment, decree or recognizance, or drawing any bond, or making any record, certificate, return or report, for each folio," of one hundred words, "fifteen cents." "For affixing the seal of the Court to any instrument, when required, twenty cents." "For searching the records of the Court for judgments, decrees, or other instruments constituting a general lien on real estate, and certifying the result of such search, fifteen cents for each person against whom such search is required to be made."

It is contended, for the petitioner, that the requisition required the clerk to do only that for which, by the foregoing provisions, he was authorized to charge 15 cents; and that the folio provision for making a certificate does not relate to a certificate of the result of a search for liens on real estate, as that is provided for in the charge of 15 cents for each person against whom a search is required to be made.

It is proper that the clerk should file the requisition for a search and charge 10 cents for doing so. This is necessary for the protection of the clerk, and his search is an official act made by him as clerk.

The charge of 15 cents for each person against whom a search is required to be made, authorized for searching and certifying the result of the search, is properly to be regarded as the compensation for making the search and for the official act of the clerk, under his official responsibility, in signing the certificate, and thus fixing his responsibility for certifying the result. The charge of 15 cents per folio for making the certificate is proper, as the service is performed and is necessary. A certificate may, by reason of a large number of names searched against, cover many folios, and there is nothing in the statute which indicates an intention that the charge of 15 cents for each name shall embrace the time and labor and care required in drawing the certificate, as well as the time and labor and care required in making the search, and the responsibility incurred in certifying the result.

Of course, no charge for affixing the seal is lawful, unless it is required, in the particular case, that the clerk shall affix the seal.

These views have been submitted to the District Judge, and I am authorized to say that he concurs in them.

The application of the petitioner is denied.

Charles H. Woodbury, in person.

Joseph M. Deuel, opposed.

WILLIAM B. FORREST

vs.

ALBERT KEELER, WILLIAM H. LAWRENCE AND THE EDWIN FORREST HOME.

In an action of ejectment, in a State Court, against three defendants, two of them, being citizens of New York, made default. The third answered, and the cause was at issue. More than 10 months afterwards, the third, being a citizen of Pennsylvania, petitioned for the removal of the cause into this Court. The plaintiff was a citizen of Massachusetts: *Held*,

(1.) The removal was not one provided for by subdivision 2 of § 639 of the Revised Statutes, because the plaintiff was not a citizen of New York;

(2.) The removal was not applied for in time, under § 3 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 471,) because several terms of the State Court had been held, after the joining of issue, at which the cause could have been tried, if noticed for trial by the defendant, and there was no obstacle to its being so noticed, although the petition was filed before the commencement of the term for which the cause was first noticed for trial.

(Before BLATCHFORD, J., Southern District of New York, March 8th, 1880.)

BLATCHFORD, J. This is an action of ejectment, brought in the Supreme Court of New York, to recover possession of a piece of land in the city of Yonkers. The complaint put in in the State Court alleges seizin and possession in fee by the plaintiff, and ejection of the plaintiff and withholding of possession from him by the defendants, and demands judgment that the plaintiff has an estate in fee in the premises, and that he recover possession thereof, and his damages for the withholding thereof. The Edwin Forrest Home answered denying the allegations of the complaint. The other two defendants did not appear or answer, and were in default for want of an answer, on the 23d of January, 1878. The answer of the Edwin Forrest Home was put in on that day. The cause was at issue as to the Edwin Forrest Home on that day. Subsequently, and on the 9th of December, 1879, the Edwin

Forrest Home filed in the State Court a petition, setting forth, among other things, that the plaintiff was, at the commencement of the suit, and is, a citizen of the State of Massachusetts, and that the Edwin Forrest Home was, at the commencement of the suit, and is, a corporation created by the State of Pennsylvania, and a citizen of that State; that "this is a suit in which there can be a full and final determination of the controversy between the plaintiff and your petitioners, the Edwin Forrest Home, without the presence of the other defendants as parties in the cause;" that the defendants Keeler and Lawrence were, at the commencement of the suit, and are, both of them, citizens of the State of New York; that both of them are in default for not answering the complaint; and that the petition "is made and presented before or at the term at which said cause could first be tried, and before the trial thereof." The prayer of the petition is, that the suit, "so far as concerns your petitioners, the said the Edwin Forrest Home, be removed into the Circuit Court of the United States for the Southern District of New York." On the petition and a bond, the State Court entered an order, on the 9th of December, 1879, accepting the petition and the bond, and ordering "that this action, so far as concerns the said defendants the Edwin Forrest Home, be, and the same hereby is, removed for trial from this Court into the next Circuit Court of the United States to be held in and for the Southern District of New York, in the Second Circuit, and that this Court proceed no further therein."

The removal in this case is not one provided for by subdivision 2 of § 639 of the Revised Statutes of the United States, because the plaintiff is not a citizen of New York. The removal must, therefore, be upheld, if at all, under the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470.)

The plaintiff moves to remand the cause to the State Court, on the ground that the removal was not applied for in time, under § 3 of the Act of 1875, which requires that the application shall be made "before or at the term at which said cause could be first tried, and before the trial thereof."

It is provided, by § 977 of the Code of Procedure of New York, that, at any time after the joinder of issue, and at least fourteen days before the commencement of the term, either party may serve a notice of trial; that, at least twelve days before the commencement of the term, the party serving the notice must file with the clerk a note of issue; and that the clerk must thereupon enter the cause upon the calendar, according to the date of the issue. It is provided, by § 980 of the same Code, that either party who has served the notice may bring the issue to trial, and proceed in the absence of the adverse party. The place of trial of this action was the county of Westchester, and the place of trial of the issues in it was a Circuit Court, to be held in that county. The plaintiff shows, that, after the joining of such issue and prior to such order for removal, Circuit Courts were held in said county of Westchester, commencing one March 3d, 1878, one June 3d, 1878, one September 16th, 1878, one December 9th, 1878, one March 3d, 1879, one June 2d, 1879, and one September 15th, 1879. The defendant shows, that, since issue was joined, the plaintiff has procured seven commissions to six different places, to examine witnesses, the last of which was procured November 12th, 1879; that none of them have been returned; that the suit was noticed for trial for the first time for a term of Court commencing December 15th, 1879; and that it was never before noticed for trial or placed on the calendar of the Court for trial.

The plaintiff contends, that, as either party could have noticed the cause for trial at any one of the terms named, and as there was no legal obstacle to the noticing of the cause by the defendant, and no stay of proceedings in the orders for commissions, or otherwise, the removal is too late. The defendant contends, that, as the cause could not be tried, under the statute of New York, until it was in fact noticed for trial and placed upon the calendar, the removal was in time.

The defendant cites the case of *Warner* v. *The Pennsylvania R. R. Co.*, (13 *Blatchf. C. C. R.*, 231.) But, in that case, there were stays of proceedings, which prevented a trial.

In *Pettilon* v. *Noble*, (7 *Bissell*, 449,) cited by the defendant, it would appear that the issue was not a triable issue, after the reversal, until the defendant had notice that the plaintiff desired the issue to be re-instated as a triable issue. This is a different provision from that of the Code of New York.

The intent of the Act of 1875 is plainly to require prompt action on the part of a party desiring to remove a cause. Under the Act of September 24th, 1789, § 12, (1 *U. S. Stat. at Large*, 79,) as embodied in § 639 of the Revised Statutes, it was necessary to apply for the removal at the time of entering an appearance in the State Court. Under the Acts of July 27th, 1866, and March 2d, 1867, (14 *Id.*, 306, 558,) as embodied in the same section of the Revised Statutes, the application could be made at any time before the trial or final hearing of the suit. Under the Act of 1875 the application must be made not only before the trial of the cause, but before or at the term at which it "could be first tried."

In *Knowlton* v. *Congress & Empire Spring Co.*, (13 *Blatchf. C. C. R.*, 170,) the plaintiff removed the cause and the defendants moved to remand it. It was held, that where either party could notice the cause for trial at a term, that term must be considered the term at which the cause could be first tried. In *Stough* v. *Hatch*, (16 *Blatchf. C. C. R.*, 233,) the cause was noticed for trial by the plaintiff and placed on the calendar, but not tried, both parties having consented that it go off for the term. The defendant then removed it and the plaintiff moved to remand it. The motion was granted on the ground that the term in question was the term at which the cause could be first tried, and that the want of preparation of the parties and their consent could not affect the question. A practically mutual consent not to put a cause on the calendar, would seem to amount to the same thing as a consent to have a cause go over the term. In *Gurnee* v. *The County of Brunswick*, (1 *Hughes*, 270, 277,) Chief Justice Waite says, in reference to the statute in question: "A cause cannot be tried until in some form an issue has been made up for trial. The pleadings or statements

necessary to make the issue are regulated by the practice in the Court where the trial is to be had. As soon as the issue is made up the cause is ready for trial. The parties and the Court may not be ready, but the cause is. The first term, therefore, at which a case can be tried is the first term at which there is an issue for trial. An application for removal, to be in time, must be made before or at this term." In *Ames* v. *Colorado Central R. R. Co.*, (4 *Dillon*, 260, 263,) it is said, that the term referred to in the Act of 1875 "appears to be that at which the cause may be heard or tried on the merits, according to the practice of the Court, without regard to the special circumstances of the case, as whether the parties are ready for trial and the like." In *Fulton* v. *Golden*, (9 *Central Law Journal*, 286,) it was held, that a removal was too late where, an equity cause being at issue, on answer and replication, and the practice allowing either party to notice it and bring it to hearing, and where, under the practice, the testimony could have been taken and the cause noticed for hearing in eight months from the issue, neither party had moved in it, and eight terms had elapsed before the petition for removal was filed.

Although the plaintiff in the present case did not notice the case for trial at an earlier term, the defendant could have done so. The plaintiff had a right to regard the defendant as having waived his right to remove the cause, when, in the absence of any stay, the defendant did not remove the cause before or at the first term at which, the cause being at issue and triable on the merits, the defendant might have noticed it for trial. The proper construction of the statute is such as to make it necessary to hold that the removal in this case was too late.

Points are raised by the plaintiff as to the value of the land sued for, and as to whether the petition for removal, not being framed to remove the whole suit, is of any avail under the Act of 1875, and as to whether the petition makes out a case for removal under the Act of 1875, and as to whether the suit is one removable in whole, or in part,

on the petition of the petitioning defendant alone, under that Act. It is not necessary to pass on those points.

The motion to remand is granted.

John Townshend, for the plaintiff.

Robert W. De Forest, for the defendant.

JOHN A. RUMSEY

vs.

THE PHŒNIX INSURANCE COMPANY.

A party in possession of insured premises under a valid subsisting contract of purchase, is the equitable owner, and has an insurable interest, although he has not paid the whole consideration money; and he is not guilty of a misrepresentation if he represents the premises as his, when he applies for insurance.

Where such a party, in applying for insurance, states that he wishes his house insured, without stating specifically the nature of his interest he does not omit to make known a fact material to the risk.

A letting of an insured house to tenants is not a change of possession.

The receiving and returning proofs of loss, and repudiating all liability on the policy to the person entitled to demand payment, is a waiver of any imperfections in such proofs.

(Before WALLACE, J., Northern District of New York, March 8th, 1880.)

WALLACE, J. The policy upon which this action was brought insured the dwelling house of one Zimmer, and the loss was, by the terms of the policy, payable to the plaintiff, "as his interest may appear." The policy contains the following conditions: "Any false representation by the assured of the condition, situation or occupancy of the property, or

any omission to make known every fact material to the risk, or an over-valuation or any misrepresentation whatever, either in a written application or otherwise; or, if the property be sold or transferred, or any change take place in title or possession, whether by legal process, judicial decree, voluntary transfer or conveyance; or, if the assured is not the unconditional and sole owner of the property; or, if the interest of the assured in the property, whether as owner, trustee, consignee, factor, mortgagee, lessee, or otherwise, is not truly stated in this policy; then, and in every such case, this policy shall be void."

After the policy was issued, and before the loss, Zimmer failed to make payments according to his contract with the plaintiff, and moved out of the dwelling. The dwelling was thereafter occupied by tenants. The question of fact was submitted to the jury, whether Zimmer had surrendered or abandoned his contract to the plaintiff, with instructions, that, if there had been such surrender or abandonment, the plaintiff could not recover. The jury found there had been no surrender or abandonment, and, by implication, that the tenants who occupied the premises were Zimmer's tenants. A verdict having been found for the plaintiff, the defendant now moves for a new trial.

It is insisted, for the defendant, that the policy is void, because Zimmer was simply a vendee in possession of the premises, under an executory contract to purchase of the plaintiff, when the policy issued, and, therefore, "not the unconditional and sole owner of the property," within the condition of the policy. It is, also, insisted, that, because Zimmer stated to the defendant's agent, at the time of applying for the insurance, that he "wished his house on Porter street insured," without stating specifically the nature of his interest, there was an "omission to make known every fact material to the risk," within the conditions which render the policy void. These objections to the plaintiff's right to recover may be considered together, and may be disposed of by the answer, that Zimmer was the equitable owner of the

property, and was the unconditional owner, except as to the plaintiff, and the plaintiff's interest was sufficiently indicated by notice that he had such an interest in the premises that the loss would be payable to him.

A party in possession of insured premises under a valid subsisting contract of purchase is the equitable owner, and has an insurable interest, although he has not paid the whole consideration money. He is not guilty of a misrepresentation if he represents the house as *his*, when he applies for insurance, and there is no breach of warranty if the house is described as "his dwelling house," in the policy.

The statement and the state of facts are consistent with each other. There is no misrepresentation, because an intent to deceive cannot be inferred. There is no breach of warranty, because the representation is true in substance. (*Strong* v. *Manfrs. Ins. Co.*, 10 *Pick.*, 40; *Ætna Fire Ins. Co.* v. *Tyler*, 16 *Wend.*, 385; *Davis* v. *Quincy Mutual Fire Ins. Co.*, 10 *Allen*, 113; *Niblo* v. *North American Ins. Co.*, 1 *Sandf. S. C. R.*, 551; *Ludlow* v. *Liverpool, &c., Ins. Co.*, 13 *Grant's Ch. R.*, 377.)

It was not incumbent upon Zimmer to make a fuller disclosure of his interest in the premises, when he applied for insurance. His failure to do so was not "omission to make known" a "fact material to the risk," within the meaning of the policy. This clause in the policy is to be read with the other clauses of which it forms part, and, applying the maxim *noscitur a sociis*, the word "omission" is equivalent to "concealment," in the contemplation of the policy. The cases cited are authorities to the effect, that, in view of Zimmer's interest, as equitable owner of the premises, in the absence of specific inquiry, he communicated all that was material to the risk, and was not bound to specify the precise extent or nature of his interest.

The fact that Zimmer moved out of the dwelling house and let it to tenants is not a defence, within the condition that avoids the policy "if any change take place in title or possession." The change of possession contemplated is some-

thing more than a change of occupation. It is a change effected "by legal process, judicial decree, voluntary transfer, or conveyance"—one which refers to his possessory right and not to the occupancy of the insured premises. The possession of Zimmer's tenants was his possession, within the meaning of the policy.

Finally, it is insisted for the defendant, that the plaintiff should be defeated because the proofs of loss were made and verified by him, and not by Zimmer, and, inasmuch as the policy requires the proofs to be made by the insured, a condition precedent to a cause of action on the policy has not been complied with. It is a sufficient answer to this position, that the defendant received and retained the proofs of loss served by the plaintiff, at the same time repudiating all liability upon the policy, upon the ground that Zimmer had no interest in the premises at the time of the fire. The plaintiff was the person to whom the whole loss was payable, by the terms of the policy, and the proper party to bring an action to recover it. By repudiating any liability, under the policy, to the person entitled to demand payment, the defendant waived any imperfections in the preliminary proofs. (*Angell on Insurance*, § 244.)

G. Wilcoxen, for the plaintiff.

E. Newcomb, for the defendant.

THE ATLANTIC GIANT POWDER COMPANY

vs.

THE DITTMAR POWDER MANUFACTURING COMPANY AND OTHERS.
IN EQUITY.

The decision in *Atlantic Giant Powder Co.* v. *Rand* and *The Same* v. *Parker*, (16 *Blatchf. C. C. R.*, 250, 281,) that the re-issued letters patent No. 5,799, granted to the Giant Powder Company, March 17th, 1874, for an improved explosive compound, the original patent having been granted to Julius Bandmann, as assignee of Alfred Nobel, the inventor, as No. 78,317, May 26th, 1868, are valid, confirmed.

A powder which, in 100 parts by weight, contains nitro-glycerine 67.64 parts, cellulose, (paper stock,) 16.82, and saltpetre, (nitrate of soda,) 15.54, and a powder which, in 100 parts by weight, contains nitro-glycerine 27.86 parts, sawdust and charcoal, in nearly equal proportions, 5.59, and saltpetre, (nitrate of soda,) 66.55, are infringements of said re-issue.

The said re-issue is not invalid, as being for a different invention from that set forth in the original patent.

It is not invalid on the ground that Nobel, the inventor, obtained from one Dittmar the knowledge of what is claimed in it.

What is claimed in it was not first invented by Dittmar.

The question of Dittmar's invention of it considered in view of the fact that, in former litigations, he was silent about his having invented it, although he made an affidavit, in a former suit on the said re-issue, the only purport of which was to show that the said re-issue was void for want of novelty.

The plaintiff held not to have deprived itself, by any conduct towards Dittmar, of the right to ask for a preliminary injunction against the defendant.

(Before BLATCHFORD, J., Southern District of New York, March 13th, 1880.)

BLATCHFORD, J. This is an application for a preliminary injunction, founded on re-issued letters patent No. 5,799, granted to The Giant Powder Company, March 17th, 1874, the original patent having been granted to Julius Bandmann, as assignee of Alfred Nobel, the inventor, as No. 78,317, May 26th, 1868, being the same re-issued patent which was before this Court in the case of the same plaintiff against Rand, and

in the case of the same plaintiff against Parker, both of them decided May 5th, 1879. (16 *Blatchf. C. C. R.*, 250, 281.)

The specific samples of powder complained of were sold by the defendant the Dittmar Powder Manufacturing Company, through the defendant Carl Dittmar, and are two in number, No. 1 and No. 2. Dr. Hayes testifies, that, by analysis, 100 parts by weight of No. 1 contains, nitro-glycerine 67.64 parts, cellulose (paper stock) 16.82, saltpetre (nitrate of soda) 15.54; that, by analysis, 100 parts by weight of No. 2 contains nitro-glycerine 27.86 parts, sawdust and charcoal, in nearly equal proportions, 5.59, saltpetre (nitrate of soda) 66.55; that, in his opinion, the solid ingredients found in each of said analyses constitute together an absorbent substance which is an equivalent of the infusorial earth specifically mentioned in the plaintiff's patent; that the powders so examined by him are each a combination of nitro-glycerine with such absorbent substance in substantially the same manner as the combination of nitro-glycerine and infusorial earth specifically mentioned in said patent; that the said solid ingredients have the property of absorbing, and retaining by absorption, nitro-glycerine, and are free from any quality which will cause them to decompose, destroy or injure nitro-glycerine; that the nitro-glycerine is combined with them in such proportions as to be retained without liability to separation by compression or leakage; that the said solid ingredients are not liable to explode by concussion, as nitro-glycerine is; that the entire combinations constitute, in his opinion, "safety powders," which can undergo the ordinary shocks of transportation and manipulation without explosion; that the nitro-glycerine therein is explosible, in blasting operations, by the means ordinarily employed for exploding nitro-glycerine; that, while the mixture is in the form of a powder, the nitro-glycerine remains, in his opinion, so compact and concentrated as to have its original explosive power; and that the cellulose or paper stock ("pulp") and the sawdust, in said mixtures, perform the same function as charcoal or carbon, both as to absorption of the nitro-glycerine and as

to combustion by the heat of the explosion of the nitro-glycerine, and they perform it in the same way and they perform no other function. In the Rand case, the defendants' powder contained, nitro-glycerine 34.71 parts; nitrate of potash 52.68 parts; sulphur 5.84 parts; woody fibre, charcoal and resin, in nearly equal proportions, 5.77 parts. In the Parker case, the defendants' powder contained, nitrate of soda 56 parts; charcoal 14 parts; nitro-glycerine 30 parts. In the Goodyear case, before Judge Shepley, the defendants' powder contained, nitro-glycerine 32.60 parts; nitrate of soda 49.46 parts; charcoal 9.63 parts; sulphur 8.31 parts. All of these powders were held to be infringements of the plaintiff's patent. What Dr. Hayes testifies, as above set forth, in regard to the powders in the present case, shows that they must, for the reasons given in the Rand, Parker and Goodyear cases, be held to be infringements of said patent, unless certain matters presented by the defendants in this case shall be sufficient to lead to a different conclusion.

The defendants contend that the only powder they make or sell is one called "Dualin," made in accordance with a patent granted to the defendant Dittmar, January 18th, 1870. They urge the following propositions: (1.) That, in view of matters now presented, the plaintiff's re-issued patent, in omitting the word "inexplosive," in discarding the concentration feature of the original patent, and in altering and adding other clauses not contained in the original patent, is broader than the original and void; (2.) That, on the evidence now presented, the Dittmar patent is the first valid and subsisting patent for nitro-glycerine safety powder combinations, composed of nitro-glycerine absorbed in some combustible or explosive, as distinguished from inexplosive, substance, and that the plaintiff's re-issue should be limited strictly to what is contained within the plain reading of the description of the original patent; (3.) That Dittmar was the original and first inventor of the mixture of nitro-glycerine with some porous solid, as distinguished from fluid or liquid, substance, in such proportions as to render the resulting com-

pound a powder safe against the usual shocks of transportation and use, and, therefore, the original and first inventor of the compositions claimed in Nobel's original patent and in the plaintiff's re-issue; that Nobel fraudulently and surreptitiously purloined his invention; and that the original and the re-issue are void; (4.) That the conduct of the plaintiff, and its proceedings heretofore, with respect to its litigations and to Dittmar, have not been such as to justify the application for an injunction at this stage of the suit.

The question of the difference between the original and the re-issue in respect to the concentration feature and in the omission from the re-issue of the word "inexplosive," found in the original, in reference to the absorbent substance, was considered and passed upon in the decision of this Court in the Rand case, favorably to the plaintiff, and the latter point was considered and passed upon in the same way by Judge Shepley in the Goodyear case. In the present case, it is contended, for the defendant, that extrinsic evidence, not in the former cases, is introduced, as to the state of the art of manufacturing explosive compounds in 1867 and 1868, and as to the use of the word "inexplosive" in that art, which has the effect of showing that the word "inexplosive" was used in the original patent, No. 78,317, in its literal and ordinary sense, and not in the special sense of a substance not liable to explode by accidental concussion. Reference is made to Nobel's provisional English specification, filed May 7th, 1867, which speaks of mixing nitro-glycerine with "porous, inexplosive substances, such, for instance, as charcoal and silica, and to his full English specification, filed on November 6th, 1867, (both of such specifications pertaining to a patent for an invention communicated by Nobel, dated May 7th, 1867,) which speaks of causing nitro-glycerine to be "absorbed in porous, inexplosive substances, such as charcoal, paper, silica or similar materials, whereby it is converted into a powder which I call dynamite or Nobel's safety powder." Reference is also made to the fact that the specification of No. 78,317 states that "porous charcoal has, also, a considerable absorbent capa-

city, but it has the defect of being itself a combustible material." Reference is also made to the specification of a patent granted by the United States to the plaintiff and The Giant Powder Company, No. 141,455, August 5th, 1873, applied for June 4th, 1873, the specification being signed by Nobel, which says: "I have, in former specifications, on which letters patent have been granted to me, described the use and effect of the mixing of nitro-glycerine with other explosives, such as gunpowder, gun cotton, &c., and also the mixing of nitro-glycerine with non-explosive substances capable of absorbing the nitro-glycerine, and have described the advantages obtained from such mixtures in greatly increasing the explosive power of such explosives, and in doing away with the extreme danger of handling nitro-glycerine in a liquid condition and the facilitating of its use for blasting purposes." The specification then sets forth and claims an explosive compound made by mixing nitro-glycerine with a pulverized nitrate, like nitrate of soda, or its equivalent, and a pulverized carbon or hydro-carbon, like resin, or its equivalent, with or without pulverized sulphur, the compound being one which may be handled with safety, and will, when not under strong restraint, burn, on the application of fire, without explosion, but may be exploded by detonation. From these references it is contended that the word "inexplosive" was used in the original patent, No. 78,317, not in the sense of a substance that would not explode by accidental concussion, but in the sense of a substance absolutely inexplosive. It is not perceived that the conclusion sought to be drawn from the premises is a sound one, as applied to the real subject-matter of the invention of Nobel, as to be gathered from the description in the patent No. 78,317. The views of this Court on the subject were fully set forth in its decision in the Rand case, being the same views contained in the decision of Judge Shepley in the Goodyear case, quoted with approval in the Rand case, and it is not necessary to restate them. They are not affected by anything now presented, nor by what is contained in the

affidavit of Mr. Parker, or the circular of the plaintiffs agents, or the scientific books adduced, as to the technical meaning of the words "explosive" and "inexplosive."

The principal defence in this case is made on the alleged ground that Dittmar invented what is claimed in re-issue No. 5,799, and that Nobel obtained the knowledge of it from Dittmar. Letters patent of Great Britain, dated May 7th, 1867, and sealed October 15th, 1867, were granted to one Newton, for "improvements in explosive compounds and in the means of igniting the same," being "a communication from abroad, by Alfred Nobel, of Rue St. Sebastien, Paris, in the Empire of France." The provisional specification was filed on the 7th of May, 1867. It read thus: "This invention relates to a method of modifying the nature of nitro-glycerine in a manner which renders it much safer for use than heretofore. Nitro-glycerine, if mixed with porous, inexplosive substances, such, for instance, as charcoal or silica, becomes very much altered in its properties. Thus, for instance, nitro-glycerine alone is not inflammable by a spark, but may be got to explode by submitting it to a very rapid shower of sparks. Nitro-glycerine absorbed in porous substances, on the other hand, easily catches fire from a spark, and burns away slowly and without explosion, except under very close and resisting confinement, when a violent explosion ensues. Against shocks or blows, the above mixture is far less sensitive than nitro-glycerine alone. Owing to the aforesaid properties of the mixture described, its use for blasting metal or very sound rock requires no other firing than an ordinary safety fuse. In shattered rock or coal, on the other hand, it will cause no real explosion at all, the gas will leak out through the crevices and prevent a great accumulation of pressure from the explosive medium, which alone can determine the detonation of nitro-glycerine when absorbed in porous substances, such as, for instance, charcoal or silica. For this reason, a special igniter is used to explode the above mixture in fissured or shaky rocks, or wherever it is to be used without close confinement. That special igniter consists of a kind

of percussion cap, wherein the fulminate is caused to develop a very high gaseous pressure before it bursts, which may be obtained either by increasing the charge of fulminate or diminishing the leakage of gas before the cap bursts. This cap is adapted to the end of a safety fuse, whereby it is ignited." The full specification of this patent was filed on the 6th of November, 1867. It read thus: "This invention relates to the use of nitro-glycerine in an altered condition, which renders it far more practical and safe for use. The altered condition of the nitro-glycerine is effected by causing it to be absorbed in porous inexplosive substances, such as charcoal, silica, paper, or other similar materials, whereby it is converted into a powder, which I call dynamite or Nobel's safety powder. By this absorption of the nitro-glycerine in some porous substance, it acquires the property of being, in a high degree, insensible to shocks, and it can also be burned over fire without exploding. The aforesaid safety powder, or dynamite, is exploded, first, when under very close and resisting confinement, by means of a spark, or any mode of ignition used for firing ordinary gunpowder; second, without or during confinement, by means of a special fulminating cap, containing a strong charge of fulminate, which is adapted to the end of a fuse, and is strongly squeezed to the latter, for the purpose of more effectually confining the charge, so as thereby to heighten the effect of the detonation; third, by means of an additional charge of ordinary gunpowder, the explosion of the latter will cause the dynamite to go off, even when it is only partially confined. From the aforesaid it will be understood, that a strong fulminating cap, if adapted to the fuse by being squeezed thereon, will cause dynamite to explode under all conditions of confinement or non-confinement, and that an additional charge of gunpowder or analogous substance will cause dynamite to explode only when confined or partially confined, and that any ordinary mode of ignition, as used for gunpowder, for instance, a fuse, will determine the explosion of dynamite only under very close and resisting confinement. It is evident that the above described fulminating cap may

be greatly varied in form, but the principle of its action lies in the sudden development of a very intense pressure or shock. In order to insure a perfect stability in the nitro-glycerine contained in the dynamite, the porous substance, before it is saturated with nitro-glycerine, is to be rendered alkaline, by washing it with a solution of carbonate of soda, lime water, or analogous substance, in order to neutralize the acid and prevent any decomposition of nitro-glycerine from taking place. I would here remark, that the above described safety powder, or dynamite, being nitro-glycerine absorbed in porous non-explosive substances, possesses many distinct properties from, and very great practical advantages over, liquid nitro-glycerine, and its explosion, except under very close and resisting confinement, requires a special ignition, as described above." The claim is: "The mode herein set forth of manufacturing the safety powder, or dynamite, herein described, and also the modes of firing the same by special ignition, as herein set forth." This English patent was the precursor of the patent No. 78,317. The story of Dittmar, as told by him, is this: Before the end of 1865, at Bomlitz, near Walsrode, in Hanover, he experimented in mixing nitro-glycerine with nitro-cellulose, which was sawdust or wood fibre treated with nitric acid or nitric and sulphuric acids, and in mixing nitro-glycerine with sawdust first treated with solutions of saltpetre and alkali. He conceived the idea that nitro-glycerine might be changed into a powder, so as to be a safe and efficient explosive. In July, 1866, at Berlin, Theodore Winckler, one of the firm of Alfred Nobel & Co., a firm composed of Nobel, Winckler, and Dr. Bandmann, employed him to ascertain the causes of the accidental explosion of liquid nitro-glycerine packed in sawdust. He spoke to Winckler of his idea of changing liquid nitro-glycerine into a powder. He then supervised the erection of a nitro-glycerine factory for Nobel & Co., at Krummel, in Lauenberg, and remained there, as its general superintendent, until the fall of 1867. Nobel returned to Krummel, from the United States, in September, 1866. In August, 1866, Dittmar experimented unsuccessfully in mix-

ing nitro-glycerine with lampblack. He also experimented with ground bricks, charcoal, cement, and, lastly, infusorial earth, as absorbents for nitro-glycerine, continuing his experiments with sawdust and nitro-cellulose, and concluded that charcoal and infusorial earth were the best absorbents, the latter being preferable on account of its greater capacity of absorption. His attention was directed to infusorial earth as an absorbent, because it was used at Nobel & Co.'s factory, in substitution for sawdust, to pack around the cans of liquid nitro-glycerine in boxes. He noticed that it was very porous, and readily absorbed the nitro-glycerine when the cans leaked. The particular experiments made by him with nitro-glycerine in combination with infusorial earth, as an absorbent, were made about the time Nobel returned, but whether before, or immediately after, he cannot remember. He did, however, make mixtures of nitro-glycerine with incombustible and inexplosive substances, as absorbents, long prior to the return of Nobel from the United States. Dittmar says: "Alfred Nobel returned in about the beginning of September, 1866. He came to the factory and had many conversations with me in respect of the mixture of nitro-glycerine with absorbent substances. I had these conversations both with him and with Mr. Winckler in his, Nobel's, presence. Nobel desired me to manufacture nitro-glycerine, and, for the purpose of rendering it safe, to pour wood spirits or wood naphtha into the nitro-glycerine, and this I did, making large quantities of this mixture. Nobel insisted that this was the only safe mixture, and claimed that nitro-glycerine, to be rendered safe, must be retained in its liquid condition. He would not listen to representations I made to him that I was convinced, and such conviction had been verified by long and careful experiment, that nitro-glycerine, absorbed by some solid substance cleansed of all impurities that would decompose it, would, in powder form, be a useful, efficient and safe explosive, and, when I told him of my experiments with sawdust, he ridiculed them and my projects as well, and insisted that I should refrain from making any such mixtures

for the future, stating that it was all nonsense, that nitro-glycerine must be retained in its liquid form, that the admixture with wood spirits was the only safe one, and that any admixture with, or absorption of nitro-glycerine by, a solid substance, rendered it even more dangerous than if left in its natural, *i. e.*, liquid condition." Dittmar continued his experiments, mixing nitro-glycerine with inexplosive, incombustible substances, principally with infusorial earth. He did not explode them in any drill or rock holes, but fired them by means of a copper shell or cap with fuse attached, the shell being charged with a strong fulminate and placed upon the mixture to be fired. The fuse exploding the fulminate, the jar caused thereby detonated the charge. Nobel often saw the compounds Dittmar was experimenting upon, and the mixtures he was making, and Dittmar often, about the beginning of September, 1866, conversed with Nobel upon the subject of those experiments, the materials he was using, and the purposes he was seeking to attain. After Dittmar had perfected some of his first experimental mixtures of charcoal and nitro-glycerine, Winckler tried them at the mines and reported favorably on them, and then, for the first time, Nobel evinced some interest in Dittmar's experiments. Dittmar built a furnace and experimented with infusorial earth in quantities, mixed with nitro-glycerine. Nobel pretended not to notice what Dittmar was making there, never came in to look at the furnace, was not pleased with anything that Dittmar made, and, finally, Dittmar refrained altogether from speaking to him on the subject. It thus became necessary for Dittmar to employ chiefly the time of Nobel's absence from Krummel to make those experiments, and, when Nobel was there, Dittmar experimented when not under Nobel's scrutiny. Towards the end of October, 1866, Dittmar made public tests of his mixtures of nitro-glycerine with infusorial earth, as an absorbent, before Government officers, at the factory at Krummel, in the presence of Nobel, Winckler and Bandmann, which tests proved eminently successful. The ingredients of such compounds

were, at that time, known to Nobel, inasmuch as Dittmar had revealed to him what they were. Nobel, after the successful issue of such tests, and while Dittmar was further experimenting with infusorial earth in combination with nitro-glycerine, mixed some of the infusorial earth, that had been dried and prepared by Dittmar, with nitro-glycerine, in a glass jar. The only original experiment ever made there by Nobel was that of painting sheets of common paper with liquid nitro glycerine, and then rolling them up into the form of a cartridge. Dittmar says: "I continued my experiments, covering almost every known absorbent substance, both explosive and inexplosive, both combustible and incombustible, with the view of discovering that substance which, either naturally or under chemical treatment, would, without decomposition, absorb the largest quantity of nitro-glycerine, without detracting from the explosive force thereof, and rather assist or enhance the force of explosion, while, at the same time, rendering the compound a safe and efficient powder, until the fall of 1867, when I left the employment of Nobel & Co. From November, 1866, until I left their employment, as aforesaid, I made large quantities of the compound consisting of nitro-glycerine and infusorial earth, in the proportions of about 70 per cent. of nitro-glycerine to about 30 per cent. of infusorial earth, and these were sold, during said period, in open market. In the spring of 1867, Nobel stated to me that he was going to take a pleasure trip to England. Owing to the fact that I had made shipments of nitro-glycerine to England, for Nobel's firm, I supposed that he was going to England in relation to such shipments and for pleasure simply, and did not suspect any motive or design on his part to overreach me. I, therefore, continued in the employment of his firm, and prosecuted my researches and experiments in nitro-glycerine combinations. During the summer of 1867 Nobel returned from England. He stated to me that he had visited England, and frequently came to my house, and, while there, inspected the experiments that I, in the meantime, had made in respect to nitro-glycerine com-

binations, and had many and extended conversations with me in respect thereto. I told him that the result of my experiments, since his departure for England, had demonstrated the advisability of preferring an explosive or combustible to an inert, inexplosive or incombustible substance, as an absorbent, inasmuch as, as aforesaid, such inert matter detracted from the explosive force of the nitro-glycerine, while a combustible or explosive substance rather added to the force of the explosion, performing, at the same time, the identical functions, in respect to reduction to powder form and safety in handling and transportation, and that sawdust, neutralized so as to free it of all qualities that would decompose the nitro-glycerine, would, in combination with the latter and saltpetre, add to its explosive force, in lieu of detracting from it, and could be fired without recourse to a strong fulminating cap, or would, in other words, be a compound in itself explosive by common ignition." Dittmar left Nobel & Co.'s employment in the fall of 1867, and went to Berlin, to Capt. Schultze's factory and became a partner in the business relating to the manufacture of explosive powders. He says: "While with Schultze, I perfected that part of my invention relating to combinations of nitro-glycerine with combustible and explosive substances. * * * I then applied for letters patent to the Government of Great Britain and Ireland, making also application for like letters to the Government of Russia and Prussia, respectively. The combination of nitro-glycerine with infusorial earth having, by experiment, proved itself so much inferior to combinations with combustible and explosive substances, as absorbents, I, in my application for such letters patent, wholly discarded inert substances, such as said infusorial earth, chalk, brick-dust and the like, and made such applications for combinations with combustible and explosive substances only. It was upon the return of my application to the British Government that I was first informed of the fact that Nobel, during his sojourn in England, had applied for and obtained English letters for my invention aforesaid.

The result of my application for an English patent was a provisional protection. * * * The Prussian Government refused to grant me letters patent upon the application made by me as aforesaid, upon the ground that the mixture of nitro-glycerine and powder had been employed for blasting purposes." Dittmar allowed his Russian application to fall, and did not perfect a patent in England for what was covered by such provisional protection.

The English provisional protection consisted of a provisional specification filed by one Johnson, December 5th, 1867, on a communication from Dittmar. It was as follows: "Hitherto, the employment of nitro-glycerine for blasting and similar purposes has been attended with considerable danger, and the object of this invention is not only to render its employment safe, but to enable it to be transported and stored free from its present attendant liability to explosion. In carrying out this invention, the nitro-glycerine is mixed with a porous combustible substance, such, for example, as finely divided wood charcoal, which, by preference, has been previously saturated with a solution of saltpetre, or nitrate of soda, or mixtures of the same, and also with a solution of carbonate of soda, and subsequently dried, so as to expel the water employed for effecting such solution; or, the nitro-glycerine may be mixed with what is known as nitro-cellulose, that is to say, with finely divided wood or other solid ligneous matter, which has been treated with nitric and sulphuric acid, in a manner similar to that employed for the production of gun cotton; or, the nitro-glycerine may be mixed with saw-dust or finely divided solid ligneous matter, previously impregnated with a solution of nitrate of potash, or nitrate of soda, or mixture of the same, and with an alkali, such as carbonate of soda, and subsequently dried, so as to expel the water employed for effecting the solution of the before mentioned salts; or, instead of employing the substances prepared as herein before mentioned, in combination with nitro-glycerine individually, mixtures of the same may be employed, and, when such mixtures of any two or more of the before

mentioned substances are employed with nitro-glycerine, the proportions of the same may be varied according to the desired requirement of the blasting material."

Both the provisional and the full specifications of Nobel's English patent were filed before Dittmar's English provisional specification was filed. Nobel's full English specification distinctly says that the article he produces is a powder. The English provisional specification of Dittmar does not say that his article is a powder. No patent allowed to Dittmar, or printed publication of anything invented by him, is produced, containing a description of what is described in re-issue No. 5,799. The only question is, as to whether Nobel, instead of having himself invented what is described in re issue No. 5,799, derived knowledge of it from Dittmar, in the manner and under the circumstances set up.

It is stated by Dittmar, that, because of Nobel's dissatisfaction with his experiments, he experimented during Nobel's absence, and refrained from speaking to Nobel on the subject of such experiments; and, although Dittmar states that Nobel knew what the ingredients were of the compounds of nitro-glycerine and infusorial earth which Dittmar used in his public tests made in October, 1866, and that, from November, 1866, until the fall of 1867, Dittmar made large quantities of the compound of nitro-glycerine and infusorial earth, in the proportions or about 70 per cent. of nitro-glycerine to about 30 per cent. of infusorial earth, it does not appear that these proportions were communicated by Dittmar to Nobel. There is nothing in Dittmar's story which goes to show that, after October, 1866, Nobel was not himself experimenting, without the knowledge of Dittmar, with mixtures of nitro-glycerine and absorbents. Dittmar did not regard the compound he used in October, 1866, of nitro-glycerine and infusorial earth, as one of entire success, and as a compound showing a substance which would, without decomposition, absorb the largest quantity of nitro-glycerine, without detracting from its explosive force, because, after October, 1866, he continued his experiments until the fall of 1867, with a view of discovering

that substance. For some time before the fall of 1867 he seems to have confined his attention to mixtures of nitroglycerine with sawdust. There is nothing in the entire statement of Dittmar which goes to show that Nobel derived from Dittmar knowledge of what is described in re-issue No. 5,799 or in patent No. 78,317, or that Dittmar made any invention that is described in his patent of January 18th, 1870, before Nobel made the invention described in re-issue No. 5,799.

If it were the fact that what Dittmar now says as to his being the real inventor of the invention described in re-issue No. 5,799 amounted to enough to warrant the denial of the plaintiff's motion, it would be impossible to accept what he says as worthy of reliance, in view of the circumstances under which he says it now, after having been silent about it in former litigations, in one of which, the suit against Parker, he made an affidavit the only purport of which was to show that re-issue No. 5,799 was void for want of novelty.

In regard to the contention that the plaintiff has, by its conduct towards Dittmar, deprived itself of the right to ask for a preliminary injunction, it appears that the plaintiff has been engaged in a series of litigations, for several years, to establish that re-issue No. 5,799 covers powders substantially the same as those involved in this motion; that the plaintiff has done nothing to induce Dittmar to believe that a claim to the right on his part to make powders such as those involved in this motion was acquiesced in by the plaintiff; and that, on behalf of the plaintiff, Mr. Rix denies the allegations of Dittmar as to his making such powders without objection from the plaintiff, and as to there being any understanding or agreement between Rix and Dittmar, that Dittmar was the real inventor of what is covered by re-issue No. 5,799, or that powders such as those involved in this motion did not infringe said re-issue, or that Dittmar should withhold the testimony which he now brings forward.

There must be a preliminary injunction against Dittmar and the Dittmar Powder Manufacturing Company, as to powders like the samples No. 1 and No. 2. The plaintiff

does not make out a case for an injunction against any of the other defendants. It does not offer any proof as to any articles made according to the Dittmar patent, and, therefore, it is unnecessary to refer to that patent, and none of the defendants but Dittmar and the company are shown to have been connected with the said samples.

George Gifford and *Causten Browne*, for the plaintiff.

Everett P. Wheeler and *Clarence Lexow*, for the defendants.

RICHARD M. HOE AND OTHERS, COMPOSING THE FIRM OF R. HOE & Co.

vs.

CALVERT B. COTTRELL AND NATHAN BABCOCK. IN EQUITY.

The letters patent granted, March 16th, 1869, to Richard M. Hoe, as the assignee of Auguste Hippolyte Marinoni, for an improvement in lithographic printing presses, are valid.

Marinoni having made oath, in his application, that he believed himself to be the original and first inventor, and having testified, in this suit, that he was the sole inventor, such evidence was held not to have been overcome by the testimony of one Chaudré, that he was a joint inventor with Marinoni, and by the fact that patents had been issued for the invention, in Europe, to the two jointly.

The decision of the Commissioner of Patents, that the required drawings and model had been presented, that an attorney had been duly appointed and had authority to amend or alter the specification, and that the specification had been sufficiently sworn to by the inventor, is final, and cannot be renewed collaterally.

There is sufficient invention in what is covered by the 3d claim, namely, "The combination of the sheet-flyer with an impression cylinder without tapes, and a receiving cylinder provided with both grippers and tapes, substantially as described and specified," to support a patent.

The object of said combination, stated.

There is a combination of the sheet-flyer with the impression cylinder, because the successive action of each contributes to produce a practical result.

The novelty of the combination sustained, against the view that it required only skilled labor to make it, in view of what existed before, all the elements of the combination being old, but the combination being new, in fact, and useful.

The combination being shown in the drawings, and described in the specification, as to its principles of construction and mode of operation, the claim is valid, although, in stating the invention, in the body of the specification, one element of the combination was omitted.

(Before SHIPMAN, J., Connecticut, March 30th, 1880.)

SHIPMAN, J. This is a bill in equity, based upon the alleged infringement of letters patent which were granted, on March 16th, 1869, to Richard M. Hoe, as the assignee of Auguste Hippolyte Marinoni, for an improvement in lithographic printing presses. The patent has been assigned to the plaintiffs.

The first question is, whether Marinoni was the sole inventor of the alleged improvement, or was a first inventor with Francis Noël Chaudré. In 1866, Mr. Hoe was in France, and purchased from Marinoni all his rights to the invention in consequence of the future grant of letters patent therefor in the United States. Marinoni made oath, in his application to this Government for letters patent, that he believes himself to be the original and first inventor of the improvements, and that they had been patented in France, on June 5th, 1865, in the name of Marinoni and Chaudré. Chaudré, who was a partner of Marinoni at the date of the invention, testifies that he was a joint and equal inventor of the improvements, which he describes at length. On June 12th, 1865, a Belgian patent was issued to Marinoni and Chaudré, and an English patent was issued to one Clark, upon their communication. By the French statute, every new discovery or invention, in all departments of industry, confers upon its author, under the conditions and for the time mentioned in the statute, the exclusive right of working, for his own profit, the said invention. "Every person who shall wish to obtain a patent of invention, must deposit, under a

sealed cover, * * * 1. His petition to the Minister of Agriculture and Commerce; 2. A specification of the discovery, invention or application forming the subject of the petition; 3. The drawings," &c. The patents demanded, in due form, are delivered without previous examination. Applications are not required to be verified by oath, and are not preserved by the Government. The plaintiffs introduced Marinoni's deposition, in which he asserted that he was the sole inventor. It is necessary for the defendants to overcome the *prima facie* case, and to establish affirmatively that the applicant was not the sole inventor. The testimony of Chaudré is not sufficient. I cannot perceive, from the depositions, that one story is apparently more entitled to confidence than the other. Marinoni's statement is exceedingly brief, and is a bare assertion that he was the inventor. Chaudré is equally positive of his joint participation in the invention, and he describes its character, but is equally silent as to the manner in which they worked, and as to the method by which they jointly accomplished the result. If the defendants could have shown an admission by Marinoni, in either foreign application, that he was not the sole inventor, it would have turned the scale; but it is not certain what the application was, or that he personally made an application. The French system of issuing patents is not so exact as that which prevails here. While the existence of the foreign patents, confessedly with the knowledge of Marinoni, throws doubt upon his title, and while I am not satisfied as to the authorship, it is impossible to say that the defendants have established, by a preponderance of proof, the fact that Marinoni was not the sole inventor.

It is next insisted, that the patent is invalid by reason of sundry irregularities and omissions during and prior to the transit of the application through the Patent Office. These alleged irregularities are as follows: Marinoni appointed Messrs. Munn, Wales and Beach "to act as his attorneys in presenting the application, and in making all such alterations and amendments as may be required, and also to sign his name to the drawings." This authority was never revoked by

Marinoni or by Hoe. Hoe & Co., who had no record interest in the invention, revoked the power to Munn & Co., and appointed C. A. Durgin to represent them in the premises. The specification which Marinoni had made and filed was not intelligible. Durgin amended the specification by writing substantially a new one, which was not sworn to by the inventor. It is claimed that there were no original drawings or model accompanying the description, as required by the statute, because the description was unintelligible and was not a description. All these alleged irregularities and omissions relate to the formal acts to be done by the inventor or by his duly constituted attorney, preparatory to and connected with the issuing of the patent. The Commissioner's decision upon the fact that the acts were done, and upon the fact of the compliance of the applicant with the requirements of the statute in regard to his application, is not to be reviewed collaterally. For the purposes of this case, the Commissioner's decision is final, that the drawings and the model required by the statute had been presented, that Durgin was the duly constituted attorney of the applicant or his assignee, and had authority to amend or alter the specification, and that the specification had been sufficiently sworn to by the inventor. If the patent is invalid by reason of any or all of these defects, its invalidity is to be determined in a proceeding to set aside the patent by *scire facias*, or by bill or information. (*Seymour* v. *Osborne*, 11 *Wall.*, 516; *Rubber Co.* v. *Goodyear Co.*, 9 *Wall.*, 788; *Jackson* v. *Lawton*, 10 *Johns.*, 23.)

The defendants insist, in the third place, that, in view of the state of the art, there was an entire lack of invention in the combination which is the subject-matter of the third and only claim which is said to have been infringed, or that the combination was old.

The improved press was for lithographic printing. The invention recited in the third claim was for "the combination of the sheet-flyer with an impression cylinder without tapes, and a receiving cylinder provided with both grippers and tapes, substantially as described and specified." The obje c

of the invention was to have the whole width or surface of a sheet of paper printed with heavy color on the impression cylinder, and delivered automatically, without smutting, face side uppermost, on the fly-board or table. The whole width of the paper is enabled to be printed, because the impression cylinder is without tapes underlying the sheet. The sheet is taken by the grippers of the receiving cylinder, and is delivered upon tapes running from the receiving cylinder over pulleys near the roots of the fly-fingers. These tapes are above the fly-fingers, and thus prevent the sheet from being smutted in consequence of sliding down the smooth fly-frame. When the sheet is in proper position, it is automatically turned by the fly-frame, face side uppermost, upon the table.

If there was invention in this combination, and the patentee was the first inventor, the claim is not invalid upon the ground that the sheet flyer and impression cylinder have no conjoint action, and no active connection to produce a joint result. The combination is of the class mentioned in *Forbush* v. *Cook*, (2 *Fisher's Patent Cases*, 668,) in which case Judge Curtis says: "To make a valid claim for a combination, it is not necessary that the several elementary parts of the combination should act simultaneously. If those elementary parts are so arranged that the successive action of each contributes to produce some one practical result, which result, when attained, is the product of the simultaneous or successive action of all the elementary parts, viewed as one entire whole, a valid claim for thus combining these elementary parts may be made." The result which was attained was the automatic delivery of a sheet, automatically printed upon its broad side with heavy color, without smutting, face side uppermost. This result was the product of the successive action of all the elementary parts.

It is not denied that all the elements were old. Delivery mechanism, consisting of tapes combined with flyers, had been used in presses having printing cylinders with tapes. Impression cylinders without tapes, and receiving cylinders with tapes, had been combined with sheet-flyers without tapes.

But, the combination of all the elements in one existing machine was new. It is substantially admitted that this combination had not been actually made or described in any machine, although it is claimed that the combination was so far suggested in antecedent patents, that the flyer could have been added by any skilled press builder, as a matter of course. Prior to the date of the invention, sheet-flyers were a common adjunct of a press. They were made so as to be detached from presses and to be put on or taken off at pleasure. Tape and sheet-flyer deliveries had been combined, and, therefore, when Dutartre, in his French patent of January 11th, 1853, showed an impression cylinder without tapes, a receiving cylinder with grippers and tapes, and a tape delivery, it is said that any skilled builder could have mechanically added a sheet-flyer to the tapes. It is further said, that, when the Reynolds American patent of February 28th, 1863, contained the same combination, and, after showing how the paper was delivered to the tapes, added, that it is "piled by hand or by an ordinary fly," it was the part of ordinary mechanical labor to add the fly to the tapes. It is to be observed, that Reynolds did not suggest the combination of fly and tapes.

The same point is put by the defendants, more forcibly, in this way. The plaintiffs, at the date of the invention, were making, in their factory, the Hoe high-stop press, which had an impression cylinder without tapes, a receiving cylinder with tapes, and a sheet-flyer without tapes. They also knew of the Taylor press, and were making, at the same time divers presses like the Taylor, having impression cylinders with tapes and a combined tape and sheet-flyer delivery. What was easier than for Mr. Hoe to discard his ingenious sheet-flyer, and substitute the well known Taylor method of delivery? Looking at the question from the present standpoint of time, it is very difficult to point out satisfactorily to one's-self the changes which required invention. If we looked merely at the simplicity of the combination, and at the ease with which it now seems that anybody could have accomplished the result, the conclusion would be irresistible, that there was no combination.

The facts which are also to be taken into account, in the determination of this question, are these: At the date of the invention, about eighteen hundred patents upon printing presses had been granted in England, France and the United States. This combination did not exist in any patented or non-patented device, so far as is now known. Lithographic printing was, at that time, well understood. Mr. Hoe, who had long been a printing press manufacturer and inventor, and was thoroughly conversant, both by study and practice, with the subject of improvements in printing, and was making both the Hoe high-stop press and presses which had tape and fly deliveries, when he saw the Marinoni press, recognized it as an invention embodying an advance in the art, and hastened to purchase the exclusive right to use the improvement in this country.

The combination is useful. It has been a successful and popular press and has been extensively sold. The plaintiffs have substituted it for the Hoe high-stop press. The exhaustive and expensive manner in which this suit has been carried on and contested shows that the combination is of value.

In the determination of the question whether there was invention in any particular combination, the important point is to ascertain whether novelty and utility existed. It is true, that these requisites may result from mere mechanical skill, and a new and useful combination may be formed by the mere mechanical addition of an old member to an old set of members; but, when a device has a new mode of operation, which accomplishes beneficial results, "Courts look with favor upon it," and are not exacting as to the degree of inventive skill which was required to produce the new result. There must be *some*, but a little will suffice. (*Forbush* v. *Cook*, 2 *Fisher's Patent Cases*, 668; *Middletown Tool Co.* v. *Judd*, 3 *Id.*, 141; *Stimpson* v. *Woodman*, 10 *Wall.*, 117.)

The facts, that, in the multiplicity of printing press mechanism, this combination had not been hit upon, and that, when it was introduced, its utility was universally recognized, and

that it is plain, that, in order to make the combination, some changes were necessary in any machine or drawing which has been shown, satisfy me, that, to produce this result required changes which the mere skill of the skilled mechanic would not suggest, and that the work was practically more difficult than now seems to the theorist to have been necessary.

The defendants next insist, that the patent is void because the patentee, in the body of his specification, states that his invention consisted in the combination with the receiving cylinder, provided with grippers and cords or tapes, of the sheet-flyers, whereas, a new element is introduced into the claim, viz., "an impression cylinder without tapes." This clause was introduced into the claim by amendment, after the application had been rejected, and the corresponding amendment was not made in the statement of the invention in the body of the specification. It is admitted by the defendants' expert to be true, "that the combination recited in the third claim is all shown in the drawings, and is described in the specification, as to its principles of construction and mode of operation, but it is equally true that it is nowhere described, except in the claim, as one of the parts of invention of the patentee." It would not be in accordance with the principles of construction which have heretofore been adopted by the Courts of this country to declare the patent void on account of this discrepancy or omission.

In regard to infringement, differences in the construction of the two machines exist, but they are not material with respect to the mode of operation of the combination which is the subject of the third claim.

Let there be a decree for an injunction and an accounting, in respect to the third claim.

M. B. Philipp and *Benjamin F. Thurston*, for the plaintiffs.

H. D. Donnelly and *William D. Shipman*, for the defendants.

The United States *vs.* Charles D. J. Noelke.

The defendant was indicted under § 3,894 of the Revised Statutes. The 1st count alleged that he deposited in the mail a "letter and circular" concerning a lottery, setting it forth *in haec verba*. The 2d count alleged that he deposited in the mail a circular concerning a lottery, and set forth what the circular purported to announce, but did not set it forth *in haec verba*. After a verdict of guilty on both counts, the defendant moved in arrest of judgment, and for a new trial, on exceptions: *Held*,

(1.) Under the statute the same paper may be both a letter and a circular, and the paper deposited in this case was both;

(2.) The indictment need not state that the paper was one concerning a lottery "offering prizes;"

(3.) The omission, if any, in the first count, of averments to show the illegal quality of the paper, was a defect cured, after verdict, by § 1,025 of the Revised Statutes, as a defect of form, not tending to the prejudice of the defendant;

(4.) The paper set forth in the first count shows, on its face, that it is such a letter as is within the prohibition of the statute;

(5.) The second count is bad, because it does not set forth the circular *in haec verba*, and the defect is one which is not cured by said § 1,025, and one which can be availed of on a motion in arrest of judgment.

In empanelling the jury, a juror was asked, by the defendant: "Have you any prejudice against the lottery business, or those who are engaged in it?" "Are you disposed, in your mind, to put an end to the traffic in lottery tickets?" "Are you in favor of active measures for the suppression of the lottery business?" The questions were successively excluded. The juror had before testified that he knew nothing about the case, and he afterwards testified that he had heard nothing and read nothing, and had not talked with any one about the prosecution of lottery dealers, and that he felt that he could decide the case by the evidence, without prejudice. He was sworn as a juror: *Held*, that affirmative answers to the three questions would not have been ground for rejecting the juror.

Other papers enclosed in the same envelope with the paper set forth in the first count, were admissible in evidence, as they tended to show that said paper related to a lottery, and were part of the *res gestæ*.

It was proper to allow a witness to testify that he visited the place of business referred to in the paper set forth in the first count, a few days after the paper was deposited in the mail, and saw lottery tickets sold there by the defendant's clerk, and that the defendant stated to the witness that the clerk was in his employ, and that that was his business, and that the witness then saw there papers with the same stamp on them as that on the paper enclosed in said envelope.

After the testimony for the prosecution had been closed, the defendant objected that no evidence had been introduced tending to show the existence of a lottery. The Court granted time to supply such proof: *Held*, that the matter was within the discretion of the Court.

The Act of the Legislature of Louisiana, passed August 11th, 1868, (*Laws of* 1868, *p.* 24,) on the subject of lotteries, is a public Act, and provable by the introduction of a volume of the Laws of 1868, purporting to have been published by authority.

It was not necessary for the prosecution to prove that the lottery had a legal existence, or that the company carrying it on was a corporation.

The occupation of the defendant, the passage of said Act, and other extrinsic circumstances, were proper to be considered by the jury on the question whether the letter related to a lottery.

Matters stated which the jury had a right, and were bound, to consider, in determining the question whether the defendant was the person who deposited, or caused to be deposited, in the mail, the letter in question.

The general rule of evidence is, that a postmark is presumptive evidence of the mailing of a letter, and such rule is not displaced by showing that envelopes not mailed have been stamped with a given postmark.

(Before BLATCHFORD, BENEDICT and CHOATE, JJ., Southern District of New York, March 30th, 1880.)

CHOATE, J. The defendant was indicted under section 3,894 of the Revised Statutes, which provides as follows: "No letter or circular concerning lotteries, so called gift concerts, or other similar enterprises, offering prizes, or concerning schemes devised and intended to deceive and defraud the public for the purpose of obtaining money under false pretences, shall be carried in the mail. Any person who shall knowingly deposit or send anything to be conveyed by mail, in violation of this section, shall be punishable by a fine of not more than five hundred dollars, nor less than one hundred dollars, with costs of prosecution." The indictment contained two counts. The first count charged that the defendant "did unlawfully and knowingly deposit in the mail of the United States, and send to be conveyed by the said mail, a certain letter and circular concerning a lottery, which said letter and circular was then and there of the tenor and in the words and figures following, that is to say:

'New York, Nov. 7, 1879.

Chas. D. J. Noelke,
Banker and Broker,
238 Grand Street,
Bet. Christie and Bowery.

Dear Sir:—Yours of 5th inst., enclosing $2, received. Enclosed please find 2 ½ La. tickets, as pr. your order.

Very respectfully,
Chas. D. J. Noelke.

All prizes payable in full on presentation of ticket.

Official copy of drawings mailed as soon as received.'

which said letter and circular was then and there enclosed in an envelope and addressed as follows, that is to say:

M. Many,
c. o. P. Howell, Esq.,
Trenton, New Jersey, } ,,,
Mercer Co. }

The second count charged that the defendant "did unlawfully and knowingly deposit in the mail of the United States, and send to be conveyed by the said mail, a certain circular concerning a lottery, which said circular was then and there enclosed in an envelope, which said envelope was addressed as follows:

'M. Many,
c. o. P. Howell, Esq.,
Trenton, New Jersey, } ,
Mercer Co. }

and which said circular purported to be an announcement of the one hundred and fourteenth grand monthly distribution of the Louisiana State Lottery, to take place at New Orleans, Tuesday, November 11, 1879, describing the list of prizes, the plan of the lottery, a list of capital prizes, and a statement of their authority for, and method of, doing business." The defendant pleaded "not guilty," and, after a trial before Benedict J., and a verdict of "guilty," on both counts, he now moves in arrest of judgment, and for a new trial, upon exceptions:

(1.) The first objection taken to the first count is, that the

writing set out in that count is improperly described as a "letter and circular." It is insisted that the statute, in proscribing a letter *or* circular, recognizes the distinction between the two things; that, by a circular is intended a written or printed communication, general, and not personal, in its character, and that, by a letter is intended a communication personal and individual in character, and not general; that, if the paper set forth is a letter, then it is not, and cannot be, a circular, within the meaning of the statute, and, if it is a circular, then it cannot be a letter. We think, however, that the same paper may be both a letter and a circular. No doubt, there may be many circulars that are not letters, but a circular which is in the form of a letter may be well described as a letter and a circular, and there is no reason for excluding such a circular from the operation of the statute. There is nothing on the face of the paper set forth in the first count indicating that it was not a circular, that is, a paper intended to be issued to a great number of persons, or for general circulation; yet it undoubtedly is a letter in form. This mode of describing it may, perhaps, have imposed on the Government the necessity of proving that the paper was both a letter and a circular; although, where an instrument is set out in full, the description has been held to be surplusage. (*Regina* v. *Williams*, 2 *Den. C. C.*, 61; *United States* v. *Trout*, 4 *Biss.*, 105; *United States* v. *Bennett*, 16 *Blatchf. C. C. R.*, 338.) But, whether these cases apply to the present case or not, we think the count is not for this reason bad.

(2.) It is also objected to the first count, that it omits to charge that the paper was one "concerning a lottery offering prizes." This objection is based on an erroneous reading of the statute. The things proscribed are (1.) "lotteries;" (2.) "so called gift concerts;" (3.) "similar enterprises offering prizes;" and (4.) "schemes devised and intended to deceive and defraud the public for the purpose of obtaining money under false pretences." The words "offering prizes" qualify and limit the words "similar enterprises." They indicate the nature of the similarity to "lotteries" and "so called gift

concerts," which must characterize other "enterprises" than "lotteries" and "gift concerts," to bring them, also, within the embrace of the statute. The words are wholly unnecessary, and would be tautological, as descriptive of "lotteries" and "gift concerts," for, the offering of prizes is well understood to be an essential part of a "lottery" or a "gift concert." This, we think, is the obvious construction and meaning of the statute.

(3.) It is also objected to the first count, that it omits averments necessary to show the illegal quality of the writing set forth; that, as set out, the paper does not, on its face, and without explanation, concern a lottery; that the expression "La. tickets" is unintelligible until more than intrinsically appears is supplied by inuendo; and that there is no allegation of the existence of a lottery of and concerning which the paper was written.

It is, undoubtedly, an established rule of criminal pleading, that, in setting out a writing as an alleged violation of a statute, where words constitute the gist of the offence, if the paper itself, in its own terms, does not purport to be the thing prohibited, the indictment should, by further averment or inuendo, set forth that essential fact. The word "lottery" is not used in the paper set out in the first count. The expressions "La. tickets," "all prizes," and "official copy of drawings," do not, perhaps, necessarily refer to a lottery, although it is difficult to imagine any other subject to which they could be reasonably attributed; but, the paper is averred to be "a certain letter and circular concerning a lottery," and, although this is an inartificial and informal mode of averring that the words "tickets," "prizes," and "drawings," used in the paper, were used in reference to tickets, prizes and drawings of and in a lottery, we think that the defect is not available to the defendant after verdict. By section 1,025 of the Revised Statutes, it is provided: "No indictment found and presented by a grand jury, in any District or Circuit or other Court of the United States, shall be deemed insufficient, nor shall the trial, judgment or other proceeding

thereon be affected, by reason of any defect or imperfection in matter of form only, which shall not tend to the prejudice of the defendant." This statute was passed July 1st, 1872, being the 8th section of "An Act to further the administration of justice," (17 *U. S. Stat. at Large*, 198,) and, while its operation is necessarily limited by that provision of the Constitution, (*Amdt.* 6,) which secures to every person accused the right "to be informed of the cause and nature of the accusation," which has been held to mean that the offence must be set out "with clearness and all necessary certainty, to apprise the accused of the crime with which he stands charged," (*United States* v. *Cruikshank*, 92 *U. S.*, 558,) yet we think that the informality of the averment that the expressions used in the paper set forth were used concerning a lottery, was one which it was competent for Congress to allow the accused to waive by going to trial on the indictment, and that this kind of imperfect and informal averment of a fact essential to make the offence complete, was one of those "matters of form" designed by the statute to be disregarded, where it appears that the defendant was not prejudiced thereby. It is not the case of an entire want of an averment of a material fact, but rather a case of an informal averment of such fact, and yet an averment such that no person of ordinary intelligence would fail to understand, from reading this indictment, that the meaning was, that these expressions were used with reference to a lottery. The design of the statute was to discourage the practice, on the part of defendants, of lying by till after trial and verdict, and then urging, as ground for arrest of judgment, mere defects of form, where, to all reasonable certainty, they had not been misled or prejudiced. And, whatever might be the effect of this defect in the indictment, on a motion to quash, or on demurrer, we think it no sufficient ground in arrest of judgment. It is quite clear, that the defendant suffered no prejudice on this account. We think, also, that this defect in the indictment is one of those defects of informal averment, which, as distinguished from a defect consisting in the

total want of an essential averment, is cured after verdict, even at common law. (*Heymann* v. *The Queen*, 12 *Cox's Cr. C.*, 383; *Bradlaugh* v. *The Queen*, *L. R.*, 3 *Q. B. Div.*, 642.)

(4.) It is also objected to the first count, that it omits necessary allegations to show that, in the sense contemplated by the statute, the letter set forth was one concerning a lottery. The argument is, that the statute was not intended to prohibit *all* letters concerning a lottery, but only such as were designed to promote and further the illegal or immoral business of setting up and carrying on lotteries. It is true, that, where an act is prohibited, and, upon the necessary construction of the statute, it is evident that the act is intended to be proscribed only under certain circumstances, or upon facts coming within the well understood reason of public policy which led to the enactment of the statute, it is not, generally, sufficient to charge the offence in the words of the statute. *Non constat* the act may be within some of the implied exceptions, (*United States* v. *Gooding*, 12 *Wheat.*, 460; *United States* v. *Pond*, 2 *Curtis' C. C. R.*, 268;) and, no doubt, many innocent letters may be written and sent by mail concerning lotteries, as, for instance, a letter from a man to his son, cautioning him not to be induced to spend his money for lottery tickets. This statute, clearly, has many implied exceptions. But, we think, that, assuming that there is, as we have held that there is, an averment, in substance, that the expressions in the letter set out referred to a lottery, it does appear clearly, on the face of the paper, that it is such a letter as is within the prohibition of the statute. It admits of no possible meaning, unless it is understood to be a communication in the course of a direct dealing in lottery tickets. Such a letter is, unmistakably, within the reason and the prohibition of the statute.

(5.) The alleged defect in the second count is, that the circular should have been set forth, not as it is, by a description of its contents, but *in haec verba*. Where the offence consists of words spoken or written, the general rule is, that those words must be set forth in the indictment. This rule has

been applied in a large number of cases, including the offence of sending threatening letters. (*Rex* v. *Lloyd*, 2 *East's P. C.*, 1,122.) It seems to us that the present case is within the general rule. In the recent case of *United States* v. *Bennett*, (16 *Blatchf. C. C. R.*, 338,) the rule was recognized in the case of an indictment for sending obscene matter through the mail, but it was held that the rule did not apply where it appeared by the indictment that the matter was too indecent to be put upon the records of the Court, in which particular case the Courts in this country have held that the rule does not apply. This objection appears to have been regarded as one of substance and not of form merely, and, therefore, not aided by verdict, at common law, (*Bradlaugh* v. *The Queen*, *L. R.*, 3 *Q. B. Div.*, 618;) and, for the same reason, we think it is not cured by the statute above referred to, (*Rev. Stat.*, § 1,025.)

The motion in arrest must, therefore, be sustained as to the second count, and overruled as to the first count.

(6.) The first three exceptions taken upon the trial were during the empanelling of the jury. A juror being called, was asked by the defendant's counsel: "Have you any prejudice against the lottery business or those who are engaged in it?" This was objected to and excluded, and the defendant excepted. The juror was then asked: "Are you disposed, in your mind, to put an end to the traffic in lottery tickets?" This was objected to and excluded, and the defendant excepted. The juror was then asked: "Are you in favor of active measures for the suppression of the lottery business?" This was objected to and excluded, and the defendant excepted. The juror had previously testified that he knew nothing about the case; and he subsequently testified, being further interrogated by the defendant's counsel, that he had heard nothing, and read nothing, nor talked with anybody at all, about the prosecution of lottery dealers, and that he felt that he could go into the jury box without any prejudice for or against the defendant and decide the case strictly within the evidence, without regard to anything that he had heard or known outside of the evidence.

He was then sworn as a juror. It must be assumed, that the juror might have answered these questions in the affirmative, and the question is, whether he would be rendered incompetent as a juror by the fact that he had a prejudice against the lottery business or those who are engaged in it, or that he was disposed, in his mind, to put an end to the traffic in lottery tickets, or in favor of active measures for the suppression of the lottery business.

Parties have a right to be tried by an impartial jury. This does not mean that they have a right to have jurors who have no prejudice or no opinion as to the policy of enforcing the laws. If the juror had answered all these questions in the affirmative, it would only show that he entertained a prejudice in favor of enforcing the laws of the State of New York against lotteries, which have been in force for a great number of years. We see nothing in this prejudice to disqualify him. In fact, if he is a good citizen, and fit to sit on the jury at all, he is bound to have a prejudice against what is forbidden by law, and against those who break the law, and is bound, also, to be in favor of active measures for the enforcement of the criminal laws of the State. The cases cited by the defendant as analogous to this are not in point. *Albrecht* v. *Walker*, (73 *Ill.*, 69,) was an action for damages for the sale of intoxicating liquor to the plaintiff's husband. A juror testified that he had a prejudice against the business in which the defendant was engaged, but not against the defendant himself, and, although he might have a prejudice against the man engaged in the business, he did not know that he would start out in the investigation with a prejudice against the man engaged in it. In reference to this, Mr. Justice Breese says: "All honest men have a prejudice, so to speak, against larceny and other crimes, but, if no prejudice exists against a party charged with the crime, we do not think that, of itself, is ground of challenge for cause." In *Winnesheik Ins. Co.* v. *Schneller*, (60 *Ill.*, 472,) the juror testified that he had a prejudice against insurance companies generally; that it was founded on the fact that he could not comprehend

their proceedings; but that the prejudice would not affect his verdict. On this the Court said: "It was error to overrule the challenge of the juror. * * * A man may have a prejudice against crime, against a mean action, against dishonesty, and still be a competent juror. This is proper, and such prejudice will never force a juror to prejudge an innocent and an honest man. As to this juror, the feeling he entertained against insurance companies was of a bigoted and reprehensible character." The case of *Maretzek* v. *Cauldwell*, (2 *Abb. Pr. Rep., N. S.*, 407,) was an action for libel respecting the plaintiff's conduct as a theatrical manager. A juror testified that he was opposed to theatrical representations. It was held that he should not have been, as matter of law, excluded on that account, but that it was ground only for challenge to the favor. But, it will be observed, that the juror had a prejudice against a whole class of persons to which the plaintiff belonged, by reason of their being engaged in a business which was not unlawful. So, where defendants, who were Roman Catholics, were indicted for a riot growing out of prejudices between Roman Catholics and others, it was held proper to allow a juror to be asked if he had any bias or prejudice against Roman Catholics. (*The People* v. *Christie*, 2 *Abb. Pr. Rep.*, 256.) Where the subject-matter inquired about is one on which there is public agitation or diversity of opinion in the community, and strong feelings are excited, greater latitude of inquiry must, clearly, be allowed than where the question relates simply to a matter about which there is no such agitation or diversity of opinion. As to the business of dealing in lottery tickets, it seems to us that there is no such diversity of opinion or public agitation in respect to the policy of the laws prohibiting it, and in respect to its injurious effects upon the morals and well-being of the community, as to make these questions proper, or reasonably necessary, to ascertain the impartiality of the jurors. Moreover, at the time these questions were asked, it had not appeared that the defendant was a dealer in lottery tickets; and, if the questions would have been competent at all, as tending

to disclose a prejudice against the defendant, that fact should, it seems, have been shown, or evidence of it offered. Without regard to that point, however, we think the facts offered to be shown immaterial, because they did not tend to disclose any prejudice which would render the juror incompetent. If the counsel expected to follow these questions up by others more material, he should have put such further questions, or suggested the point. As the record stands, it cannot be assumed that he desired to show, against the competency of the juror, anything more than would have been shown by the affirmative answers to these questions.

(7.) Objection was also made to the admission in evidence of other papers enclosed in the same envelope with the letter or circular set forth in the first count, as it was put in the mail. Those other papers tended strongly to show that the paper set forth related to a lottery. They were the circular described in the second count, and two tickets purporting to be tickets in a lottery called "The Louisiana State Lottery." There can be no doubt that they were competent evidence, as part of the *res gestæ*.

(8.) A witness for the prosecution testified, that he visited the place of business referred to in the letter set forth in the first count, No. 238 Grand street, a few days after the time alleged in the indictment when the letter was mailed, and that he saw there several other papers bearing the same device or monogram as were on the papers enclosed with said letter, and saw the defendant there, with a hand stamp, make the same impression on a slip of paper. The witness was then asked: "What else did you see and do there at that time?" This question was objected to. The objection was overruled and the defendant excepted. The witness then testified to seeing a lottery ticket sold there by the defendant's clerk while the defendant was present, and to statements made by the defendant to the witness, that this clerk was in his employ and that this was his business; and that the defendant tried to prevent a deputy marshal, who was with the witness, from entering the place. The defendant objected to this evidence, and moved to strike it out. The motion was

denied, and the defendant excepted. The witness further testified, under the defendant's objection and exception, that he found in the front office a place for the sale of lottery tickets, and in the back part a policy shop. It is now insisted, that this testimony was wholly irrelevant and "utterly foreign to the charge." It seems to us, however, that it tended to trace to the defendant the possession, prior to their mailing, of the papers enclosed in the envelope, and that his declarations as to his business, so soon after the mailing of this letter, were competent, as bearing on the question, whether or not it was he who mailed the letter. It tended to show that he had motive and opportunity to commit the offence with which he was charged, and such circumstantial evidence is always competent.

(9.) After the District Attorney had announced the testimony for the prosecution closed, the defendant moved for an acquittal, on the ground that no evidence had been introduced tending to show the existence of a lottery of and concerning which the papers in question were written or made. The District Attorney then asked time to supply this proof, which was granted under objection and exception on the defendant's part, and an adjournment was had for this purpose. It is now insisted, that this was error, but we are of opinion that it was within the discretion of the presiding judge to permit the case to be reopened.

(10.) On the coming in of the Court, the District Attorney offered in evidence pages 24, 25 and 26 of a volume entitled, "Laws of 1868, of the State of Louisiana," being an Act to authorize the incorporation and establishment of the Louisiana State Lottery Company, to be referred to. This was objected to, on the ground that a private Act cannot be proved by the introduction of the book containing it. The objection was overruled, and the defendant excepted. The book from which this Act was read has been before us. It bears the imprint, "Published by Authority," on the title page. The Act in question, passed August 11th, 1868, is en-

titled, "An Act to increase the Revenues of the State, and to authorize the incorporation and establishment of the Louisiana State Lottery Company, and to repeal certain Acts now in force." The first section is as follows: "That, whereas many millions of dollars have been withdrawn from and lost to this State by the sale of Havana, Kentucky, Madrid and other lottery tickets, policies, combinations and devices, and fractional parts thereof, it shall hereafter be unlawful to sell, offer or expose for sale any of them, or any other lottery, policy or combination ticket or tickets, devices or certificates, or fractional parts thereof, except in such manner and by such persons, their heirs, executors or assigns, as shall be hereinafter authorized." The second section declares that certain persons named "are hereby constituted and declared a corporation for the objects and purposes, and with the powers and privileges, hereinafter specified and set forth," and then follow "articles of incorporation," which declare, among other things: "The objects and purposes of this corporation are, First.—The protection of the State against the great losses heretofore incurred by sending large amounts of money to other States and foreign countries, for the purchase of lottery tickets and devices, thereby impoverishing our own people. Second.—To establish a solvent and reliable home institution for the sale of lottery, policy and compensation tickets, &c., at terms and prices in just proportion to the prizes to be drawn and to insure perfect fairness and justice in the distribution of such prizes. Third.—To provide means to raise a fund for educational and charitable purposes for the citizens of Louisiana." The articles also provide, that the corporation shall pay to the State of Louisiana $40,000 per annum, to be credited to the educational fund. The third section of the Act imposes a penalty on any person for selling or offering for sale any lottery tickets in violation of the Act. The fourth section grants to the corporation the exclusive privilege, for twenty-five years, of establishing a lottery and selling tickets. The

seventh section repeals certain laws, namely, an Act passed February 17th, 1866, entitled, "An Act to license the vending of lottery tickets;" "An Act to authorize the sale of stamps to venders of lottery tickets," passed February 28th, 1866; and an Act to amend the last named Act, passed March 22d, 1866; and "all other laws or parts of laws inconsistent with or contrary to the provisions of this Act." The Acts thus expressly repealed are, clearly, general statutes. The Act of February 17th, 1866, was an Act creating offences and imposing penalties.

We have no doubt that this statute, read in evidence, is to be regarded as a general statute or public Act, and not as a private Act. It is largely made up of provisions in the nature of general legislation, and the fact that, incidentally, and as a means towards making such general legislation effectual, it grants corporate powers to certain persons, does not make it the less a general law. Laws are either public or private, and this is, clearly, public. The objection that it was not proved as a private law has no force.

(11.) The prosecution having rested again, the defendant's counsel renewed his motion to direct a verdict of acquittal, upon the ground specified in the former motion, that there was no evidence of the existence of a lottery of and concerning which the papers in question could have been written or made, or that they are letters and circulars concerning any lottery; also, on the further ground, that, be the Act what it may, there is no evidence of any action in acceptance of the charter there tendered, or that an organization under that Act was ever effected by the corporators named therein, or that the corporation, if it ever existed, had not been dissolved by some one of the various methods known for the dissolution of corporations, at the time the indictment was found, or that the charter had not been forfeited or withdrawn by subsequent legislation. This motion was denied, and the defendant excepted. This exception is based upon the theory, that it was necessary for the Government to prove that the lottery was one established by law, having a legal existence; and that

it was necessary to prove that the party or parties who issued the tickets enclosed in the envelopes, which purported to be issued by the Louisiana State Lottery Company, were a corporation, as they purported to be, and that they had, or carried on, a real lottery. There was abundant evidence in the case, to justify the denial of this motion, that there were some parties purporting to be and calling themselves by the name of the Louisiana State Lottery Company, who were carrying on a lottery; but it was wholly immaterial whether they were the same persons named in this Act, or whether those persons had accepted their charter or not. It was none the less a lottery in fact, and within the prohibition of the statute, whether legally established or wholly illegal, whether its promoters were duly incorporated or not. Indeed, we think that the mailing of a letter or circular concerning a projected lottery, one not yet in existence, would clearly be within the letter and the spirit of the statute, if it were a letter or circular promoting, or designed to aid in, the organization and setting up of a lottery. There was, therefore, no reason why, at this stage of the case, the Court should direct an acquittal of the defendant, when the papers themselves, with the mailing of which he was charged, bore on their face strong, if not conclusive, evidence that they related to an existing or established lottery. No more evidence of the existence of a lottery need to have been given, to justify a conviction, than the papers and tickets enclosed in the envelope.

(12.) The remaining exceptions are to the judge's charge to the jury. The judge charged the jury, among other things, as follows: "In order to convict, you must find that it is a letter concerning a lottery, in the one case, and a circular concerning a lottery, in the other; and, in determining that question, you are not confined to the words in the paper. You may look at the surrounding circumstances—the letter sent, which was the order, the tickets enclosed in Exhibit No. 1, (*i. e.*, the letter set out in the first count,) apparently in compliance with the order, the occupation of the defend-

ant, and all the other circumstances in the case, in order to determine whether or not that letter, forming the subject of the first count, was concerning a lottery. If you find that it was concerning a lottery, then it was an illegal article in the mail, in case you find it to have been there deposited. If you find that this Exhibit No. 1 was deposited in the mail, and you find that these two papers that were in it, in one case, a letter, and, in the other case, a circular, were concerning a lottery, then the question arises: Who deposited these papers in the mail? Before proceeding to that, I should remark, that there has been evidence going to show the existence of a lottery known as the Louisiana State Lottery. The evidence from the statute book of the State of Louisiana, together with the sale of the tickets put in evidence, in the absence of any evidence to the contrary, will justify you in finding that there is such a lottery as the Louisiana State Lottery. If you find that this letter, Exhibit No. 1, was deposited in the mail, and that the papers in it are concerning a lottery in existence, the Louisiana State Lottery, you then come to the question, whether the defendant is shown to have deposited Exhibit No. 1 in the mail, as charged." The Court further charged the jury, that they must be satisfied, beyond a reasonable doubt, that the letter, Exhibit No. 1, was mailed, that the papers in it were concerning a lottery, and that the man who deposited it, or caused it to be deposited, was the defendant. The defendant excepted to that part of the foregoing portion of the charge which states that the occupation of the defendant is to be considered in determining whether the letter concerns a lottery, and that the jury may resort to surrounding circumstances to determine as to the character of the letter and circular; also, to the language, "that the evidence of the statute book and the sale of the tickets here prove that there is such a thing as the Louisiana Lottery."

Thereupon the Court further charged, that the evidence of the statute of Louisiana, and of the sale of tickets, was evidence from which the jury might conclude that there was

such a lottery, in the absence of proof to the contrary. To this further charge the defendant excepted.

That the defendant's occupation, of a dealer in lottery tickets, and the other extrinsic circumstances, were proper to be considered by the jury, on the question whether the letter related to a lottery, if, in their judgment, they threw any light on the meaning of the letter, in case its meaning was doubtful, which it does not seem to us to have been, we think there can be no question. A party's acts and declarations may always be resorted to to show the meaning of his writings, and obscure or doubtful expressions can often be elucidated only by a reference to surrounding circumstances.

There was no ground of exception in that part of the charge which, upon the question whether the letter was concerning a lottery, allowed the jury to consider the fact that there was such an Act on the statute book of Louisiana. In determining whether or not there was such a lottery as that named upon the papers enclosed with the letter, the fact that such an Act had been passed was a circumstance that was competent evidence. The tickets and papers enclosed were such as would be likely to follow and result from the passage and acceptance of such an Act, and, although there was no other evidence that the statute had been ever acted upon, these papers were, we think, some evidence of that fact, and there was a correspondence and apparent connection between the Act and the tickets and papers, which made the Act, without further evidence of any action taken under it, a circumstance tending to show that there was, in fact, such a lottery. As we have held above, the regularity of the organization of the Company, or the legality of the acceptance of the charter, or its continued legal existence, were wholly immaterial, and aside from the question in this case. In the particulars thus excepted to, we think the defendant has no just ground of complaint.

(13.) The judge also charged the jury as follows: "If you find that the accused received an order for two half tickets, such as were in the letter, Exhibit No. 1, together with two

dollars enclosed therefor, sent to him under a fictitious name, and if you find that Exhibit No. 1 was thereafter deposited in the post-office for mailing, and was a compliance with the order which the accused had received, those circumstances, together with the undisputed fact that the accused was engaged in selling lottery tickets, that the name used in the address of the letter in Exhibit No. 1 was the same as that signed to the order, and was fictitious, and that the letter was accompanied with tickets bearing his stamp and his business card, in the absence of evidence tending to show the contrary, will justify the conclusion that the defendant was the person who did deposit in the post-office, for mailing, the letter, Exhibit No. 1, or procured it to be so deposited." To this part of the charge the defendant excepted. The judge also, in the same connection, distinctly charged the jury, that this was a question of fact for them to pass upon, and that they should give the defendant the benefit of any reasonable doubt arising from the lack of sufficient evidence; that, if the evidence given on the part of the Government did not satisfy their minds on the disputed question of fact, they were to give him the benefit of the doubt; but that, if they were satisfied beyond a reasonable doubt, it was their duty to convict him. We think there was no error in this portion of the charge. The question of fact was fairly submitted to the jury, and the matters referred to by the Court were such as they had the right, and were bound, to consider, in determining that question.

(14.) The defendant's counsel requested the Court to charge as follows: "No presumption arises, in this case, from the impression of a post-office stamp upon the envelope enclosing either of the papers in evidence, as to the mailing of any or either of such papers." The Court refused so to charge, and the defendant excepted. The letters in question bore the stamp or mark of the New York post-office, and it is conceded that the general rule is that such a stamp or mark would be *prima facie* evidence that the letter had been in the mail; but, it is contended that no such presumption arises in this case, because there is evidence that the witness Comstock,

who testified that he took these letters from the mail, also testified, that he had received from the postmaster at Trenton, New Jersey, and other postmasters, during the past twelve months, a large number of empty envelopes, bearing the stamp of their post-offices, which had never been through the mail. The letter or order referred to in the charge to which the letter, Exhibit No. 1, appeared to be an answer, was testified to by the witness as being enclosed in such a stamped envelope, bearing the postmark of the Trenton office; and he testified that he delivered it to the superintendent of the registered letter department of the New York post-office, on the 6th of November, 1879, the day after its date, and the day before the date of Exhibit No. 1. The argument is, that this evidence shows such a deviation from the system of business on which this presumption rests, that the presumption fails. We think, however, that there is nothing in this evidence which controls, or prevents the application of, the general rule of evidence, that the regular postmark is presumptive evidence of the mailing of the letter. It does not show, as the defendant's counsel claims, any "gross irregularities on the part of officials of the post-office," or that "the supposed system is so disregarded as to be no system." Notwithstanding the occasional departures from the rule shown, which appears to have been in aid of justice, the general rule still remains, that the postmark is an indication that the letter offered in evidence has been through the mail.

Upon the whole case, therefore, we find no error upon the trial, and the motion for a new trial must be overruled.

Benjamin B. Foster, for the defendant.

Sutherland Tenney, (*Assistant District Attorney*,) for the United States.

APPENDIX.

I.

Rules.

Rule of the Circuit Court of the United States for the Southern District of New York, adopted since the publication of the sixteenth volume of these Reports.

November 22d, 1880.

The order made by this Court on the twelfth day of September, in the year of our Lord, one thousand eight hundred and seventy-nine, in relation to the drawing of jurors, is hereby amended so as to read as follows:

"In pursuance of the provisions of the Act of the Congress of the United States on the subject of the drawing of jurors, approved June 30th, 1879, Samuel D. Babcock, of the city of New York, is hereby appointed a Commissioner to discharge the duties prescribed by that Act, in this Court; and the said Commissioner and the Clerk of this Court shall, as soon as practicable after the entry of this order, place in a box the names of two thousand persons to serve as grand jurors and as petit jurors in this Court, each on a separate slip of paper, each of which persons shall possess the qualifications prescribed in section 800 of the Revised Statutes of the United States, being the qualifications set forth in sections 1,079, 1,086 and 1,029 of the Code of Civil Procedure of the State of New York, passed June 2d, 1876, the said Clerk and the said Commissioner each placing one name in said box alternately, commencing with said Clerk, without reference to party affiliations, until the said number of two thousand names shall have been placed therein. All jurors, grand and petit, to serve in this Court, shall be publicly drawn by the said Clerk from the said box, and from the names so placed therein; and, at the time of the drawing of any juror, the said box shall contain the names of not less than eight hundred persons, so placed therein. The said Commissioner and the said Clerk shall, from time to time, as may be necessary, place in said box, in manner aforesaid, the names of additional persons, or the same persons, or both, possessing said qualifications, so that the number of said names shall not, when any juror is drawn, be less than eight hundred nor more than two thousand. The box shall be locked and retained by the Clerk, and the key shall be kept by the Commissioner. The box shall be provided by the marshal. The Clerk shall post upon the outer door of the Clerk's office notice of the time and place of drawing jurors, at least five days prior to the drawing, except when jurors are summoned during a session of the Court."

INDEX.

A

ACTION.

See MILITARY ORDER, 2.

ADMIRALTY.

1. Where, in a suit *in rem*, in Admiralty, in the District Court, the claimant, after a decree for the libellant, appeals to this Court, and this Court decrees for the libellant for a sum sufficient to allow of an appeal by the claimant to the Supreme Court, which may be a supersedeas, no summary judgment can be rendered by this Court against the sureties in the appeal bond executed on the appeal to this Court, until after the expiration of ten days after the rendering of the decree by this Court. *The New Orleans*, 216

2. Where, in a suit *in rem*, in Admiralty, in the District Court, the libellant, after a decree dismissing the libel, appeals to this Court, and this Court dismisses the libel, and the sum claimed in the libel is sufficient to allow of an appeal by the libellant to the Supreme Court, which may be a supersedeas, no summary judgment can be rendered by this Court against the sureties in the appeal bond executed on the appeal to this Court, until after the expiration of ten days after the rendering of the decree by this Court. *The Jesse Williamson, Jr.*, 220

3. Where, in a suit *in rem*, in Admiralty, in the District Court, the claimant, after a decree for the libellant, appeals to this Court, and this Court decrees for the libellant for a sum not sufficient to allow of an appeal by the claimant to the Supreme Court, a summary judgment can be rendered at once by this Court against the sureties in the appeal bond executed on the appeal to this Court. *The Blanche Page*, 221

4. A collision occurred between a steamboat and a schooner, caused by negligence on the part of the former, without any design, neglect, privity or knowledge of her owners. She immediately took fire, and burned and sank in deep water, the fire being caused by the collision. She had a cargo, being carried on freight, which was totally lost. None of her pending freight was earned or received. She was raised and repaired. After that she was libelled, in Admiralty, in the District Court, by owners of part of the lost cargo. On a claim to her, she was appraised at $70,000, as her value after being raised and repaired, and she was released on a stipulation for that amount, purporting to be for the benefit of all persons having liens on her for losses by the collision. After decrees for the libellants, her owners petitioned the same District Court, for the benefit of a limitation of liability under the Act of March 3d, 1851, (9 *U. S. Stat. at Large*, 635.) That Court appraised her value, as she lay immediately after the collision and fire and before she was raised, at $2,500, and ordered that amount to be paid into Court. That was the value of the interest of the petitioners in her as she was immediately after the disaster. The value of that interest immediately before the collision was $70,000. At the time of the collision she was insured against fire, and her owners received, on such in-

surance, over $49,000. She was not surrendered or transferred to a trustee: *Held*,

(1.) The value of the interest of the owner of the steamboat, to be taken, under said Act, is not the value of her and her freight before the collision;

(2.) The valuation of $70,000 is not to be taken as the measure of the liability of such owner;

(3.) Such measure is the value of the steamboat in the condition in which she was immediately after the disaster, and not her value after she was raised and repaired;

(4.) Such value in this case was $2,500, with nothing added for freight;

(5.) After the collision, the value of the steamboat was not greater before the fire than after it;

(6.) The proceeds of the fire insurance ought not to be added to the appraised value of the steamboat;

(7.) It was proper for the District Court to restrain the libellants in the suits *in rem* from further prosecuting those suits or suits against the stipulators for the $70,000. *In re Norwich and New York Transportation Co.* 221

AFFREIGHTMENT.

See VESSEL.

ANSWER.

See PRACTICE, 1.

APPEAL.

See ADMIRALTY, 1 to 3.

ASSIGNEE.

See PROMISSORY NOTE, 1, 2.
TOWN BOND, 4.

ASSIGNMENT.

See DRAFT.

ATTACHMENT

See DRAFT.
BANKRUPTCY, 5.

B

BANK.

See NATIONAL BANK.

BANKRUPTCY.

1. An amended petition in involuntary bankruptcy cannot set forth, as part of the indebtedness to the petitioning creditor, a promissory note, endorsed by the debtor, which did not fall due until after the original petition was filed. *In re Morse*, 72

2. The District Court overruled a demurrer to an amended petition in involuntary bankruptcy, without prejudice to an application for leave to answer, on showing satisfactory cause therefor. Such application was promptly made, with the proposed answer duly verified, alleging defences which the debtor was entitled to try and prove, but the application was refused: *Held*, that, in analogy to the practice laid down in Rule 34 in equity, it ought to have been granted. *id.*

3. An assignee in bankruptcy brought a suit in equity against the voluntary assignee of the bankrupt to set aside a conveyance made by the bankrupt, within three months before the filing of the petition in bankruptcy, to the defendant, in trust for the benefit of all the creditors of the assignor, without any preferences: *Held*, that, as the direct effect of the conveyance, if upheld, would be to keep the property away from the operation of the bankruptcy law and from distribution by the Courts and officers of the United States, and to give it and its administration to a trustee selected by the debtor, the plaintiff was entitled, under § 5,129 of the Revised Statutes, as amended by the Act of June 22d, 1874, (18 *U. S. Stat. at Large*,

390,) to the relief asked. *Harding* v. *Crosby*, 348

4. The bankrupt is not a necessary party to such suit. *id.*

5. A. and U. were partners. L. had a partnership debt against them. A. transferred his interest in the partnership assets to U., and U. became his debtor therefor. U. became insolvent and assigned his property to M., for the benefit of his creditors. Afterwards, U. was adjudged a bankrupt and M. became his assignee in bankruptcy, and, as such, recovered the property. L. assigned his debt against U. to Q., and Q. and A. proved their claims against U., in bankruptcy. M., as assignee, had in his hands a dividend on the claim of A. Q. claimed to have attached such dividend by an execution on a judgment in a State Court against A. G. afterwards proceeded in the same manner with a debt of his against A. individually. G. then brought this suit to restrain the application of such dividend to the debt to Q. and to have it applied on the debt to G.: *Held*,

(1.) The dividend was not attachable on process from a State Court, and no Court but the Bankruptcy Court could order it to be paid to any one but A.;

(2.) If the dividend was attachable, this Court could not, by injunction, restrain the proceedings;

(3.) The jurisdiction given to the Circuit Court in bankruptcy matters does not warrant this suit;

(4.) The bill shows no ground for equitable relief;

(5.) If it did, A. should be a party to the suit. *Gilbert* v. *Lynch*, 402

6. K., having no funds in the hands of B., drew three drafts on B., and negotiated them to the plaintiffs. Before they were accepted by B., K. delivered to M., the agent of B., funds towards meeting the drafts, which M transmitted to B. B. then accepted two of the drafts, and paid them, but did not accept the third. The remainder of the funds was not enough to pay the third. The plaintiffs claimed the funds in the hands of B., while B. had them. Afterwards, K. was adjudged a bankrupt, and the defendants became his trustees in bankruptcy. B. delivered to them such remainder of the funds. The plaintiffs brought this suit to recover such sum: *Held*,

(1.) The money having been placed in the hands of B. expressly to provide for the drafts, and having been claimed by the plaintiffs, while it was in the hands of B., and before the bankruptcy proceedings, the plaintiffs were entitled to it;

(2.) The defendants acquired no greater right to the money than B. had to it. *Seligman* v. *Wells*, 410

BILL OF LADING.

See CARRIER, 7.

BOND.

1. Bonds were executed and issued in Canada, by a railway company, for the payment of money and interest thereon, secured by mortgage. By their terms, they were payable at the city of New York. Subsequently, an Act was passed by the Parliament of the Dominion of Canada, authorizing the company to issue new bonds, in substitution, bearing a lower rate of interest, and declaring that the assent of the holders of the old bonds should be deemed to have been given to the substitution. The plaintiff did not, in fact, assent, and sued the company to recover the interest on the old bonds held by him: *Held*, that he was entitled to judgment. *Gebhard* v. *Canada Southern R. R. Co.*, 416

2. Such Act is repugnant to the fundamental principles of justice. *id.*

C

CARRIER.

1. A person who ships cargo by a barge which he knows must be towed to her place of destination, is bound by the terms of towage which the barge agrees on with the tug which the barge procures to tow her. *The W. E. Gladwish*, 77

2. If the barge is sunk and the cargo is lost, by contact with ice, while the barge is being towed by the tug, the owner of the cargo must show negligence on the part of the tug, in order to recover against it for such loss. *id.*

3. It was held not to be negligence in the tug to keep on, after reaching ice, instead of lying by, or making a harbor; that the towing hawser was not too long; that the speed was not too great; that nothing could have been done by the tug to avoid the danger, when the obstruction which actually caused the loss was seen; and that the barge and the vessels in the tow with her were not improperly arranged. *id.*

4. To make the tug liable for keeping on, it must appear that the error was one which a careful and prudent navigator, surrounded by like circumstances, would not have made. *id.*

5. The judgment of witnesses as to speed, formed long after the event, and not based upon anything which specially attracted attention at the time, is rarely to be depended upon. *id.*

6. M. delivered to an Express Company, for transportation, a trunk, with contents of the value of $4,172, taking a receipt exempting the company from loss by fire and from liability beyond $50, "at which sum said property is hereby valued, unless the just and true value thereof is stated herein." The value of the trunk and contents was not stated in the receipt. Through the negligence of the employees of a railroad company employed by the Express Company to transport the property, it was destroyed by fire. In a suit by M. against the Express Company, for the value of the property: *Held*,

(1.) Common carriers cannot exonerate themselves from liability for the negligence of their own agents;

(2.) The Express Company is liable notwithstanding the stipulation against liability by fire;

(3.) The limitation of the liability to $50 is binding upon M., as a reasonable condition;

(4.) The Express Company is liable for $50, and for no more. *Muser* v. *Holland*, 412

7. The defendant, a railroad company, received from W. goods for transportation to Pittsburgh, giving W. a bill of lading containing a condition that the company should not be responsible for loss or damage by fire, unless it could be shown that such damage or loss occurred through the negligence or default of the agents of the company. On the arrival at Pittsburgh of the car containing the goods, a mob took possession of it, and continued to hold it against the military power of the State, and ultimately fired and destroyed the goods; *Held*, that W. must prove that the loss by fire arose from the negligence of the defendant or its agents, and that, in the absence of such proof, the defendant was not liable for the value of the goods. *Wertheimer* v. *Pennsylvania R. R. Co.*, 421

CHARTER-PARTY.

1. A charter-party for the voyage of a vessel from New York to Santa Cruz, (Canary Islands,) and thence to Havana, Cuba, provided that the respondents were to be allowed, for the loading and discharging of the vessel, "dispatch for loading at New York and discharging at Havana; thirty running days for discharging at Santa Cruz;" and that, if the vessel should be longer detained by the respondents, demurrage, at so much per day, should be paid, day by day, for every day so detained: *Held*, that the customs and rules of the port of Havana were not to control as to the time for discharging there, but that the respondents were bound to take the cargo, at Havana, as rapidly as the vessel could deliver it. *Sleeper* v. *Puig*, 36

2. By the rules of the port the cargo could be delivered only at the mole. The vessel came to anchor and was ready to deliver her cargo. There was no room for her at the mole. She was delayed till room was found: *Held*, that, under the terms of the charter-party, the risk of delay in ob-

taining a place of discharge at the mole, was on the respondents, and not on the vessel. *id.*

CIRCUIT COURT.

See PROMISSORY NOTE, 1, 2.
BANKRUPTCY, 5.
FEES.

CLERK.

See FEES.

COLLECTOR.

See DUTIES.

COLLISION.

1. A steamer must, in a fog, run at only such a speed as is consistent with the utmost caution; and she must, if possible, be kept under such control that she can be stopped after another vessel, with which she is in danger of collision, may be seen or otherwise discovered. *The Eleanora,* 88

2. A schooner sailing in the night, in a fog, in a common thoroughfare of approaching steam vessels, and heading on a course crossing their regular tracks, and hearing fog signals from them from various directions, was held in fault for not exhibiting a lighted torch, a collision having occurred between her and one of such steamers. *id.*

3. Nothing short of an absolute certainty that the torch could do no good, to be established by proof, will justify an omission to obey the rule. *id.*

4. The schooner was held in fault because, while on her port tack, she sounded one blast only at a time of her fog horn, instead of two blasts at a time. *id.*

5. The rule of the supervising inspectors of steam vessels on that subject, though it does not have the force of law as regards a sailing vessel, had become binding on the schooner, as a usage of the sea. *id.*

6. The schooner was held in fault for sailing short handed in a fog, having only two men on deck, one attending to going about, and acting as a look-out, and the other steering and blowing the fog horn. *id.*

7. A schooner and her cargo were lost by a collision with a steamer. The steamer being sued separately for the two losses, both vessels were held in fault. The damages for the loss of the schooner were apportioned between the two vessels. A decree was given to the owners of the cargo for the full amount of their loss; and a credit was allowed to the steamer, on the decree in favor of the schooner against her, for a sum equal to one-half of the decree in favor of the owners of the cargo. *id.*

8. As, in the suit by the schooner, both parties had appealed to this Court, the costs in this Court in that suit were equally divided between them. *id.*

9. Under Rule 4 of the statutory Navigation Rules, (*Rev. Stat.*, § 4.233,) requiring "steam vessels, when towing other vessels," to "carry two bright white mast-head lights vertically," and requiring that each of those mast-head lights shall be of the same character and construction as the mast-head lights prescribed by Rule 3, a steam tug, which has no mast, and cannot carry a light at her mast-head, must carry two bright white lights vertically, of a character to be visible five miles away, on a dark night, with a clear atmosphere, and so constructed as to show a uniform and unbroken light ahead, and from ten points on one side to ten points on the other, of the tug. *The Jesse Williamson, Jr.,* 106

10. Whether, if two lights, of a power equal to what is required for mast-head lights, are suspended vertically on the flag-staff at the stern of a tug, in such a manner as to show a uniform and unbroken light ahead over an arc of twenty points of the com-

pass, they would be the legal equivalent of two mast-head lights, *quere*. *id.*

11. If circumstances are such as to make it proper for a steam tug to keep a tow 400 or 500 feet behind her, she should be specially careful not only to notify approaching vessels that a tow is following, but, as near as may be, where it is. *id.*

12. Whether Rule IX of the board of supervising inspectors appointed under the authority of the Act of February 28th, 1871, (16 *U. S. Stat. at Large*, 440, *Rev. Stat.* §§ 4,405 *and* 4,412,) has the force of law in respect to the lights to be carried on canal boats and barges, while being towed by steam vessels, *quere*. *id.*

13. A large ocean steamer has no right to leave her moorings in a narrow slip crowded with other craft, by the use of her own propeller, without taking the utmost care to prevent accidents by the disturbance of the water which necessarily follows. *The Nevada*, 122

14. She must maintain complete control of herself, and, if she cannot get out by the use of her own propeller, without doing damage to other vessels that are lawfully moored near her, she must employ a tug. *id.*

15. In leaving the slip, she must keep a lookout astern, and over her side, into the slip, if necessary. *id.*

16. A steam tug moving in a slip, in a fog, and inside of the ends of the piers, is not required to sound her steam whistles, as a signal to a steamer moving up the river outside of the slip, and which runs into the slip and collides with her. *The Shady Side*, 132

17. A steamer running up a river in a fog mistook her way and ran into a slip at a speed which made it impossible for her to stop, so as to avoid a collision with a tug inside of the slip, after the tug came in sight, and was held in fault for not running at a moderate speed in a fog. *id.*

18. The tug having been sunk by the collision, the libellant procured her to be raised. She was sold to the libellant for $18, in a suit against her by the person who raised her. The libellant afterwards paid the charge for raising her, $600. The expense of repairing her, added to the cost of raising her and a reasonable demurrage, exceeded what would have been her value when repaired. This Court allowed the libellant $3,500, as her value at the time of her loss, as a total loss. The value of what was saved was sufficient to pay the expense of saving it, but no more; and the value of the tug when raised was equal to the expense incurred in searching for and raising her, but no more. *id.*

19. This Court allowed to the libellant his costs in the District Court, and, as the claimant had been partially successful on the appeal, it divided the costs in this Court. *id.*

20. A steamer collided with a sailing ship in the night, having changed her course and stopped and backed her engine, in an endeavor to avoid the collision. It appeared that, if the steamer had kept her course and speed, and the ship had done what she in fact did do, there would have been no collision. But, as the steamer had skilful officers, who exercised good judgment, in view of the appearances of, and changes in, the ship's lights, it was held that the steamer was not in fault. *The Adriatic*, 176

21. The ship sank with all on board, and the steamer was held not to have been in fault for her conduct after the collision, in respect to getting out her boats and proceeding on her voyage. *id.*

See ADMIRALTY, 4.

COMMON CARRIER.

See CARRIER.

CONSTITUTION OF THE UNITED STATES.

Article 3, § 2. 511
5th Amendment, 54
6th Amendment, 559

CONTRACT.

See EQUITY, 2 to 4.

CORPORATION.

See REMOVAL OF CAUSES, 15.

COSTS.

1. An allowance is not proper, in a bill of costs, in this Court, of a solicitor's fee for an overruled exception to a master's report, because, under Rule 84, in Equity, no standing rule has ever been made by this Court on the subject, and because no allowance for such fee is found in § 824 of the Revised Statutes of the United States. *Garretson* v. *Clark*, 256

See COLLISION, 8, 19.
PATENT, 9, 70.

COUPON.

See TOWN BOND.

CRIMINAL LAW.

1. The fact that an indictment against a person has been quashed because of insufficient averments is no ground for quashing an information subsequently filed by the District Attorney against the same person for the same offence. *United States* v. *Nagle*, 256

2. It is no objection to an information filed in open Court by the sworn assistant of the District Attorney, that the signature of the District Attorney to the information was written by such assistant by virtue of a general authority conferred upon him by the District Attorney. *id.*

3. An indictment under §§ 5,431 and 5,434 of the Revised Statutes, in setting out counterfeit notes, did not exhibit any imprint of the seal of the Treasury, while the notes put in evidence on the trial exhibited such imprint: *Held*, that there was no such variance as to make it improper to admit the notes in evidence. *United States* v. *Bennett*, 357

4. The notes were circulating notes of a national banking association, but the indictment, while setting them out at length, called them "national bank currency notes": *Held*, not a variance. *id.*

5. At the close of the evidence for the prosecution the defendant requested that one M. be called as a witness for the Government. He was not then called. Afterwards, and after the defendant had testified in his own behalf, M. was produced in rebuttal: *Held*, no error. *id.*

6. The circulating notes of a national banking association are valid contracts without having the imprint of the seal of the Treasury on them. *id.*

7. The indictment is not bad for not giving a fac-simile of the seal to which it refers, or for not setting out the numbers on the notes. *id.*

8. The indictment properly charges in different counts different offences, under §§ 5,431 and 5,434, for which different punishments are prescribed by those sections, the offences charged being of the same class of crimes, such joinder being permitted by § 1,024. *id.*

9. Whether the offences were "properly joined," under § 1,024, was a question to be determined on a motion to quash or to compel an election. *id.*

10. Where the defendant is convicted of the several offences charged in said indictment, he is, in effect, convicted on separate indictments, and may be separately punished for each offence proved. *id.*

11. The defendant was indicted under § 3,894 of the Revised Statutes. The 1st count alleged that he deposited in the mail a "letter and circular" concerning a lottery, setting it forth in *hæc verba*. The 2d count alleged that he deposited in the mail a circular concerning a lottery, and set forth what the circular purported to announce, but did not set it forth in *hæc verba*. After a verdict of guilty on both counts, the defendant moved in arrest of judgment, and for a new trial, on exceptions: *Held*,

(1.) Under the statute the same paper may be both a letter and a circular, and the paper deposited in this case was both;

(2.) The indictment need not state that the paper was one concerning a lottery "offering prizes;"

(3.) The omission, if any, in the first count, of averments to show the illegal quality of the paper, was a defect cured, after verdict, by § 1,025 of the Revised Statutes, as a defect of form, not tending to the prejudice of the defendant;

(4.) The paper set forth in the first count shows, on its face, that it is such a letter as is within the prohibition of the statute;

(5.) The second count is bad, because it does not set forth the circular *in haec verba*, and the defect is one which is not cured by said § 1,025, and one which can be availed of on a motion in arrest of judgment. *United States* v. *Noelke*. 554

12. In empanelling the jury, a juror was asked, by the defendant: "Have you any prejudice against the lottery business, or those who are engaged in it?" "Are you disposed, in your mind, to put an end to the traffic in lottery tickets?" "Are you in favor of active measures for the suppression of the lottery business?" The questions were successively excluded. The juror had before testified that he knew nothing about the case, and he afterwards testified that he had heard nothing and read nothing, and had not talked with any one, about the prosecution of lottery dealers, and that he felt that he could decide the case by the evidence, without prejudice. He was sworn as a juror: *Held*, that affirmative answers to the three questions would not have been ground for rejecting the juror. *id.*

13. Other papers enclosed in the same envelope with the paper set forth in the first count, were admissible in evidence, as they tended to show that said paper related to a lottery, and were part of the *res gestæ*. *id.*

14. It was proper to allow a witness to testify that he visited the place of business referred to in the paper set forth in the first count, a few days after the paper was deposited in the mail, and saw lottery tickets sold there by the defendant's clerk, and that the defendant stated to the witness that the clerk was in his employ, and that that was his business, and that the witness then saw there papers with the same stamp on them as that on the paper enclosed in said envelope. *id.*

15. After the testimony for the prosecution had been closed, the defendant objected that no evidence had been introduced tending to show the existence of a lottery. The Court granted time to supply such proof: *Held*, that the matter was within the discretion of the Court. *id.*

16. The Act of the Legislature of Louisiana, passed August 11th, 1868, (*Laws of* 1868, *p.* 24,) on the subject of lotteries, is a public Act, and provable by the introduction of a volume of the Laws of 1868, purporting to have been published by authority. *id.*

17. It was not necessary for the prosecution to prove that the lottery had a legal existence, or that the company carrying it on was a corporation. *id.*

18. The occupation of the defendant, the passage of said Act, and other extrinsic circumstances, were proper to be considered by the jury on the question whether the letter related to a lottery. *id.*

19. Matters stated which the jury had a right, and were bound, to consider, in determining the question whether the defendant was the person who deposited, or caused to be deposited, in the mail, the letter in question. *id.*

20. The general rule of evidence is, that a postmark is presumptive evidence of the mailing of a letter, and such rule is not displaced by showing that envelopes not mailed have been stamped with a given postmark. *id.*

See INDICTMENT.
INVOLUNTARY SERVICE.

CUSTOMS.

See FORFEITURE.
VESSEL.

D

DAMAGES.

See COLLISION, 18.
PATENT, 39 to 45.

DISTILLERY.

See INTERNAL REVENUE.

DRAFT.

1. A bank in Missouri, having money on deposit in a bank in New York, to the amount of over $2,000, drew a draft on the latter on August 1st, for the sum of $1,998, to the order of R., for which R. paid the former $2,000. On the 3d of August, the Missouri bank assigned to C. all its property, in trust for its creditors, by an assignment valid by the laws of Missouri, and the New York bank was notified of such assignment on the same day. On the 5th of August the draft was presented by R. to the New York bank. Payment of it was refused. R., on the 5th of August, attached the money held by the New York bank, by judicial process, in a suit against the Missouri bank, on the draft, and afterwards recovered a judgment therein. He then brought this suit against the two banks and C., to have the $1,998 paid to him. On a demurrer to the bill: *Held*, that the right of C. to the money was superior to that of R. *Rosenthal* v. *Mastin Bank*, 318

2. The draft was not accepted by the drawee, nor charged by it against the drawer, nor did the draft operate as an assignment of the funds of the drawer in the hands of the drawee. *id.*

DUTIES.

1. One entry was made at the custom house of fruit imported in a vessel, which fruit belonged to several owners, and was embraced in several invoices. The duties were estimated at $4,648 and deposited and the goods were delivered. Afterwards a damage allowance for loss by decay on the voyage was applied for. The report showed that the damage sustained by various lots of the fruit was more than 25 per cent. of the quantities in such lots, but that the damage on all the fruit imported by the vessel was less than 25 per cent. of the whole quantity. The collector, by allowing the damage on the lots which were damaged more than 25 per cent., liquidated the duties at $270 40 less than the amount deposited, and refunded the $270 40. Afterwards the collector reliquidated the duties at $4,648, refusing to allow any damage, because it did not exceed 25 per cent. of all the fruit covered by the entry. The United States having sued, in the District Court, to recover the $270 40, that Court directed a verdict for the defendants. On a writ of error: *Held*,

   (1.) That, under § 2,931 of the Revised Statutes, the first liquidation was not conclusive as to the United States;

   (2.) That the United States were entitled to recover according to the last liquidation;

   (3.) That the defendant could not be allowed to give evidence to show that the decision of the collector in the last liquidation was erroneous;

   (4.) That the District Court ought to have directed a verdict for the United States. *United States* v. *Phelps*, 312

See VESSEL.

E

ENDORSER.

See PROMISSORY NOTE, 1 to 3.

EQUITY.

1. Mere delay in enforcing equitable rights is not a defence to a suit, except in cases where the statutes of limitation apply, or where the party has slept upon his rights, and acquiesced for such a length of time that his claim has become stale. *Williams* v. *Boston & Albany R. R. Co.*, 21

2. A mutual life insurance company issued to B. and to H. a policy insuring the life of B. for the benefit of H., for

a premium to be paid on a specified day, annually. By the policy, it was to become void if B. should become so far intemperate as to impair his health. The premiums were paid for 6 years. Two months after the last payment the company cancelled the policy because it learned that B. had become so far intemperate as to impair his health, and notified H. of such cancellation, and offered to pay the surrender value of the policy. H. refused to recognize such cancellation, or to surrender the policy, and tendered to the company the annual premium every year, the tender being always refused. The company filed a bill in equity against H., praying that the policy be declared null, and be surrendered on payment of its surrender value. On demurrer: *Held*, that the bill would lie. *Connecticut Mutual Life Ins. Co.* v. *Home Ins. Co.*, 142

3. A Court of equity will exercise its power of setting aside contracts for defects not apparent on their face, although such defects arose after the execution of the contracts, in cases where special circumstances render it inequitable or unjust, or a hardship, to compel the plaintiff to await a suit at law at the instance of the other party. *id.*

4. The rule, that a Court of equity will not aid to enforce a forfeiture, or to divest an estate for breach of covenant or condition subsequent, is not applicable to the cancellation of a policy of insurance on the life of a living person. *id.*

See BANKRUPTCY, 3, 5.
MORTGAGE, 2.
PATENT, 18, 19, 25, 27, 29 to 38, 78, 82.
PRACTICE, 3, 4.
TRUST.

ESTOPPEL.

1. The defendant, owning an interest in a patent, conveyed such interest to the plaintiff. Afterwards, the defendant continued to practice the invention, and he acquired a prior patent, which he alleged covered the same improvement. In a suit in equity against him by the plaintiff, for infringement: *Held*, that he was estopped, by his conveyance, from denying the validity of the patent, and that the acquiring by him of the prior patent enured to the benefit of the plaintiff. *Faulks* v. *Kamp*, 432

See PATENT, 14, 15, 19.

EVIDENCE.

1. On the question of the novelty of the invention claimed in a patent sued on, the file wrapper and its contents of another patent are not competent evidence to show the date of the making of the invention shown in the latter patent. Such evidence is hearsay and secondary, and the reduction to practice and use of the invention alleged to invalidate the patent sued on must be shown by direct evidence of the construction and use of a structure embodying such invention. *Howes* v. *McNeal*, 396

See CRIMINAL LAW, 5, 18 to 20.
NEW TRIAL, 1, 2.
PATENT, 2, 3*a*, 43, 53, 54.

EXECUTOR.

See TRUST.

EXPRESS COMPANY.

See CARRIER, 6.

F

FEES.

1. It is proper for the clerk of this Court, instead of certifying the result of a search for liens on the original requisition delivered to him, to file such requisition and give a certificate of the result of the search on another paper. *In re Woodbury*, 517

2. A charge of 10 cents for filing such requisition is proper. *id.*

3. A charge of 15 cents for each person against whom a search is required to be made is proper, as a compensation for making the search, and for the act of signing the certificate and certifying the result. *id.*

4. A compensation of 15 cents per folio for making the certificate is proper. *id.*

5. No charge for affixing the seal of the Court to the certificate is proper unless it is required. *id.*

FIRE INSURANCE.

See ADMIRALTY, 4.
INSURANCE, 2 to 5.

FORFEITURE.

1. Under § 1 of the Act of March 3d, 1863, (12 *U. S. Stat. at Large*, 737, 738, *Rev. Stat.*, § 2,864,) forfeiting imported goods, or their value, to the United States, for fraud in the entry of the goods at the custom house, if a suit is brought for such value, such value is not limited to the sum which the defendant received for the identical goods entered, on their sale by him. *United States* v. *York Street Flax Spinning Co.*, 138

See INTERNAL REVENUE.

FORMER SUIT.

See PATENT, 73.

G

GUARDIAN.

1. L., in 1855, was appointed by the Surrogate of Richmond county, New York, guardian of the person and estate of S., an infant 4 years of age. He accepted the trust, and gave a bond, and took possession of money and other property of S. L. was, at the time, a citizen of Georgia, and S. was a citizen of Alabama, temporarily residing in New York. In 1861, the war of the rebellion occurred between the United States and those two States. L. having died, and never having accounted to said Surrogate, S., having become of age, brought this suit, in 1875, against L.'s executor, for an account. He set up, in defence, that L. and S. aided the rebellion, which lasted 4 years; that the property of L. and of S. was liable to confiscation by the United States; that L. could not, during the war, account to said Surrogate; that, by the war, the relation of guardian and ward ceased, in respect to such accounting; that L., at the request of S. and her natural guardians, all citizens of Alabama, withdrew her funds from New York and invested them in securities authorized by the laws of Georgia and Alabama and of the Confederate States; that, in 1867, he accounted with M., who had been appointed the legal guardian of S., by the proper Court in Alabama, where she then resided, and received from him a release; that S., when she became of age, ratified such release; and that the plaintiff is the sole legatee of S. and ratified all the acts of L.: *Held*,

(1.) Notwithstanding the war, S. had, after its termination, a right to call on L. to account;

(2.) It is no defence, that L. made the investments he did to prevent the property of S. from being confiscated;

(3.) Although the appointment of the new guardian in Alabama was proper, and the defendant must be credited with what L. paid to the new guardian, he was still liable to account in this suit, notwithstanding the new guardian had given L. a full discharge, on receiving the said securities in which L. had invested the funds of S., the defendant being credited with anything realized from such securities;

(4.) Ratification by S. is not proved;

(5.) The plaintiff, before the death of S., had no such interest as would make her acts and admissions binding on her when she afterwards became administratrix of S.;

(6.) L. took the risk of the unlawful investments, and must make good what he received, with interest and annual rests. *Micou* v. *Lamar*, 378

I

INDICTMENT.

1. An indictment purporting to be founded on § 5,346 of the Revised Statutes, charging the commission of an assault with a dangerous weapon, on board a vessel belonging in whole or in part to a citizen of the United States, alleged the assault to have taken place "in the harbor of Guantanamo, in the Island of Cuba," but did not allege that that place was out of the jurisdiction of any State of the United States: *Held*, upon the authority of *United States* v. *Jackelow*, (1 *Black*, 484,) that the indictment was bad, for want of such allegation *United States* v. *Anderson*, 238

See CRIMINAL LAW, 1 to 4, 7 to 10, 11.

INFORMATION.

See CRIMINAL LAW, 1, 2.

INJUNCTION.

1. An injunction will not be granted to restrain a defendant from proceeding in the State Court in a cause which the plaintiff claims has been removed into this Court, although the jurisdiction of this Court over the cause is clear, and the State Court has refused to make an order for the removal of the cause, and the defendant has noticed the cause for trial in the State Court. *Penrose* v. *Penrose*, 332

2. Such injunction is not required to uphold the jurisdiction of this Court over the cause. *id.*

See ADMIRALTY, 4.
BANKRUPTCY, 5.
PATENT, 20, 22, 23, 27, 28, 113.

INSURANCE.

1. Clauses in an open uniform canal cargo policy of insurance construed, in such manner as, the insurance being to the amount of $8,000 on goods worth $20,000, and the loss being $9,378 01, the liability of the insurer was held to be only for two-fifths of the loss, and not for the $8,000. *Breed* v. *Providence Washington Ins. Co*, 287

2. A party in possession of insured premises under a valid subsisting contract of purchase, is the equitable owner, and has an insurable interest, although he has not paid the whole consideration money; and he is not guilty of a misrepresentation if he represents the premises as his, when he applies for insurance. *Rumsey* v. *Phœnix Ins. Co.*, 527

3. Where such a party, in applying for insurance, states that he wishes his house insured, without stating specifically the nature of his interest he does not omit to make known a fact material to the risk. *id.*

4. A letting of an insured house to tenants is not a change of possession. *id.*

5. The receiving and returning proofs of loss, and repudiating all liability on the policy to the person entitled to demand payment, is a waiver of any imperfections in such proofs. *id.*

See ADMIRALTY, 4.
EQUITY, 2 to 4.

INTEREST.

See BOND.
PATENT, 38.

INTERNAL REVENUE.

1. Under that part of § 3,281 of the Revised Statutes which forfeits personal property owned by a person who has permitted or suffered his premises to be used for purposes of ingress or egress to or from an illicit distillery, it is necessary, in order to such forfeiture, that such person should have known that the ingress or egress over his premises was to or from a distillery. *Gregory* v. *United States*, 525

INVOLUNTARY SERVICE.

1. What it is to "inveigle," and what it is to "hold to involuntary service," under the Act of June 23d, 1874. (18 *U. S. Stat. at Large*, 251,) defined. *United States* v. *Ascarola*, 423

2. An arrangement made in Italy, which contemplated the delivery of a child to the defendant, to be by him brought to the United States for the purpose of being employed there as a beggar or a street musician, the child being entied in Italy to consent to such arrangement, *held* to have been an inveigling of the child in Italy, under that statute. *id.*

3. An intention in the defendant, in bringing the child to the United States, to employ him as a beggar, or as a street musician, for his own profit, if such employment would be injurious to the morals of the child and inconsistent with its proper care and education according to its condition, is an intention to hold the child to involuntary service, although the child consented in Italy to the employment, and although it be not shown that the child subsequently dissented, while under the control of the defendant. *id.*

J

JUDGMENT.

1. A judgment entered in 1872, on an assessment of damages, on a default, was opened in 1880, to allow evidence to be given of payments made by one of the defendants, or out of his property, which should have been allowed, and deducted from the assessment, when the judgment was entered. *United States* v. *Millinger*, 451

See ADMIRALTY, 1 to 3.
PRACTICE, 2.

JURISDICTION.

See BANKRUPTCY, 5.
INJUNCTION.
PATENT, 79.
PROMISSORY NOTE, 1, 2.
REMOVAL OF CAUSES, 1.

L

LIFE INSURANCE.

See EQUITY, 2 to 4.

LIMITATION OF LIABILITY.

See ADMIRALTY, 4.

M

MASTER.

See PATENT, 29.

MILITARY ORDER.

1. An officer of the army of the United States, assigned to the command of a military district created by the Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 428,) had no authority, as military commander, to issue an order to the sheriff of a county, requiring him to place a person in possession of a plantation and personal property which were, at the time, in possession of another person. *Whalen* v. *Sheridan*, 9

2. But, where he issued such an order, on the application of H., who claimed to be the true owner of the property, and was sued by W., who was dispossessed by the execution of the order, for damages for such dispossession, it was held that he could justify under such order if H. was the true owner and was entitled to the possession. *id.*

MORTGAGE.

1. By the law of Connecticut, the right of a mortgagee of land to foreclose the mortgage, or to sue to recover possession of the land, is barred, if the mortgagor has been permitted to remain in possession of the land for 15 years at least, without paying any part of the debt or recognizing the mortgage. *Fox* v. *Bosson*, 352

2. A second mortgagee of the same land, out of possession, can bring a suit in equity against the first mortgagee, out of possession, and the mortgagor in possession, to have the first mortgage cancelled, on the ground of the bar of such statute. *id.*

N

NATIONAL BANK.

1. A purchaser of stock in a national bank, who, to conceal his ownership and escape individual responsibility, causes it to be transferred to another person pecuniarily irresponsible, is, so long as he remains the actual owner, a shareholder, within the meaning of § 12 of the Act of June 3d, 1864, (13 *U. S. Stat. at Large*, 102,) now §§ 5,139 and 5,151 of the Revised Statutes of the United States, and liable as such. *Davis* v. *Stevens*, 259

See CRIMINAL LAW, 6.

NAVIGATION.

See CARRIER, 1 to 5.
COLLISION.

NEGLIGENCE.

1. D., while on the deck of a steamship belonging to the defendant, arranging in the hatch the pipe of a grain elevator, stepped upon a section of the grating of the hatch, which, not being properly placed in the groove in which it was intended to fit, tilted under his weight, and he fell through the hatchway and was killed. D. was in the employ of the owner of the elevator, who had a contract with the defendant to put the grain into the hold of the steamer. A stevedore had a contract with the defendant to load the steamer. It did not appear when or by whom the grating was negligently placed: *Held*,
(1.) It was no part of the defendant's duty to maintain a safe covering on the hatchway;
(2.) That, if the stevedore's men improperly placed or displaced the grating, the defendant was not responsible for their acts. *Dwyer* v. *National Steamship Co.*, 472

See CARRIER, 1 to 5.

NEW TRIAL.

1. Evidence which counsel did not, on a trial, think would be material, and did not know of and so did not obtain, although it might easily have been discovered, will not, generally, be allowed to furnish ground for a new trial, although its materiality may arise from the views of the Court in deciding the cause. *Codman* v. *Vermont & Canada R. R. Co.*, 1

2. A motion for a new trial, because of alleged newly discovered evidence, denied, on the ground that such evidence was merely cumulative. *Whalen* v. *Sheridan*, 9

3. After the Court has heard and denied a motion for a new trial, in a suit at law, and a judgment has been rendered and paid and satisfied, it has no power to grant leave to re-argue the motion for a new trial. *Smith* v. *Town of Ontario*, 240

4. The decision in *Smith* v. *The Town of Ontario*, (15 *Blatchf. C. C. R.*, 267,) commented on. *id.*

NOTARY.

See PROMISSORY NOTE, 3.

P

PARTY.

See BANKRUPTCY, 4, 5.
PATENT, 25.

PATENT.

1. Invention,
2. Novelty, (1, 2.)
3. Abandonment.

4. Application.
5. Specification.
6. Duration, (3 to 8.)
7. Disclaimer, (9 to 12.)
8. Re-issue.
9. Assignment.
10. License, (11 to 17.)
11. Suit in Equity, (18, 19.)
12. Infringement, (20 to 26.)
13. Injunction, (27, 28.)
14. Profits, (29 to 38.)
15. Damages, (39 to 45.)
16. Particular Patents.
(1.) Williams — Locomotive lamp, (46 to 50.)
(2.) Ingalls — Post-Office stamp, (51 to 58.)
(3.) Heath — Cuspadore, (59 to 62.)
(4.) Christman — Pump-filter, (63 to 70.)
(5.) Severance — Rock-drill, (71 to 75.)
(6.) Littlefield — Stove-cover hinge, (76 to 79.)
(7.) Blackman — Lamp, (80 to 83.)
(8.) Quirolo — Stereoscope, (84, 85.)
(9.) Brown — Baling short cut hay, (86.)
(10.) Adair — Pump, (87, 88.)
(11.) Root — Clock-dial, (89.)
(12.) Page — Induction coil apparatus and circuit-breaker, (90 to 104.)
(13.) Slawson — Fare-box, (105, 106.)
(14.) Giant Powder Co. — Explosive compound, (107 to 113.)
(15.) Hoe — Lithographic printing press, (114 to 121.)

1. *Invention.*

See 47, 85, 86, 89, 91, 98 to 100, 105, 106, 110 to 112, 115, 117.

2. *Novelty.*

1. A concrete pavement, made of cement, sand and gravel, made plastic by water and then laid in blocks, in a plastic state, at the place where it is to be used, and suffered to set or harden there, is not anticipated by a pavement made of blocks of cement made elsewhere, and then laid, like bricks or flags, at the place of use. *Schillinger* v. *Gunther*, 66

2. The burden of proof is on a defendant, to establish, by satisfactory evidence, the prior use of a patented invention. *Parker* v. *Remhoff*, 206

See EVIDENCE, 1.
49, 54, 69, 83, 84, 86, 99 to 101, 120.

3. *Abandonment.*

See 18, 102, 103.

4. *Application.*

See 116.

5. *Specification.*

See 67, 87, 94, 96, 121.

6. *Duration.*

3. Letters patent for an invention were granted in England, dated September 3d, 1862. The specification was filed in the Great Seal Patent Office there, March 3d, 1863. Letters patent for the same invention were granted by the United States, July 14th, 1863, for 17 years. The date of the application for the United States' patent was not shown: *Held*,
(1.) That the date of the filing of the specification in England must be taken as the date of the patenting in England, for the purposes of § 6 of the Act of March 3d, 1839, (5 *U. S. Stat. at Large*, 353;)
(2.) That the invention was, therefore, not patented in England more than six months before the United States patent was applied for, and so the Act of 1839 did not apply, and the United States' patent was valid for 17 years from July 14th, 1863. *American Diamond Rock Boring Co.* v. *Sheldon*, 303

3*a*. The burden of proof is upon a party who claims that a patent should be limited in duration, to show the facts which would limit it. *id.*

4. Re-issued letters patent were granted to Moritz Pinner, as assignee of Jean Bouvet, as inventor, November 1st, 1864, for 17 years from June 28th, 1864, for an improvement in metal cans for preserving food, the

original patent having been granted to Pinner, June 28th, 1864, for 17 years from that day. In June, 1878, in this suit, brought for the infringement of said re-issue, an interlocutory decree was made, for an account of profits and a perpetual injunction. Afterwards, the defendants moved for leave to introduce in evidence, for the first time, a prior patent, granted in France, to Bouvet, for the same invention, and to amend the answer for that purpose, with a view to limit the duration of the plaintiff's patent to the term of 17 years from the date of the French patent. The French patent consisted of (1) a patent, "taken" November 30th, 1861, for 15 years; (2) a certificate of addition, "taken" December 21st, 1861; (3) another certificate of addition, "taken" November 27th, 1862. Under the French law, the 2 certificates of addition expired with the original French patent, namely, at the end of 15 years from November 30th, 1861, and the 2 certificates of addition had effect, as patents, respectively, from December 21st, 1861, and November 27th, 1862. The 2d certificate of addition, in connection with the original and the 1st certificate, patented the same invention covered by said re-issue: *Held*, that said re issue was valid, for the purposes of said injunction, only for 17 years from November 27th, 1862, and that said motion ought to be granted. *De Florez* v. *Raynolds*, 486

5. The French patent law of July 8th, 1844, examined and explained. *id.*

6. The defendants held not to have been guilty of laches in not sooner making the motion, but the case not to be regarded as a precedent for the case of an application to set up a defence to defeat a patent for want of novelty. *id.*

7. The successive statutes of the United States as to the duration of patents, examined. *id.*

8. The effect of § 16 of the Act of March 2d, 1861, (12 *U. S. Stat. at Large*, 246,) providing that all patents thereafter granted should remain in force for the term of 17 years from the date of issue, and prohibiting all extension of such patents, was, to limit the duration of a United States' patent for an invention previously patented abroad to the same inventor, to the term of 17 years from the date when the foreign patent had effect, as a patent, in his favor. *id.*

7. *Disclaimer.*

9. Under §§ 4,917 and 4,922, of the Revised Statutes, where a proper disclaimer is entered during the pendency of a suit on a patent, there may be a recovery for the plaintiff, in respect of what is not disclaimed, provided there has been no unreasonable neglect or delay to enter a disclaimer, but the recovery is to be without costs. *Schillinger* v. *Gunther*, 66

10. There may be a disclaimer of something which was introduced into a re-issued specification and did not exist in the original specification. *id.*

11. In connection with a disclaimer of a claim or part of a claim, it is not improper to eliminate or withdraw, by the same writing, the parts of the body of the specification on which the disclaimed claim or part of a claim is founded. *id.*

12. The disclaimer in this case upheld, against the objection that the matter disclaimed was not introduced by mistake, but with the intent to defraud or mislead the public. *id.*

See 70.

8. *Re-issue.*

See, 10, 55, 64 to 66, 72, 75, 81, 82, 104, 109.

9. *Assignment.*

See 13 to 17, 55 to 57.

10. *License.*

13. A written license under a patent stated that the patent was "lawfully granted," and provided for the revocation of the license by the licensor, for non-payment of royalty, and de-

clared that such revocation should not impair "the effect of the admission of the validity" of the patent. The licensor revoked the license for said cause and then sued the licensee in equity, for an account and the payment of the royalty which accrued prior to the revocation. The licensee set up that the patent was void, for want of novelty, and that he had never paid any royalty under the license. The plaintiff moved for a decree on the bill and answer and an affidavit, and the defendant put in counter affidavits: *Held*, that, under Rule 90, in Equity, the English practice in 1842 must be followed, and not any later English practice; that the affidavit could not be considered; but that the case should be heard on bill and answer. *Evory* v. *Candee*, 200

14. *Held*, also, that the licensee was estopped, by the terms of the license, from setting up the invalidity of the patent, as a defence. *id.*

15. The licensee also set up a parol agreement, made before the written license, reserving to the licensee a right to use the invention without royalty, if he should become satisfied that the patent was void. After the time when such parol agreement was alleged to have been made, the licensee himself drew said written license: *Held*, that he could not be allowed to set up such parol agreement. *id.*

16. Three instruments relating to rights under letters patent, and none of them purporting to grant anything more than a license, were executed between the same parties contemporaneously and as parts of the same transaction. One of them was recorded in the Patent Office and the other two were not. A person having purchased the right covered by the recorded instrument, *bona fide*, and without notice of the unrecorded instruments: *Held*,

(1.) That the recorded instrument was one not required by § 11 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 121,) to be recorded;

(2.) That the unrecorded instruments were not required by that statute to be recorded;

(3.) That the instruments were all of them valid as against such purchaser, without being recorded;

(4.) That such purchaser acquired no greater rights than were conveyed by all three of the instruments, construed together. *Hamilton* v. *Kingsbury*, 264

17. Where L., the transferee of a right under letters patent, transferred to another only his right, title and interest, K., who subsequently acquired such interest, is chargeable with notice of what he might have learned as to the true extent of such interest, by enquiring of H., named in the transfer from L. as the grantor to L., although the transfer from L. stated the interest in L. as being greater than it really was, H. not being a party to such transfer. *Hamilton* v. *Kingsbury*, 460

See 44, 45.

11. *Suit in Equity.*

18. A defence in a suit in equity, that the patentee has, since he obtained his patent, abandoned or dedicated it to the public use, must be set up in the answer. *Williams* v. *Boston & Albany R. R. Co.*, 21

19. R. having sued F., in equity, for the infringement of a patent, F., in writing, admitted R's right, and agreed on the damages to be paid, and to consent to a decree therefor and for a perpetual injunction. Such consent was given and the decree was entered, the damages were paid, and the injunction was issued. Many terms of Court having elapsed since the entry of the decree, F. applied for leave to file a supplemental bill, to set aside the decree, on the ground that the agreement was entered into under a mistake of fact: *Held*,

(1.) That the application was really to file a bill of review and was too late under Rule 88, in Equity;

(2.) That, the decree having been entered by consent, a bill of review to set it aside could not be entertained;

(3.) That the agreement operated as an estoppel. *In re Pentlarge*, 306

See EQUITY, 1.
9 to 13, 24, 25, 27, 29 to 38, 78.

12. *Infringement.*

20. The plaintiff was the owner of patents covering improvements in metallic cotton ties, consisting of buckles and hoops, for compressing bales of cotton. Neither the plaintiff nor any prior owner of the patents had granted any licenses to make buckles or ties, but they had made and sold the ties. The buckles were stamped, "Licensed to use once only," and were sold with invoices declaring that the ties were licensed to be used once only, as baling ties. The defendant bought the buckles so once used, from cotton mills and junk dealers, and put up some with new hoops, and some with pieces of the original hoops pieced together, and sold them as cotton ties: *Held*, that the defendant had infringed the patents, and ought to be enjoined from further infringement. *American Cotton Tie Supply Co.* v. *Bullard*, 160

21. A patent for making a protuberance from the inside on the outer surface of the rim of the cover of a box, and a like protuberance from the inside on the outer surface of the rim of the box, so that, when the cover closes on the box, the projection on its rim will snap over the projection on the box, and thus form a fastening, is infringed where, instead of the protuberance on the cover, a hole is made in the cover. *Parker* v. *Remhoff*. 206

22. Cotton ties made in infringement of patents owned by the plaintiff were being shipped from New York to ports in the southern part of the United States, by steamers belonging to a corporation of which the defendants were the managing officers, for persons whose names they refused to disclose to the plaintiff, the ties being shipped to be sold at such ports for use: *Held*, that such carrying of such ties by said steamers was an infringement of the patents, and that such officers would be restrained by an injunction from doing so. *American Cotton Tie Supply Co.* v. *McCready*, 291

23. Under § 4,921 of the Revised Statutes, the Court has power to enjoin the infringement of a patent, independently of the award of any other relief thereon. *id.*

24. Seats embodying a patented invention were bought by the Board of Education of the city of New York for the use of the schools of the city, and were used in such schools, such Board being a corporation created by the State, having exclusive charge of such schools: *Held*, that the city, in its corporate capacity, was liable, in a suit in equity, for the infringement of the patent. *Allen* v. *The Mayor*, 350

25. The Board of Education is a proper party to the suit and is also liable for the infringement. *id.*

26. A man worked for the defendant by the piece, in the defendant's manufactory, and there used, in the defendant's business, folding guides, his own property, which infringed the plaintiff's patent: *Held*, in a suit in equity, that the defendant had infringed the patent. *Wooster* v. *Marks*, 368

See ESTOPPEL.
29 to 38, 50, 58, 68, 74, 88, 92, 93, 95, 108.

13. *Injunction.*

27. Grounds stated for granting a preliminary injunction, although the patent had been held void, on final hearing, in another Circuit Court. *U. S. Stamping Co.* v. *King*, 55

28. The defendant had, under an Act of the Legislature of Florida and an Act of the Congress of the United States, the exclusive right to lay and maintain a submarine telegraph cable between Florida and Cuba. In operating such cable it used an invention covered by letters patent owned by the plaintiff, granted after said Acts were passed: *Held*, that, although the plaintiff could not use the invention for telegraphic purposes between Florida and Cuba, he could enjoin the defendant from using such invention for such purposes between

such *termini*. *Colgate* v. *International Ocean Telegraph Co.*, 309

See 20, 22, 23, 113.

14. *Profits.*

29. A Court has power to set aside a report of a master for any manifest error either in law or fact, and to recommit it for further proceedings, or to correct it, if the means of correction are furnished. *Steam Stone Cutter Co.* v. *Windsor Mfg. Co.* 24

30. The principle stated, upon which gains and profits are recovered from an infringer, in a suit in equity. *id.*

31. Where infringing machines have been made and sold for profit by the infringer, the plaintiff is entitled to whatever of that profit arose from appropriating the patented inventions by making and selling those machines, although other infringing machines were disposed of by the infringer without profit, or are still on hand and cannot be disposed of, involving loss to the infringer. *id.*

32. The value of the use of real and personal estate belonging to the infringer, such as shops, fixtures and machinery, including repairs, employed in making the machines made and sold for profit, is to be allowed as part of their cost. *id.*

33. The amount paid for insurance on such property, the insurance being for the safety of the property generally, and not for the benefit of the manufacture of those machines, is not to be allowed as part of their cost; nor is the amount paid for local taxes on such property. *id.*

34. The infringer being a corporation, salaries paid to stockholders in it employed in making those machines, such salaries having been paid in good faith, for services actually rendered, and not as a mode of dividing profits, or for the purpose of concealing profits, are to be allowed as part of the cost of those machines. *id.*

35. Where a portion of the prices at which those machines were sold was due to an arrangement of the boiler in the machine, different from the plaintiff's, but the defendant had no monopoly of such arrangement, such portion of the price being allowed to the plaintiff, the cost of the workmanship is to be allowed to the infringer. *id.*

36. Where $750 of the price at which each of those machines was sold was due to a patented improvement of the infringer, called a bow-spring, attached to and sold with the machine, no part of the $750 is to be allowed to the plaintiff, and no part of the cost of making the bow-spring is to be allowed to the infringer. *id.*

37. The infringer had incurred liabilities on guaranties and warranty of title, as to those machines, but nothing is to be deducted on that account from the avails of their sales, because those liabilities will be extinguished by satisfying the plaintiff's recovery as to those machines. *id.*

38. Interest on the profits decreed was charged against the infringer from the time of the entry of the interlocutory decree. *id.*

15. *Damages.*

39. Reduction of prices and consequent loss of profits, caused to a patentee by the competition of an infringer, is a proper ground for awarding damages against the infringer. *Sargent* v. *Yale Lock Mfg. Co.*, 244

40. In this case, on the evidence, it was held, that the reduction of prices by the plaintiff on safe locks containing his patented invention, was directly and solely caused by the defendant's infringement, after allowing a proper sum for any other patented device contained in the defendant's locks, and for any other causes which gave to the defendant an advantage in selling his locks. *id.*

41. The plaintiff, as owner of the patent, was held to be entitled to recover the damages, although he might be

accountable to a copartner for a part of them, as the copartner could not sue for them. *id.*

42. The interlocutory decree in a suit in equity for the infringement of a patent referred it to a master to take an account of the plaintiff's damages and of the defendant's profits. The master reported that there were no damages and no profits, but that the plaintiff was entitled to a compensation for the use of his patent by the defendant. It appeared that the use of the patent restored the salable character of the article the defendant made, and thus saved the defendant from loss: *Held*, that the money value of such advantage could be recovered, as compensation. *Sargent* v. *Yale Lock Mfg. Co.*, 249

43. Opinions and estimates as to such value are not competent evidence. *id.*

44. The amount paid by the defendant for a license to use another patented invention, which he used after he ceased to infringe the plaintiff's patent and in substitution for the plaintiff's device, was held to be the proper measure of the value of the invention to the defendant. *id.*

45. In this case, the report of the master as to the amount of damages sustained by the plaintiff, by the infringement of his patent, was set aside, on the ground that what he had reported as an established license fee was not shown to have been such. *Greenleaf* v. *Yale Lock Mfg. Co.*, 253

16 *Particular Patents.*

(1.) *Williams—Locomotive Lamp.*

46. The decision of this Court in *Williams* v. *The Rome, Watertown & Ogdensburgh R. R. Co.*, (15 *Blatchf. C. C. R.*, 200,) in regard to the re-issued letters patent granted to Irvin A. Williams, December 19th, 1865, for an "improvement in locomotive lamps," cited and applied. *Williams* v. *Boston & Albany R. R. Co.*, 21

47. Although the subordinate combinations covered by the several claims of the patent will not produce a useful result without the addition of other parts necessary to make a locomotive lamp, they are, nevertheless, sufficient to sustain the patent, because, by their coöperation, they contribute to a new result, and may be used in conjunction with such other parts as are ordinarily employed in locomotive head-lights. *id.*

48. All the claims of said patent are valid, except the fifth. *id.*

49. The fifth claim is void for want of novelty. *id.*

50. The defendant having employed all the parts in combination covered by the claims of the patent, cannot escape liability for infringement because of the employment of others in addition. *id.*

(2.) *Ingalls—Post-Office stamp.*

51. The re-issued letters patent, division A, No. 4,143, granted to Helen M. Ingalls, October 4th, 1870, for an improvement in post-office postmarking and cancelling hand-stamps, (originally granted to Marcus P. Norton, April 14th, 1863, and re-issued to Jacob Shavor and Albert C. Corse, August 23d, 1864, and to said Norton, August 3d, 1869,) are valid. *Campbell* v. *James*, 42

52. The invention was made by Norton before May 4th, 1859. *id.*

53. A letter from Norton, introduced in evidence by the defendant, is evidence for the plaintiff on those points which are in his favor. *id.*

54. Evidence to defeat a patent, on the ground of prior invention, ought to be such as to remove all fair and reasonable doubt. *id.*

55. The assignment on which a re-issue was based was alleged to have been forged by the assignee, but, it appearing that the assignor, after the re-issue, recognized the assignment as valid, it was upheld. *id.*

56. The execution of an assignment by a corporation and by S., presi-

dent, held to be a good execution by S. for his individual interest. *id.*

57. An assignment of a patent to an assignee in trust gives him the legal title. *id.*

58. Although the defendant used the invention as an officer of the Government, in the performance of his duties, for the benefit of the Government, he is liable as an infringer. *id.*

(3.) *Heath—Cuspadore.*

59. The letters patent granted to Eugene A. Heath, October 10th, 1871, for an "improvement in cuspadores," are valid. *U. S. Stamping Co.* v. *King*, 55

60 The invention covered by the claim of the patent, defined. *id.*

61. Although, in a prior suit on the patent, it had been held invalid, in view of a prior patent, this Court held it to be valid, and granted a preliminary injunction on it, on a different state of facts. *id.*

62. The invention in the Heath patent held to be patentable. *id.*

(4.) *Christman—Pump-filter.*

63. The re-issued letters patent granted to John Christman, March 24th, 1874, for an "improvement in pump filters," on the surrender of original letters patent granted to him November 28th, 1865, are valid, as respects the first claim. *Christman* v. *Rumsey*, 148

64. The decision of the Commissioner of Patents as to the existence of a ground for re-issue set forth in § 53 of the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 205,) is conclusive. *id.*

65. The said re-issued patent has not new matter introduced into its specification in violation of said § 53; nor is it open to the objection that it is not for the same invention, or for any invention, described in the original specification as the invention of the patentee. *id.*

66. It was lawful, under the decision in *The Corn Planter Patent*, (23 *Wallace*, 181,) to re-issue said patent with claims to combinations of fewer elements than were contained in the combination claimed in the claim of the original patent, the sub-combinations of the re-issue entering into a larger combination claimed in the original. *id.*

67. The claims of said re-issued patent, namely, "1. The combination of a wire gauze, C, with an open grating or guard, A, of sufficient strength for the purpose required, and a point, A', constructed substantially as and for the purposes described. 2. The combination of a grating, A, having apertures through it for the passage of the water to the interior, forming the lower end of a pump tube, with a wire gauze, C, for filtering the water, substantially as described," are claims to combinations and not merely to aggregations of parts. *id.*

68. The question of the infringement of the first claim, considered. *id.*

69. The second claim is void for want of novelty. *id.*

70. The plaintiff was allowed to recover on the first claim, on making, before a decree, a disclaimer as to the second claim, it not appearing that there had been any unreasonable neglect or delay to enter such disclaimer, but, as the disclaimer was not made before the suit was brought, costs to the plaintiff were refused. *id.*

(5.) *Severance—Rock-drill.*

71. The re-issued letters patent, No. 3,690, granted to Asabel J. Severance, as assignee of Rodolphe Leschot, October 26th, 1869, for an improved rock drill, are valid. *American Diamond Rock Boring Co.* v. *Sheldon*, 208

72. Where a re-issue is granted to an assignee, it is to be taken that he

had title to the patent, unless the contrary is made to appear. *id.*

73. A suit which is dismissed for want of prosecution is no bar to a subsequent suit for the same cause of action. *id.*

74. The question of the infringement of said re-issue, considered. *id.*

75. In determining whether a re-issue is for a different invention from the original patent, the two must be compared, to see if the invention patented in the re-issue is in any manner described in any part of the original and whether it might have been patented there. *id.*

(6) *Littlefield—Stove-cover hinge.*

76. The decision of the Supreme Court, in *Littlefield* v. *Perry*. (21 *Wallace*, 205,) construed. *Perry* v. *Littlefield*, 272

77. The invention covered by the claim of the letters patent re-issued to Dennis G. Littlefield, May 31st, 1870, for an "improvement in the mode of hinging covers to stoves, tea kettles and other open-topped vessels," on the surrender of the original letters patent granted to said Littlefield, March 13th, 1866, namely, "A detachable cover and its seat, respectively provided with a pin and an opening, so constructed as to engage or lock with each other, for the purpose of hinging and securing a cover upon an open-topped vessel, substantially as described," is an invention the exclusive right to which for the States of New York and Connecticut, as applicable to stoves covered by the patents embraced in the assignment of April 5th, 1853, and in the supplemental agreement of the same date, referred to in *Littlefield* v. *Perry*, belongs to the plaintiff, as against Littlefield and all persons claiming under him. *id.*

78. A bill in equity being maintainable in some respects, a demurrer to the whole bill was overruled. *id.*

79. The parties to the suit being all of them citizens of New York, this Court has no power to decree that the defendant execute to the plaintiff a transfer of letters patent. *id.*

(7.) *Blackman—Lamp.*

80. The re-issued letters patent, No. 7,417, granted to Ebenezer Blackman, December 5th, 1876, for improvements in lamps for burning coal oil, on the surrender of original letters patent No. 123,325, granted to said Blackman, February 6th, 1862, are invalid, as respects claims 1, 2, 4 and 5. *Blackman* v. *Hibbler*, 333

81. The claims of the re-issue are not for the same invention described in the original patent. *id.*

82. The specification of the original patent describes the invention as the use, only in combination, of a glass chimney base and a mica chimney top, and does not suggest the use of the base as a separate device. Therefore, all claims, in the re-issue, to the use of the base by itself, are invalid. *id.*

83. Claims 1, 2, 4 and 5 of the re-issue are void for want of novelty. *id.*

(8.) *Quirolo—Stereoscope.*

84. Re-issued letters patent, No. 6,557, granted to Antonio Quirolo, July 27th, 1875, for an improvement in stereoscopes, consisting of a combination of legs with the standard for the stereoscope to stand upon, are void, on their face, for want of novelty, within common knowledge. *Quirolo* v. *Ardito*. 400

85. Such a stand having been in use before for other things, there was no invention in putting a stereoscope upon it. *id.*

(9.) *Brown—Baling short cut hay.*

86. Whether letters patent No. 68,282, granted August 27th, 1867, to Charles Brown, for an improvement in baling short cut hay, are valid, is doubtful, short cut hay having been known before, and the invention consisting only in applying to short cut hay the well known pre-

cess of baling hay. *Faulks* v. *Kemp*, 432

(10.) *Adair—Pump.*

87. The second claim of re-issued letters patent No. 6,964, granted to William Adair, February 29th, 1876, for an improvement in pumps, namely. "The combination of the piston cylinder, the valve chamber and its valves, by which the water is supplied to and discharged from the lower side of the piston, the water head, and a cylinder cover which is removable from the pump through the open water head, substantially as described," is a claim for such a combination in double-acting pumps, and is valid. *Adair* v. *Thayer*, 468

88. A pump sold by the defendant was held to infringe such claim, although a part of the combination was used in it for only one of the purposes for which such part was used by the plaintiff. *id.*

(11.) *Root—Clock-dial.*

89. Re-issued letters patent were granted August 3d, 1875, to S. Emerson Root, for an improvement in clock dials, the original patent having been granted to him May 10th, 1859, and extended for seven years from May 10th, 1873. The plaintiff filed a disclaimer December 24th, 1877. It appearing that a clock dial composed of a printed paper dial and a metallic back united by a metallic rim was old, and that a metallic back with a lateral outside flange was commonly in use, it was *held*, that it was no material part of the invention to make the rim to correspond generally with the old pattern of the back; that that was all there was left of the invention after the disclaimer; and that, therefore, no patentable invention remained. *Root* v. *E. N. Welch Mfg. Co.*, 478

(12.) *Page—Induction coil apparatus and circuit-breaker.*

90. The re-issued letters patent granted October 10th, 1871, to Priscilla W. Page, administratrix, &c., of Charles G. Page, deceased, and the Western Union Telegraph Company, for improvements in induction coil apparatus and circuit breakers, the original patent having been granted to said Page, as inventor, April 14th, 1868, are valid, so far as claims 11, 12 and 13 are concerned. *Page* v. *Holmes Burglar Alarm Telegraph Co.*, 484

91. The history of the invention, and of the efforts of Page to obtain a patent for it, set forth. *id.*

92. The defendant held to have infringed claims 11, 12, and 13, namely, "11. The adjustment of the retractile force of an automatic circuit breaker, substantially as set forth. 12. The combination of an electro-magnet, armature and adjustable retractor. 13. Adjusting or regulating the length of vibration of the armature of an electro-magnet, by means of a set screw, or any mechanical equivalent for substantially the same purpose, substantially as herein set forth." *id.*

93. Claim 11 held to have been infringed, although, in the plaintiff's patent, the armature was retracted by a weight, made adjustable, and, in the defendant's apparatus, the retractile force was a spiral spring made adjustable as to its tension, the two having the same extent of adjustable capacity, by minute adjustments capable of being made without stopping the working of the apparatus; and although the adjustable functions of the spring were used only to ascertain whether the apparatus was in working order originally, and then the spring was left at the tension fixed upon. *id.*

94. The words "the adjustment," in claim 11, held to mean, the mechanical means of making the adjustment. *id.*

95. Claim 13 held to have been infringed, although the defendant's set screw was set originally at a given point, to determine the extent of vibration of the armature, and was not afterwards changed. *id.*

96. Claim 13 held to be a claim to the set screw so arranged as to be capable of making the regulation. *id.*

97. The special Act of Congress of March 19th, 1868, (15 *U. S. Stat. at Large*, 356,) under which the patent was granted, construed. *id.*

98. The words "circuit breakers described by him prior to said application," in said Act, defined, and held to include such appendages and added instrumentalities, so previously described by Page, as were calculated to make the circuit breaker more efficient or perfect. *id.*

99. The inventions covered by claims 11 and 12 examined, as to their history and the prior description of them by Page. *id.*

100. Claim 13 examined, as to the time from which the invention covered by it takes date, as having been described by Page. *id.*

102. The novelty of the inventions covered by claims 11, 12 and 13 held not to have been successfully impeached. *id.*

101. The provision in § 2 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 118,) which disqualified a person, while an employee in the Patent Office, from acquiring an interest in a patent, did not operate to dedicate to the public inventions made by such employee before he became such employee. *id.*

103. The said special Act construed, on the question of the abandonment of the inventions by Page to the public, and held not to be open to the objection that it deprived any person of his property without due process of law. *id.*

104. The application to be made under said special Act was subject to the same rules as other applications, and the same right to a re-issue existed as in the case of other patents. *id.*

(13.) *Slawson—Fare-box.*

105. The second claim of re-issued letters patent No. 4,240, granted to John B. Slawson, January 24th, 1871, for an improvement in fare boxes, and extended for seven years from July 28th, 1871, (the original patent having been granted to said Slawson, July 28th, 1857, and re-issued January 24th, 1871,) namely: "2. A fare box, having two compartments, into one of which the fare is first deposited, and temporarily arrested, previously to its being deposited in the other, when the former is provided with openings covered or protected by transparent mediums or devices, so arranged that the passenger can see through one, and the driver or conductor through the other, in the manner substantially as and for the purpose set forth," contains no patentable combination and no invention. *Slawson* v. *Grand Street, &c., R. R. Co.*, 512

106. The claim of letters patent No. 121,920, granted to Elijah C. Middleton, assignee of James F. Winchell, December 12th, 1871, for an improvement in fare boxes, namely: "Lighting the interior of a fare box at night, by light obtained from the head-light of the car, thrown by the reflector, I, through an opening, H, in the head lamp box, into the chamber for the temporary detention of the fare for inspection, substantially in the manner and for the purpose set forth," does not involve any invention. *id.*

(14.) *Giant Powder Co.— Explosive compound.*

107. The decision in *Atlantic Giant Powder Co.* v. *Rand* and *The Same* v. *Parker*, (16 *Blatchf. C. C. R.*, 250, 281,) that the re-issued letters patent No. 5,799, granted to the Giant Powder Company, March 17th, 1874, for an improved explosive compound, the original patent having been granted to Julius Bandmann, as assignee of Alfred Nobel, the inventor, as No. 78,317, May 26th, 1868, are valid, confirmed. *Atlantic Giant Powder Co.* v. *Dittmar Powder Mfg. Co.*, 531

108. A powder which, in 100 parts by weight, contains nitro-glycerine 67.64 parts, cellulose, (paper stock,) 16.82, and saltpetre, (nitrate of soda,) 15.54, and a powder which, in 100 parts by weight, contains nitro-glycerine

27.86 parts, sawdust and charcoal, in nearly equal proportions, 5.59, and saltpetre, (nitrate of soda,) 66.55, are infringements of said re-issue. *id.*

109. The said re-issue is not invalid, as being for a different invention from that set forth in the original patent. *id.*

110. It is not invalid on the ground that Nobel, the inventor, obtained from one Dittmar the knowledge of what is claimed in it. *id.*

111. What is claimed in it was not first invented by Dittmar. *id.*

112. The question of Dittmar's invention of it considered in view of the fact that, in former litigations, he was silent about his having invented it, although he made an affidavit, in a former suit on the said re-issue, the only purport of which was to show that the said re-issue was void for want of novelty. *id.*

113. The plaintiff held not to have deprived itself, by any conduct towards Dittmar, of the right to ask for a preliminary injunction against the defendant. *id*

(15.) *Hoe—Lithographic printing press.*

114. The letters patent granted, March 16th, 1869, to Richard M. Hoe, as the assignee of Auguste Hippolyte Marinoni, for an improvement in lithographic printing presses, are valid. *Hoe* v. *Cottrell*, 546

115. Marinoni having made oath, in his application, that he believed himself to be the original and first inventor, and having testified, in this suit, that he was the sole inventor, such evidence was held not to have been overcome by the testimony of one Chaudré, that he was a joint inventor with Marinoni, and by the fact that patents had been issued for the invention, in Europe, to the two jointly. *id.*

116. The decision of the Commissioner of Patents, that the required drawings and model had been presented, that an attorney had been duly appointed and had authority to amend or alter the specification, and that the specification had been sufficiently sworn to by the inventor, is final, and cannot be renewed collaterally. *id.*

117. There is sufficient invention in what is covered by the 3d claim, namely, "The combination of the sheet-flyer with an impression cylinder without tapes, and a receiving cylinder provided with both grippers and tapes, substantially as described and specified," to support a patent. *id.*

118. The object of said combination, stated. *id.*

119. There is a combination of the sheet-flyer with the impression cylinder, because the successive action of each contributes to produce a practical result. *id.*

120. The novelty of the combination sustained, against the view that it required only skilled labor to make it, in view of what existed before, all the elements of the combination being old, but the combination being new, in fact, and useful. *id.*

121. The combination being shown in the drawings, and described in the specification, as to its principles of construction and mode of operation, the claim is valid, although, in stating the invention, in the body of the specification, one element of the combination was omitted. *id.*

PLEADING.

See PATENT, 18.
PRACTICE, 1, 2.
TRUST, 2.

PRACTICE.

1. In an action for damages for publishing a libel, the answer omitted to deny statements in the complaint as to the manner in which the plaintiff was damaged and as to the amount of the damages sustained. The defendant was allowed to amend the answer, by denying such statements,

on the ground that the omission to deny them ought to have been regarded by the plaintiff as inadvertent. *Goodyear Dental Vulcanite Co.* v. *White*, 5

2. Under the system of pleading adopted in New York, judgment at the trial, in a suit at law, is to be rendered in accordance with the facts pleaded and proved, without regard to the form of the pleadings or the theory on which they were prepared. *Whalen* v. *Sheridan*, 9

3. Where the defendant in a suit in equity has appeared by a solicitor, notice of application for a decree, after an order *pro confesso*, must be given to such solicitor. *Bennett* v. *Hoefner*, 341

4. The defendants having, with the leave of the Court, filed several pleas, some to the whole bill and some to parts of the bill, and having set forth therein the existence of certain records, being judgments in suits at law, which were pleaded in bar, the Court, on motion of the plaintiff, and before he had replied to the pleas or set them down for argument, made an order referring it to a master to ascertain and report as to the truth of the existence of records in any way corresponding with those set forth in the pleas, and to return copies of the records, unless the defendants should file, with the pleas, copies of the records. *Emma Silver Mining Co.* v. *Emma Silver Mining Co.*, 389

See ADMIRALTY, 1 to 3.
CRIMINAL LAW, 1, 2.
JUDGMENT.
NEW TRIAL.
PATENT, 2, 6, 18, 19, 70, 73, 78.
REMOVAL OF CAUSES, 1, 2.

PROMISSORY NOTE.

1. The decision in *Codman* v. *Vermont & Canada R. R. Co.*, (16 *Blatchf. C. C. R.*, 165,) adhered to. *Codman* v. *Vermont & Canada R. R. Co.*, 1

2. This suit being against the endorser of the notes, and the endorsement having been filled up when it was made, and ordering the contents of the notes to be paid to the bearer, and this having been done before the notes were put into circulation, the contract of the endorser was with the bearer, and no disability of the bearer to sue, as an assignee, could arise under § 11 of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 79,) now § 629 of the Revised Statutes. *id.*

3. It was of no consequence that the notary protesting the notes did not have the notes, as well as the coupons, to present for payment, at the time of making demand of payment. *id.*

4. This statement: "Funds for the payment of this note at maturity have been placed in my hands, as trustee," written across the face of a promissory note, and signed by the defendant, such note having been made by a party for whom the plaintiff built a bridge, and the bridge having been delivered by the plaintiff to such party on the faith of the signing of such statement, *held*, to make the defendant liable for the full amount of the note, although he had not such funds when he signed said statement, and the plaintiff knew it. *Keystone Bridge Co.* v. *Britton*, 407

See TOWN BOND, 4.

R

RAILROAD COMPANY.

See BOND.
CARRIER, 7.

REBATE OF DUTIES.

See VESSEL.

REBELLION.

See GUARDIAN.

REMOVAL OF CAUSES.

1. W., a citizen of New York, brought a suit in a State Court of New York

against S., a citizen of New York, to recover money alleged to have been due by S. to N., a voluntary assignor to W. By an order of the State Court, G., a citizen of Ohio, who claimed the money as assignee in bankruptcy of N., was made defendant in the suit in the place of S., S. having paid the money into Court. W. then filed an amended complaint in the suit, in the State Court, treating G. as the sole defendant, and asking judgment against him. G. answered the amended complaint. G. then removed the case into this Court. without giving notice to the plaintiff of the application for the removal. The petition for removal set forth that "the controversy is between W., as assignee of the estate of N., who was at the commencement of this action, and now is, a citizen of the State of New York, and G., as assignee in bankruptcy of N., who is, and was at the commencement of this action, a citizen of the State of Ohio." On a motion by the plaintiff to remand the cause: *Held*,

(1.) That the petition alleged the personal citizenship of the parties, and was not defective;

(2.) That no notice of the applicationf or the removal was necessary, and the State Court could, in practice, require it or dispense with it;

(3.) That it is not necessary, under §§ 2 and 3 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470,) in order to the removal of a suit, that it should appear that the parties were citizens of different States when the suit was commenced;

(4.) That the suit, as between W. and G., must be regarded as having been commenced when G. was substituted for S., as a defendant. *Wehel* v. *Wald*, 342

2. On March 17th, the State Court in which this suit was pending made an order, on the petition of the defendant, that it be removed into this Court. The defendant ought to have filed the record in this Court by April 7th. It was not filed till April 10th. This Court, on May 24th, made an order remanding the cause. June 2d, on a new petition filed that day by the defendant, which set forth that the suit was then pending in the State Court, that Court made an order that the suit be removed into this Court: *Held*,

(1.) That, as the removal was provided for by §§ 2 and 3 of the Act of March 3d, 1875, (18 *U.S. Stat. at Large*, 470, 471,) the petition was in time i, filed before or at the term at which the cause "could be first tried, and before the trial thereof;"

(2.) That the publication of the second edition of the Revised Statutes, under the Act of March 2d, 1877, (19 *U. S. Stat. at Large*, 268,) did not re-instate subdivision 1 of § 639 of the Revised Statutes, as applicable to this suit;

(3.) That the proper condition of the bond on removal was that prescribed by § 3 of the Act of 1875;

(4.) That the petition of June 2d was filed before or at the term at which the cause could be first tried;

(5.) That, as the defendant had once removed the cause to this Court and had failed, by neglect, to perfect the removal, and the cause had been remanded for that reason, the right to remove it had been waived and lost;

(6.) That the defendant could not now be allowed to furnish an excuse for not having in time filed the record on the first removal, and that it had acquiesced in the first remand by averring, in the second petition, that the cause was then pending in the State Court. *McLean* v. *St. Paul & Chicago Railway Co.*, 363

3. Subdivision 3 of § 639 of the Revised Statutes, in regard to the removal of causes, is not repealed by the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 471.) *Sims* v. *Sims*, 369

4. Where a suit has been tried in the State Court and a judgment had for the plaintiff, and such judgment has been reversed, on appeal, and a new trial ordered, and proceedings, by the defendant, to remove the cause into this Court, are taken before the new trial is had, the application for removal is made before "the trial or final hearing of the suit," and in time, under said subdivision 3. *id.*

5. In determining, under the first clause of § 2 of the Act of March 3d, 1875 (18 *U. S. Stat. at Large*, 470,) whether a suit is one in which there is a con-

troversy between citizens of different States, the condition of the controversy when the petition for removal is filed is what is to be considered, and not its condition at a subsequent time. There must be a controversy between citizens of different States when the petition is filed, and all the parties on one side of such controversy must unite in the petition for removal, and they must all then be of different State citizenship from any of the parties on the other side of such controversy. *Chicago, St. Louis & New Orleans R. R. Co.* v. *McComb*, 371

6. A corporation defendant, which is not a real or actual or necessary party, but is a merely formal party, to the controversy in the suit, as such controversy stands when the petition for removal is filed, is to be considered as not a party. *id.*

7. The controversy is to be judged of, in part, by the pleadings, if any, which had been put in, in the State Court, before the filing of the petition for removal. *id.*

8. In a suit by a corporation of one State against a citizen of another State, it is sufficient, in a petition for removal by the defendant, under the first clause of said § 2, to state, that the defendant *is* a citizen of such other State, and it is not necessary to state that he was such citizen when the suit was commenced. *id.*

9. Nothing had transpired, in pleading or evidence, since the case came into this Court, to show that said formal defendant ought now to be held to be an actual real and necessary defendant; and a motion to remand the cause was denied. *id.*

10. Where one of the defendants in a suit is, on the averments in the complaint in the State Court, an unnecessary and improper party, and no real and actual party, and the plaintiff is an alien, and the other defendants are all citizens of various States of the United States, the case is one removable into this Court under the first clause of § 2 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470,) where all such other defendants apply for the removal, and where there is a controversy between the alien and such citizens, which is the only controversy in the suit. *Cooke* v. *Seligman*, 452

11. Some of the petitioners for removal signed the petition by an attorney, but the order of the State Court for the removal stated that the petition was duly made and filed by the petitioners, and that the petitioners appeared by counsel and moved for such order. On the contents of the petition and the bond, and the action of the petitioners by their counsel, in moving for such order, and the contents of such order: *Held*, that the petition must be regarded as the petition of the petitioners. *id.*

12. The averment, in the petition, that certain of the petitioners, "as they are the qualified executors of the last will and testament of J. B., deceased," were and are citizens of the State of New York, was *held*, in this case, to mean, that they were sued as such qualified executors, and to be an averment of their personal citizenship. *id.*

13. The absence of any acknowledgment or proof of the execution of the bond was *held* to be a matter of practice for the State Court to pass upon, and not reviewable by this Court, after the State Court had accepted the bond. *id.*

14. The bond contained, in its condition, a clause providing that the defendant should do, or cause to be done, such other and appropriate acts as, by said Act of 1875, and other Acts of Congress, are required to be done, on the removal of a suit: *Held*, that such clause was a sufficient compliance with any requirement in § 3 of the Act of 1875, that the bond should be one for appearing in the Federal Court. *id.*

15. A suit brought by a corporation created by an Act of Congress is a suit arising under the laws of the United States, and, as such, is removable into this Court, under § 2 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470.) *Union Pacific Railroad Co.* v. *McComb*, 410

16. In an action of ejectment, in a State Court, against three defendants, two of them, being citizens of New York, made default. The third answered, and the cause was at issue. More than 10 months afterwards, the third, being a citizen of Pennsylvania, petitioned for the removal of the cause into this Court. The plaintiff was a citizen of Massachusetts: *Held*,

(1.) The removal was not one provided for by subdivision 2 of § 639 of the Revised Statutes, because the plaintiff was not a citizen of New York;

(2.) The removal was not applied for in time, under § 3 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 471,) because several terms of the State Court had been held, after the joining of issue, at which the cause could have been tried, if noticed for trial by the defendant, and there was no obstacle to its being so noticed, although the petition was filed before the commencement of the term for which the cause was first noticed for trial. *Forrest* v. *Keeler*, 522

S

STATUTES.

United States.

1789, September 24th, Judiciary, 1, 2
1789, September 24th, Removal of Causes, 525
1790, April 10th, Patent, 442
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See CARRIER, 1 to 5.
COLLISION, 9 to 12.

TOWN BONDS.

1. After the Court decided *Cooper* v. *The Town of Thompson*, (13 *Blatchf. C. C. R.*, 434,) the Court of Appeals of New York decided, in *Horton* v. *Town of Thompson*, (71 *N. Y.*, 513,) that the Act of the Legislature of New York, passed April 28th, 1871, (*Laws of New York*, 1871, *chap.* 809, *p.* 1838,) validating the irregularities of the commissioners in issuing the bonds of the town, was unconstitutional, and, after that decision, this Court, in an action between the parties to this suit, adhered to the former decision of this Court. In the present case this Court adhered to its former decisions, there being no difficulties in the way of a review of the case by the Supreme Court. *Perrine* v. *Town of Thompson*, 18

2. The case of *The County of Warren* v. *Marcy*, (97 *U. S.*, 96,) followed, as conclusive against a defence predicated on *The People ex rel. Kilbourne* v. *Benedict*. *id.*

3. Where a plaintiff has the legal title to coupons, he can sue upon them, although he bought them merely with the object of bringing suit upon them in this Court, and intending, if he collected them, to pay over a portion of the recovery to some other person. *id.*

4. Coupons payable to bearer are promissory notes, within § 1 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470,) and the holder of them is not an assignee, but acquires his title by delivery. *id.*

TRIAL.

See CRIMINAL LAW, 12, 15, 17.

TRUST.

1 G., trustee under the will of J., of property, to receive its profits, and

pay the same to B. during his life, with remainder over to the plaintiffs, turned over the property absolutely to B., who lost it. The plaintiffs brought this suit against L., the executrix of G., claiming not only that she had assets belonging to the estate of G., but that G. had conveyed to her, she being then his wife, without consideration, property of his own, more than was a reasonable provision for her in view of his violation of said trust, and probably intending to defeat such liability, which she understood: *Held*, that, in addition to responding for the assets of the estate, she must respond, and in this suit, for the property so conveyed to her. *Beatty* v. *Hinckley*, 398

2. The whole claim is one against the estate of G., in her hands as executrix, and the bill is not multifarious. *id.*

V

VESSEL.

1. Where a rebate of duties is made in regard to goods respecting which damage is awarded for a breach of a contract of affreightment by a vessel, the vessel cannot have credit, against the amount of damage, for the amount of the rebate. *The Eroe*, 16

See ADMIRALTY, 4.
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